

No. 2022-2044

**IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

IKORONGO TEXAS LLC AND IKORONGO TECHNOLOGY LLC,
Plaintiffs-Appellants,

v.

BUMBLE TRADING LLC,
Defendant-Appellee

Appeal from the United States District Court for the Western District of Texas,
No. 6:20-cv-256, Hon. Alan D. Albright, United States District Judge

**PETITION FOR REHEARING *EN BANC* BY PLAINTIFFS-APPELLANTS
IKORONGO TEXAS LLC and IKORONGO TECHNOLOGY LLC**

Howard Wisnia
howard@wisnialaw.com
Wisnia PC
12636 High Bluff Drive
Suite 400
San Diego, California 92130
858.461.0989 - Telephone

Karl Rupp
krupp@soreylaw.com
Sorey & Hoover LLP
One Liberty Place
101 N. 6th Street, Suite 502
Waco, Texas 76701
903.230.5600 - Telephone
903.230.5656 - Facsimile

Jessica Underwood
junderwood@nixlaw.com
Nathan Hall
nhall@nixlaw.com
Nicholas Wyss
nwyss@nixlaw.com
Nix Patterson, LLP
8701 Bee Caves
Building 1, Suite 500
Austin, Texas 78746
512.328.5333 - Telephone
512.328.5335 - Facsimile

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 2022-2044

Short Case Caption Ikorongo Texas LLC v. Bumble Trading LLC

Filing Party/Entity Ikorongo Texas LLC and Ikorongo Technology LLC

Instructions:

1. Complete each section of the form and select none or N/A if appropriate.
2. Please enter only one item per box; attach additional pages as needed, and check the box to indicate such pages are attached.
3. In answering Sections 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance.
4. Please do not duplicate entries within Section 5.
5. Counsel must file an amended Certificate of Interest within seven days after any information on this form changes. Fed. Cir. R. 47.4(c).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 10/10/2023

Signature: /s/ Howard Wisnia

Name: Howard Wisnia

| <p>1. Represented Entities. Fed. Cir. R. 47.4(a)(1).</p> | <p>2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).</p> | <p>3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).</p> |
|--|---|--|
| <p>Provide the full names of all entities represented by undersigned counsel in this case.</p> | <p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p> | <p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p> |
| <p>Ikorongo Texas LLC</p> | | |
| <p>Ikorongo Technology LLC</p> | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |
| | | |

Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable Additional pages attached

| | | |
|-----------------------------|--------------------|--|
| Derek Gilliland | Jeffrey Angelovich | |
| Sorey, Gilliland & Hull LLP | | |
| Brad Beckworth | | |

5. Related Cases. Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

Yes (file separate notice; see below) No N/A (amicus/movant)

If yes, concurrently file a separate Notice of Related Case Information that complies with Fed. Cir. R. 47.5(b). **Please do not duplicate information.** This separate Notice must only be filed with the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. Fed. Cir. R. 47.5(b).

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/Not Applicable Additional pages attached

| | | |
|--|--|--|
| | | |
| | | |

TABLE OF CONTENTS

| | PAGE |
|--|-------------|
| CERTIFICATE OF INTEREST | i |
| TABLE OF CONTENTS | iv |
| TABLE OF AUTHORITIES | v |
| RULE 35(b)(1) STATEMENT | vi |
| INTRODUCTION..... | 1 |
| ARGUMENT | 3 |
| I. 35 U.S.C. § 251 Requires Consideration of the Original Claims..... | 3 |
| II. The Judicially Created “Explicitly and Unequivocally” and “Separate and Apart” Standard Is Inconsistent with Section 251 and Supreme Court Precedent | 7 |
| III. The District Court’s Application of <i>Antares</i> Is Unprecedented and Out of Step with this Court’s 35 U.S.C. § 251 Jurisprudence | 10 |
| CONCLUSION | 17 |

TABLE OF AUTHORITIES

| Cases | Page(s) |
|--|----------------|
| <i>Antares Pharma, Inc. v. Medac Pharma Inc.</i> , 771 F.3d 1354 (Fed. Cir. 2014)..... | <i>Passim</i> |
| <i>Cioffi v. Google</i> , 2023 WL 2981491 (Fed. Cir. 2023) | 7 |
| <i>Forum U.S., Inc. v. Flow Valve, LLC</i> , 926 F.3d 1346, 1352 (Fed. Cir. 2019)..... | 4, 7 |
| <i>Halo Elecs., Inc. v. Pulse Elecs., Inc.</i> , 579 U.S. 93 (2016) | 9 |
| <i>In re Amos</i> , 953 F.2d 613 (Fed. Cir. 1991)..... | 14, 15 |
| <i>In re Float’N’Grill</i> , 72 F.4th 1347 (Fed. Cir. 2023)..... | 7, 15 |
| <i>In re Peters</i> , 723 F.2d 891 (Fed. Cir. 1983)..... | 4, 14 |
| <i>Nautilus, Inc. v. Biosig Instruments, Inc.</i> , 572 U.S. 898 (2014) | 10 |
| <i>Octane Fitness, LLC v. ICON Health & Fitness, Inc.</i> , 572 U.S. 545 (2014) | 9, 13, 14 |
| <i>U.S. Indus. Chems. v. Carbide & Carbon Chems. Corp.</i> , 315 U.S. 668 (1942)..... | <i>Passim</i> |
| Statutes | |
| 35 U.S.C. § 282 | 8 |
| 35 U.S.C. § 251 | <i>Passim</i> |

RULE 35(b)(1) STATEMENT

Based on my professional judgment, I believe the panel decision is contrary to the following decision(s) of the Supreme Court of the United States or the precedent(s) of this court: *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.* (“*Industrial Chemicals*”), 315 U.S. 668 (1942); *In re Peters*, 723 F.2d 891 (Fed. Cir. 1983); *In re Amos*, 953 F.2d 613 (Fed. Cir. 1991).

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

1. Whether *Industrial Chemicals* requires the Court to consider the original claims in addition to the specification when conducting a 35 U.S.C. § 251.
2. Whether the “clearly and unequivocally” and/or “separate and apart” test purportedly articulated in *Antares Pharma, Inc. v. Medac Pharma Inc.*, 771 F.3d 1354 (Fed. Cir. 2014), is inconsistent with Section 251, *Industrial Chemicals*’ “same invention” test, the presumption of validity under 35 U.S.C. §282, and the burden on the patent challenger to present “clear and convincing” evidence of invalidity.
3. Whether aspects of an invention that are described in a patent specification in “a lengthy list of combinations and possibilities” or as “part of a serial list of suggestions,” without more, can never be claimed individually on reissue.

INTRODUCTION

The Panel summarily affirmed the District Court’s order granting summary judgment of invalidity under 35 U.S.C. § 251. The District Court applied the already dubious legal standard laid out in *Antares Pharma, Inc. v. Medac Pharma Inc.*, 771 F.3d 1354 (Fed. Cir. 2014) in a heretofore unprecedented manner—to *forbid* consideration of the original patent claims in its “original patent” analysis of the reissue claims. It also interpreted *Antares* to (1) require that the “particular combinations” of the reissue claims be “clearly and unequivocally” disclosed “separate and apart” from other aspects of the invention, and (2) hold that features disclosed in the specification “as a lengthy list of combinations and possibilities” or as “part of a serial list of suggestions” can never meet the “clear and unequivocally” “separate and apart” standard. Appx000008-000009; 000013-15.

The District Court’s Order—and the Panel’s summary affirmance of the District Court’s Order—is in stark and consequential conflict with well-established Supreme Court and Federal Circuit precedent. Specifically, in *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668 (1942) (“*Industrial Chemicals*”), the Supreme Court applied 35 U.S.C. § 251, and in doing so, did not exclude the original claims from its analysis or apply an extra-statutory requirement of “clear and unequivocal” “separate and apart” disclosure. Rather, it looked for “the same invention” as in the original patent, and *explicitly considered*

the original claims when determining whether reissue claims were supported by adequate disclosure in the original patent. The test established by the Supreme Court is that reissue claims must be for “*the same invention* described and *claimed* and intended to be secured by the original patent.” *Id.* at 681.

Contrary to this clear precedent, the Panel affirmed the District Court’s legally erroneous order based on a reading of *Antares* wholly inconsistent with the statute and with *Industrial Chemicals*. And this deviation from precedent is particularly important in the present case, because it presents an issue not previously considered in the 35 U.S.C. § 251 context: here, the aspects of the reissue claims the District Court found did not meet the original patent requirement are actually *narrower* than the original patent claims. A logical byproduct of the District Court’s decision is that the original claims themselves would not pass muster under §251, a nonsensical result wholly at odds with *Industrial Chemicals*’ “same invention” test. Moreover, the District Court’s application of the *Antares* test resulted in yet another unprecedented holding—that alternative features disclosed in a patent specification in list format are *per se* insufficient to meet the original patent requirement.

This conflict raises significant questions of law that demand the thoughtful consideration of the *en banc* Court and, if left unaddressed, undermine the jurisprudential stability of this Circuit and 35 U.S.C. § 251’s purpose.

ARGUMENT

I. 35 U.S.C. § 251 Requires Consideration of the Original Claims.

The District Court expressly held that *Antares* prevented it from considering the original patent claims in its Section 251 analysis. Appx000010. In summarily affirming the District Court, the Panel has, *sub silentio*, adopted this bright line rule, muddying (if not entirely overruling) the need, and the practice, to consider both the specification *and* the original claims during the original patent analysis.

At least until *Antares*, the historic practice of the Supreme Court and this Court was to examine the original claims and compare them to the reissue claims as part of the Section 251 analysis. Once a court determines how the reissue claims differ from the original claims, it then looks to both the specification and the original claims in search of support for the different (and in every instance Appellant has seen, broadened) aspects. In *Industrial Chemicals*, the Supreme Court described comparing the original and reissue claims as defining a “criteria of judgment:”

We shall postpone discussion of the tests of identity or difference of invention, and the use of expert testimony, to a statement of the criteria of judgment furnished by the language of the specifications *and claims* of the two documents [(the original and reissue patents)].

315 U.S. at 671. The Supreme Court expressly analyzed the original patent’s claims and compared them to the new reissue claims. *Id.* at 673-75. (“The new claims 8 and 9 are broader than those of the original patent.”). Finally, the Supreme Court held the broadened reissue void because it was “not for the same invention described and

claimed and intended to be secured by the original patent.” *Id.* at 681. Plainly, the Court looked to the original claims (as well as the specification) to determine whether there was support for the reissue claims; because there was not, the reissue was void.

This Court has done the same in cases applying Section 251, before, after and even in *Antares* itself. In *In Re Peters*, this Court first compared the claims of the original patent to those in the reissue and found that a claim limitation relating to the thickness of tips had been removed. 723 F.2d 891, 892-93 (Fed. Cir. 1983). This Court then examined the specification to determine whether the originally claimed tip configuration was critical to the invention. *Id.* Likewise, in *Forum U.S., Inc. v. Flow Valve, LLC*, this Court analyzed the original patent claims to hold that the reissue patent “broadened the claims to include embodiments of fixtures that do not use arbors by writing new claims without the arbor limitations.” 926 F.3d 1346, 1349 (Fed. Cir. 2019).

Even in *Antares*, the case that led the District Court astray, this Court employed the same two-step process by comparing the reissue claims to the original claims. 771 F.3d at 1356. In doing so, this Court found “[t]he original claims are significantly different in scope and coverage than the asserted claims. [The original claims] are focused on jet injectors, and every one of those claims contains the ‘jet injection’ limitation. The asserted claims are focused on particular safety features

and do not contain the jet injection limitation.” *Id.* Having compared the original claims to the reissue claims and determining the scope differed, the *Antares* Court then found that “[t]he original specification here does not adequately disclose the later-claimed safety features to meet the *Industrial Chemicals* standard.” *Id.*

Nonetheless, despite having just examined the original claims, the *Antares* Court stated, “by definition in reissue the original claims do not disclose the invention claimed on reissue. Thus, we must look to the specification.” *Id.* at 1362. But interpreting that language—which arguably made sense in the factual context of *Antares*—to preclude examination of the original claims is contrary to the plain text of 35 U.S.C. § 251 and the clear precedent of *Industrial Chemicals*. And yet that is what the District Court, and the Panel via summary affirmation, did here.

Comparing the reissue claims to the original claims in this case, it is beyond peradventure that the differences at issue constitute a narrowing of the invention: the original claims broadly covered collecting and sharing visited location data recorded by a location-aware device, while the reissue claims cover collecting and sharing visited geographic location data recorded by a location-aware cellular phone using a satellite-based location-fixing protocol. *See* Claim 33 of ’704 Reissue Patent, Appx000355; *cf.* Claim 32 of ’139 Patent, Appx000273 at 22:23-37. With respect to the narrowed claim elements, the specification discloses (as the District Court

acknowledged) that location data may be geographic data, and that it may be recorded using satellite-based protocols such as GPS or DGPS. Appx000012-15.

Likewise, both the originally filed and originally issued claims disclose sharing “responses” (e.g., comments, ratings) as dependent claims, and therefore not “necessary” to the invention. *See, e.g.*, Appx000273 (Original Claims 27 and 28 (providing annotation tools for associating for notes/ratings with tracking entries)); Appx000391 (Originally Filed Claims 30 and 31 (same)). These claims demonstrate that the patentee regarded *as its invention* tracking and sharing visited location data, with or without “other” experiences, and with or without the ability to “respond” to the experience data with comments, ratings, or similar.

The District Court’s analysis should have ended there. Instead, the District Court entirely disregarded the original claims, interpreting *Antares* to require that, “[i]n evaluating the original patent requirement, the Court looks to the original patent in its entirety *but excludes the erroneous claims.*” Appx000010 (emphasis added). This cannot be right. Whether the original claims are technically “erroneous” is of no import. Indeed, acceptable reissue “errors” include “claiming more *or less* than [the patentee] had a right to claim in the patent.” 35 U.S.C. § 251(a) (emphasis added). What matters is that Section 251 requires that the reissue claims be for the same invention as *claimed* in the original patent, and thus the original claims must be referenced. *Industrial Chemicals*, 315 U.S. at 681. Moreover, even if the original

claims were “erroneous” that does not mean they are not probative of the “invention described and *claimed* and intended to be secured by the original patent.” *Id.*

A rehearing *en banc* is necessary to clarify whether entirely disregarding the original claims is consistent with Section 251 and controlling precedent.

II. The Judicially Created “Explicitly and Unequivocally” and “Separate and Apart” Standard Is Inconsistent with Section 251 and Supreme Court Precedent.

The District Court’s error in ignoring the original claims was compounded by application of the erroneous standards first announced in *Antares* to require that the specification *alone* must be searched for an “explicit and unequivocal” disclosure of “the particular combinations” claimed on reissue “separate and apart” from other aspects of the invention. *See* Appx000008-000009; Appx000012 (citing *Antares*, 771 F.3d at 1362-63). The District Court recognized this as a “heightened standard” permitting reissue claims only for “separate inventions that are clearly and unequivocally disclosed in the original specification.” Appx000009. This same erroneous standard has now been cited by this Court in *Forum U.S., Inc. v. Flow Valve, LLC*, 926 F.3d 1346, 1352 (Fed. Cir. 2019), *Cioffi v. Google*, No. 2018-1049, 2023 WL 2981491 at *4 (Fed. Cir. 2023), and *In re Float’N’Grill*, 72 F.4th 1347, 1351 (Fed. Cir. 2023) Indeed, this Court has not affirmed the patentability of any reissue under the “original patent” requirement of § 251 since the introduction of this new “standard.”

But this language from *Antares* is a stark departure and expansion of the requirement set out in § 251, which simply demands that the reissue claims be for “the invention disclosed in the original patent.” While this Court’s instruction in *Antares* perhaps made sense given the unique facts of that case, interpreting that language as establishing the test for satisfying the original patent requirement in every broadening reissue is inconsistent with prior precedent and § 251’s text.

In *Antares* the patentee admitted the reissue claims were directed to a ***different invention*** than originally claimed, and the new invention was indisputably broader by having removed the “jet injector” limitations. 771 F.3d at 1362. Under these unique facts, searching the specification for the disclosure of the “particular combinations” of safety features claimed on reissue “separate and apart” from the original “jet injector” invention may have made sense. However, the *Antares* Court, perhaps inadvertently, did not so limit its reasoning. Rather, it purported to create of whole cloth a new standard or test that “the specification must clearly and unequivocally disclose the newly claimed invention as a separate invention.” *Id.*

This “test” is entirely judicially created and divorced from any statutory or judicial precedent. First, the statute has no such requirement, and the test is inconsistent with the 35 U.S.C. §282 presumption of validity, and with the burden on *the patent challenger* to present “clear and convincing” evidence of invalidity. Second, while the *Antares* panel cited *Industrial Chemicals* in support of its test,

neither the word “clearly” nor “unequivocally” appears in that opinion. More significantly yet, *Industrial Chemicals* never uses the word “separate.” Instead, the Supreme Court held the reissue claims must be for “**the same invention** described and **claimed** and intended to be secured by the original patent.” 315 U.S. at 681. Indeed, while the word “separate” does not appear in the opinion, the word “same” appears twelve times, and “same invention” appears six times. *See generally id.* *Antares*’s replacement of the Supreme Court’s “same invention” test with a new “separate invention” test is made worse still by the fact that *Antares* provides no guidance as to what the newly claimed invention should be “separate” **from**, outside the *Antares*-specific context of a patentee admitting their reissue claims were directed to “a different invention” than originally claimed (a troublesome admission in light of *Industrial Chemicals*’s “same invention” test). *Id.* at 1356. Further, its requirement of heightened “clear and unequivocal” support is inappropriate.

Antares’s fabrication of a new test, divorced from Supreme Court precedent and the statutory text is the very same kind of judicial legislating for which the Supreme Court has reversed the Federal Circuit previously. *See, e.g., Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 579 U.S. 93, 104-105 (2016) (reversing Federal Circuit’s creation of two-part test for enhanced damages as inconsistent with language of the governing statute); *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545, 557-58 (2014) (reversing Federal Circuit’s adoption of clear and convincing

standard of proof for award of attorneys' fees under Section 285 where there was no statutory basis for imposing a heightened standard of proof). Indeed, the Supreme Court made clear in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014), that devising tests divorced from the governing statutory text "leave[s] courts and the patent bar at sea without a reliable compass." *Id.* at 911-12 (reversing the creation of "insolubly ambiguous" and "amenable to construction" standards for definiteness where such judicially created tests had no basis in text of Section 112).

A rehearing *en banc* is necessary to consider whether *Antares's* clear departure from the statute and the language of *Industrial Chemicals* is consistent with § 251's requirements.

III. The District Court's Application of *Antares* Is Unprecedented and Out of Step with this Court's 35 U.S.C. § 251 Jurisprudence.

Assuming, *arguendo*, that original claims should be completely ignored, and that the "clear and unequivocal" "separate and apart" test is appropriate, the District Court's application of *Antares* is illogically restrictive and does not comport with general principles of patent drafting. The District Court found, under *Antares*, that reissue claims are not permitted to claim a single feature or embodiment when that feature's disclosure in the specification is contained within "a lengthy list of combinations and possibilities" or as "part of a serial list of suggestions." Appx000008-000009; 000013-15. No prior case has come to such a conclusion. But the Panel's affirmance of the District Court's opinion endorses this approach, which

renders common patent drafting practices virtually obsolete for reissues. Review by an *en banc* panel of this Court is necessary to consider whether such an application of *Antares* is consistent with § 251's requirements.

The District Court's holdings here can be summarized as: (1) because the patent discloses that multiple types of data, including geographic data, could be stored and shared, the reissue claims cannot encompass sharing geographic data without *every* form of sharing; and (2) because the patent discloses that a mobile device could be associated with a location using various protocols (*e.g.*, triangulation, GPS, DGPS, *or* Loran), the reissue claims must encompass *every* one of those protocols. Appx000013-15.

Regarding (1), the patent discusses types of activity that may be tracked permissively:

Tracked activity may include Internet activity 120, **wireless network location track and interaction activity** 121 and enterprise intranet activity 122. Activities tracked in these domains **may include** view, listen, rate, comment, assign emoticon, send, watch, download, bookmark or **visit**. A user views a URL, watches a visual presentation and listens to an audio presentation. **A user visits a restaurant or other location.** A user who views, watches, listens or visits may respond to their experience. A user's response may be to rate, comment, assign an emoticon, send information to a buddy, download data or bookmark an item for later access.

Appx000264-000265 at 4:65-5:1.

The original patent's use of the permissive language "may include" in this paragraph demonstrates that the invention could include *or exclude* one or more of

such tracked activities. The Patent further discloses with reference to type of data collected: “The VLD [visited location database] also could store geographic information regarding the location, such as geo-coded data.” Appx000264 at 3:24-25. Despite that disclosure, the District Court found that “the specification fails to clearly and unequivocally disclose sharing the visited geographic location data *separate and apart* from sharing experiences generally as the original invention.” Appx.000013 (emphasis in original).

Regarding (2), the District Court concluded that the original invention does not disclose “using a satellite-based location fixing protocol.” Appx000015. This too, was flatly incorrect.

Several equivalent methods of associating a portable device with a location are available. Sophisticated networks may fingerprint, triangulate or otherwise locate a wireless device based on radio signal characteristics. Sophisticated devices may include circuits that determine the device's location; these circuits may utilize GPS, DGPS, Loran or any other location fixing protocol.

Appx000264 at 3:27-35. Neither the District Court, nor Appellee, dispute that the patent discloses that location detection can occur using GPS or DGPS, or that those are satellite-based location fixing protocols. Regardless, the District Court, relying on *Antares*, found that because GPS and DGPS were “part of a serial list of suggestions,” the disclosure did “not amount to an explicit and unequivocal disclosure that the scope of the original invention is limited to all ‘satellite-based

location-fixing protocol[s]’ ...to the exclusion Bluetooth, triangulation, radio signal, Loran, and other location fixing protocols.” Appx000015.

These holdings turn the law on its head. While the original patent recited that the invention “*may* include” certain features the District Court held that the reissue claims *must* include those features. *Id.* Similarly, when the original patent recited that one option “*or*” another could be used, the District Court required that the reissue claims must include *every* listed option. *Id.*

The District Court’s holding—and the Panel’s affirmance of that holding—are completely out of step with this Court’s prior § 251 decisions. In no prior case has this Court or the Supreme Court found that an embodiment disclosed within a serial list of suggestions could not be claimed on reissue because “a serial list of suggestions does not amount to an explicit and unequivocal disclosure.” Appx000015.

For example, in *Industrial Chemicals*, the Supreme Court found that original claims requiring the presence of water as a catalyst could not be broadened on reissue to omit the necessity of water where the specification made clear that water was necessary. *Id.* at 676. Here, unlike in *Industrial Chemicals*, the District Court did not consider whether any “necessary” element was omitted. None were—the patent is directed to sharing experiences, of which “visiting a location” is one. Appx000264-000265 at 4:65-5:1. Similarly, recording locations using means other than a

“satellite-based location-fixing protocol” is unnecessary; rather the patent describes the physics of how location is associated as “relatively unimportant.” Appx000264 at 3:34-38. Here, the specification uses the word “necessary” only once, in reference to location tracking that may be via GPS, and not with respect to any other “experiences:”

“It is **necessary** for the user to have a wireless device 2354, which supports a location detection service. This support may be by Bluetooth, GPS or any other location detection technology.”

Id. at 5:53-56 (emphasis added).

Similarly, in *In Re Peters*, this Court found that original claims directed to a television including support walls with metal tips of a particular thickness were permissibly broadened to omit specification of a particular thickness. This Court reasoned that the tip thickness was not critical to the invention, was not used to distinguish prior art, and a POSITA would understand it to be unimportant. *Id.* at 893-94. Here, similar to *In Re Peters*, the features not included in these reissue claims are described in the patent permissively, or as “unimportant.”

In *Antares*, this Court found that original claims directed to jet injectors including safety features could not be broadened on reissue to omit the “jet injector” limitation where the specification identified the invention as “jet injector” rather than a “safety feature.” *Id.* at 1362. *Antares* found that “serially mentioning” a feature that the patentee admitted was **not** the original invention was insufficient to find that

it was a “separate” invention. *Id.* But here, the claims were not broadened to omit an originally claimed feature, there is no admission of a “different invention,” and the “serially mentioned” features are alternative embodiments of the original invention itself.

Most recently, in *In Re Float’N’Grill*, this Court found that an original patent directed to a float apparatus with a grill supported by a plurality of magnets could not be broadened on reissue to omit the magnets because the specification described the magnets as “necessary.” 72 F.4th 1353. As discussed above with respect to *Industrial Chemicals*, no features described as “necessary” were omitted here.

The facts here most align with *In re Amos*, where this Court found that reissue claims directed to raising rollers electronically were permissible because the specification said rollers could be “raised either mechanically by the roller cams *or* electronically by the computer controlling the router.” 953 F.2d 613, 614 (Fed. Cir. 1991). Notably, if the interpretation of *Antares* used here had been applied to the *Amos* facts, the reissue claims would have been invalidated because there was no “explicit and unequivocal disclosure that the scope of the original invention is limited to [electronically raising rollers] ...to the exclusion of [mechanically raising rollers].” *See* District Court Order at 15, Appx000015.

The import of the District Court’s holding here is unprecedented. It means that if a specification discloses that a “box could be painted red, blue, or green,” a reissue

of that patent cannot claim a red box—it can only claim a box that is red, blue, or green (even where, as here, the original patent itself includes claims directed to a red box).

Significantly, every one of the preceding § 251 cases involved an examination of whether aspects of reissue claims that were broadened vis-à-vis the original *claims* were permissible. The facts of the present case are distinct—the challenged aspects of the reissue claims are *narrower* than the original claims, and the narrowed aspects are disclosed within the specification as alternative embodiments.

This Court’s affirmation of the District Court’s finding that features disclosed in a specification permissively, or in serial format, rather than allegedly as “separate and apart” from any other aspects of the invention presents a significant and unwarranted policy shift that will have far-reaching effects. Narrowing reissues are often sought to overcome prior art, and listing multiple optional or alternative embodiments is a common patent drafting practice. Indeed, the “satellite-based location-fixing protocol” claim aspect at issue here was added to the reissue claims during Patent Examiner negotiations. Review by an *en banc* panel of this Court is necessary to consider whether the District Court’s novel application of *Antares* contravenes § 251.

CONCLUSION

For the foregoing reasons, Appellants respectfully request this Court REVERSE the District Court's judgment AND REMAND for further proceedings.

///

Respectfully submitted,

/s/ Howard Wisnia

Howard Wisnia
howard@wisnialaw.com
Wisnia PC
12636 High Bluff Drive
Suite 400
San Diego, California 92130
858.461.0989 - Telephone

Karl Rupp
krupp@soreylaw.com
Sorey & Hoover LLP
One Liberty Place
101 N. 6th Street, Suite 502
Waco, Texas 76701
903.230.5600 - Telephone
903.230.5656 - Facsimile

Jessica Underwood
junderwood@nixlaw.com
Nathan Hall
nhall@nixlaw.com
Nicholas Wyss
nwyss@nixlaw.com
Nix Patterson, LLP
8701 Bee Caves
Building 1, Suite 500
Austin, Texas 78746
512.328.5333 - Telephone
512.328.5335 - Facsimile

Attorneys for Plaintiffs-Appellants

CERTIFICATE OF SERVICE

I, Howard Wisnia, a member of the Bar of this Court, hereby certify that on this 10th day of October 2023, I electronically filed the foregoing with the Court using the CM/ECF system. All counsel for Defendant-Appellee are registered CM/ECF users and will be served by the appellate CM/ECF system.

/s/ Howard Wisnia

Howard Wisnia

CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rules of Appellate Procedure 28 and 32 and Federal Circuit Rules 28 and 32, the undersigned hereby certifies that this brief complies with the type volume limitation of Federal Circuit Rule 32(b).

This brief complies with the type-volume limitation of Federal Circuit Rule 32(b) because this brief contains 3,849 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b)(2).

This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5)-(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word for Mac Version 16.63.1 in 14-point Times New Roman Font.

/s/ Howard Wisnia

Howard Wisnia

ADDENDUM

NOTE: This disposition is nonprecedential.

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

**IKORONGO TEXAS LLC, IKORONGO
TECHNOLOGY LLC,**
Plaintiffs-Appellants

v.

BUMBLE TRADING LLC,
Defendant-Appellee

2022-2044

Appeal from the United States District Court for the
Western District of Texas in No. 6:20-cv-00256-ADA, Judge
Alan D. Albright.

JUDGMENT

NATHAN HALL, Nix Patterson, LLP, Austin, TX, argued
for plaintiffs-appellants. Also represented by JESSICA
UNDERWOOD, NICHOLAS ANDREW WYSS; KARL RUPP, Sorey
& Hoover LLP, Waco, TX; HOWARD N. WISNIA, Wisnia PC,
San Diego, CA.

NOAH CAREY GRAUBART, Fish & Richardson P.C., At-
lanta, GA, argued for defendant-appellee. Also

represented by ASHLEY BOLT; RUFFIN B. CORDELL, Wash-
ington, DC; ANDREW PEARSON, Boston, MA.

THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (DYK, PROST, and STOLL, *Circuit
Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

September 8, 2023
Date

/s/ Jarrett B. Perlow
Jarrett B. Perlow
Clerk of Court