

22-1303, 22-1304

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

WILDCAT LICENSING WI LLC,

Appellant

v.

**ATLAS COPCO TOOLS AND ASSEMBLY SYSTEMS LLC,
GENERAL MOTORS LLC, FAURECIA AUTOMOTIVE
SEATING, LLC, and MAGNA INTERNATIONAL INC.**

Appellant

Appeal from the United States Patent Trial and Appeal Board in IPR2020-00891 and IPR2020-00892, before Administrative Patent Judges Browne, Jung, and Tartal

**APPELLANT WILDCAT'S COMBINED PETITION FOR PANEL
REHEARING AND REHEARING *EN BANC***

Robert Hart
Brandon C. Helms
Benjamin M. Cappel
ADDYHART P.C.
401 N. Michigan Ave, Ste. 1200-1
Chicago, Illinois 60611
732.991.7285
robert@addyhart.com
bhelms@addyhart.com
benjamin@addyhart.com

Jeffrey W. Salmon
JEFFREY W. SALMON LAW, LLC
320 Wilmette Ave.
Glenview, IL 60026
773.294.5581
jeff@jeffreywsalmonlawllc.com

Meredith Martin Addy
ADDYHART P.C.
10 Glenlake Parkway, Ste. 130
Atlanta, Georgia 30328
312.320.4200
meredith@addyhart.com

Peter F. Snell
Brad M. Scheller
**MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY AND POPEO, P.C.**
666 Third Avenue
New York, NY 10017
212.692.6850
pfsnell@mintz.com
bmscheller@mintz.com

February 22, 2024

Attorneys for Appellant Wildcat Licensing WI LLC

CERTIFICATE OF INTEREST

Counsel for Appellant Wildcat Licensing WI LLC, certifies:

1. **Represented Entities.** Provide the full names of all entities represented by undersigned counsel in this case. Fed. Cir. R. 47.4(a)(1).

Wildcat Licensing WI LLC

2. **Real Party in Interest.** 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. Fed. Cir. R. 47.4(a)(2).

None.

3. **Parent Corporations and Stockholders.** Provide the full names of all parent corporations for the entities and all publicly held companies that own 10 percent or more of the stock of the entities:

None.

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. Rule 47.4(a)(4).

(a) **Meena Seralathan**
Minz Levin Cohn Ferris Glovsky and Popeo, P.C.

(b) **Not applicable.**

5. **Related Cases.** Provide the case titles and numbers of any case known to be pending in this court 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).

- *Wildcat Licensing WI LLC v. Bayerische Motoren Werke AG, BMW Manufacturing Co., LLC, and BMW of North America, LLC* (C.A. No. 1:19-cv-00834-mn-jlh, D. Del.);
- *Wildcat Licensing WI LLC v. Faurecia Interior Systems, Inc., Faurecia Automotive Seating, LLC, Faurecia Madison Automotive Seating, Inc.,*

Faurecia Emissions Control Technologies, USA, LLC, and Faurecia Emissions Control Systems NA, LLC (C.A. No. 1:19-cv-00839-mn-jlh, D. Del.);

- *Wildcat Licensing WI LLC v. FCA US LLC, FCA Italy S.P.A., And Fiat Chrysler Automobiles N.V.* (C.A. No. 1:19-cv-00840-mn-jlh, D. Del.);
- *Wildcat Licensing WI LLC v. Ford Motor Company* (C.A. No. 1:19-cv-00842-mn-jlh, D. Del.);
- *Wildcat Licensing WI LLC v. General Motors LLC* (C.A. No. 1:19-cv-00843-mn-jlh, D. Del.);
- *Wildcat Licensing WI LLC v. Jaguar Land Rover Limited and Jaguar Land Rover North America, LLC* (C.A. No. 1:19-cv-00844-mn-jlh, D. Del.);
- *Wildcat Licensing WI LLC v. Lear Corporation And Lear Automotive Manufacturing, LLC* (C.A. No. 1:19-cv-00845-mn-jlh, D. Del.);
- *Wildcat Licensing WI LLC v. Magna International Inc., Magna International Of America, Inc., Magna Powertrain Inc., Magna Powertrain Of America, Inc., Magna Powertrain USA, Inc., Magna Seating of America, Inc., Magna Exteriors of America, Inc., Magna Closures of America, Inc., And Cosma International Inc.* (C.A. No. 1:19-cv-00846-mn-jlh, D. Del.).

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). See Fed. Cir. R. 47.4(a)(6).

None/Not Applicable.

Dated: February 22, 2024

By: /s/ Meredith Martin Addy
Meredith Martin Addy

TABLE OF CONTENTS

CERTIFICATE OF INTERESTi
TABLE OF AUTHORITIESiv
STATEMENT OF COUNSEL1
POINTS OF LAW OR FACTS OVERLOOKED OR
MISAPPREHENDED BY THE COURT2
ARGUMENT3
I. Introduction.....3
II. This Court Should Grant *En Banc* Review to Resolve the Conflict
Regarding the Proper Standard of Review For Determining Whether
An IPR Petitioner’s Reply Arguments Are “New.”6
III. The Court Should Grant *En Banc* Review to Ensure That the Board
Adheres to the Court’s “Guideposts” For Determining Whether Reply
Arguments Are in IPR “New.”9
A. The IPR Statute and the APA Require That IPR Petitions
Identify “With Particularity” the Evidence For Obviousness
Challenges, a Determination Requiring a *De Novo* Standard of
Review.....9
B. Applying the Abuse of Discretion Standard, the Panel in This
Case Departed From the Court’s “Guideposts,” in Conflict With
Ariosa and Section 312(a)(3).11
IV. The Panel Decision Further Erred in Affirming the Board’s Failure to
Consider the “Comparing” Limitation.15
V. This Case is an Excellent Vehicle Addressing the Questions
Presented.....16
CONCLUSION17
CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME
LIMITATIONS.....a

TABLE OF AUTHORITIES

Cases

<i>Apple Inc. v. Andrea Elecs.</i> , 949 F.3d 697 (Fed. Cir. 2020)	9
<i>Ariosa Diagnostics v. Verinata Health, Inc.</i> , 805 F.3d 1359 (Fed. Cir. 2015)	passim
<i>Corephotonics, Ltd. v. Apple Inc.</i> , 84 F.4th 990 (Fed. Cir. 2023)	passim
<i>Cybor Corp. v. FAS Techs., Inc.</i> , 138 F.3d 1448 (Fed. Cir. 1998)	5
<i>Ericsson Inc. v. Intell. Ventures I LLC</i> , 901 F.3d 1374 (Fed. Cir. 2018)	8
<i>Gechter v. Davidson</i> , 116 F.3d 1454 (Fed. Cir. 1997)	18
<i>Guerrero v. RJM Acquisitions LLC</i> , 499 F.3d 926 (9th Cir. 2007)	10
<i>Henny Penny Corp. v. Frymaster LLC</i> , 938 F.3d 1324 (Fed. Cir. 2019)	1, 9, 13, 17
<i>In re IPR Licensing, Inc.</i> , 942 F.3d 1363 (Fed. Cir. 2019)	1, 8
<i>In re Lueders</i> , 111 F.3d 1569 (Fed. Cir. 1997)	17
<i>In re NuVasive, Inc.</i> , 841 F.3d 966 (Fed. Cir. 2016)	1, 8, 13
<i>In re Zurko</i> , 142 F.3d 1447 (Fed. Cir. 1998)	6, 11
<i>Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	8, 10, 11, 12

KSR Intern. Co. v. Teleflex Inc.,
550 U.S. 398 (2007).....20

Lighting Ballast Control LLC v. Philips Elecs. N. Am. Corp.,
744 F.3d 1272 (Fed. Cir. 2014)7, 20

M & K Holdings, Inc. v. Samsung Elecs. Co.,
985 F.3d 1376 (Fed. Cir. 2021)18

MModal LLC v. Nuance Commc'ns, Inc.,
846 F. App'x 900 (Fed. Cir. 2021).....13

Netflix, Inc. v. DivX, LLC,
84 F.4th 1371 (Fed. Cir. 2023) 4, 11, 12

Oil States Energy Svcs. v. Greene's Energy Group,
137 S. Ct. 2239 (2018).....19

Provisur Techs., Inc. v. Weber, Inc.,
50 F.4th 117 (Fed. Cir. 2022)19

Rembrandt Diagnostics, LP v. Alere, Inc.,
76 F.4th 1376 (Fed. Cir. 2023)4, 8

SAS Institute, Inc. v. Iancu,
584 U.S. 357 (2018).....11

Statutes

35 U.S.C. § 312(a)(3)..... passim

STATEMENT OF COUNSEL

Based on my professional judgment, I believe the panel decision is contrary to the following precedent of this Court:

Corephotonics, Ltd. v. Apple Inc., 84 F.4th 990 (Fed. Cir. 2023); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324 (Fed. Cir. 2019); *In re IPR Licensing, Inc.*, 942 F.3d 1363 (Fed. Cir. 2019); *In re NuVasive, Inc.*, 841 F.3d 966 (Fed. Cir. 2016); and *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359 (Fed. Cir. 2015).

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

1. Whether the proper standard of review for determining whether the Board improperly relied on “new” arguments not raised in an IPR petition is *de novo* or abuse of discretion.

2. Whether under 35 U.S.C. § 312(a)(3)—which requires IPR petitions to “identif[y]...with particularity...the evidence that supports the grounds for the challenge to each claim”—the Board may hold a claimed invention obvious based upon a new theory relying on an embodiment of the prior art that was not identified in the IPR petition.

**POINTS OF LAW OR FACTS OVERLOOKED OR MISAPPREHENDED
BY THE COURT**

It is respectfully submitted that the panel decision overlooked or misapprehended the following points:

1. The panel decision misapprehended the proper standard of review when it erroneously held that “the Board did not abuse its discretion by considering the evidence and arguments raised in Atlas’ reply briefs,” as the determination whether an IPR petitioner has raised on reply a new theory of obviousness absent from the IPR petition is reviewed “de novo.” *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1008; 35 U.S.C. § 312(a)(3).

2. The panel decision misapprehended that Atlas’ reply briefs did not raise a “new theory” when Atlas argued for the first time on reply that IBM disclosed a “torque transducer,” even though the Petitions never used the word “transducer,” never argued that IBM disclosed a Hall-effect sensor that was part of a “torque transducer,” never argued that the IBM reference “suggests” a tool with a torque transducer, and never identified in its Petitions where IBM purportedly discloses a “torque transducer.”

3. The panel decision misapprehended that the basis for the Board’s finding on the “comparing” limitation was “reasonably discernible,” even though the Board was entirely silent on any analysis of the “comparing” limitation and the panel was forced to resort to “speculation.”

ARGUMENT

I. Introduction

A petitioner in *inter partes* review (“IPR”) may not raise “in reply, an entirely new theory of *prima facie* obviousness absent from the petition, even if the new theory is responsive to the patent owner’s response or the Board’s institution decision.” *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1008 (Fed. Cir. 2023) (quotations omitted). “[T]he Board walks a fine line when interpreting the scope of a petition and determining what arguments have been fairly presented.” *Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371, 1377 (Fed. Cir. 2023).

This Court’s jurisprudence is in conflict over the proper standard of review for determining whether the Board has successfully walked this “fine line.” One series of cases holds the standard is *de novo*, while the other holds that it is abuse of discretion. *Compare, e.g., Corephotonics*, 84 F.4th at 1008 (whether an IPR petitioner’s reply has improperly raised a new theory or argument “is a question of law we review *de novo*.”), *with Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1385 (Fed. Cir. 2023) (applying abuse of discretion standard to determination of whether IPR “reply arguments” constitute “new theories”).

In this case, the panel decision was a mirror-image of the Court’s conflicted jurisprudence. While citing the *de novo* standard articulated in the *Corephotonics* line of cases (see Op. at 6), the panel actually applied the abuse of discretion

standard, holding that “the Board did not abuse its discretion by considering the evidence and arguments raised in Atlas’ reply briefs.” Op. at 8.

The “question of the proper standard of review” is no mere “esoteric topic of interest only to law professors and appellate judges.” *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1474 (Fed. Cir. 1998) (Rader, J., dissenting-in-part). It “influences greatly both the trial judges who preside over the trial process and patent practitioners who must advise clients.” *Id.* In appeals from IPR proceedings, the issue is not only important but frequently occurring, as patent owners commonly dispute whether IPR petitioners have raised new reply arguments beyond the scope of their petitions.

In this case, the standard of review the panel applied was outcome-determinative of its decision. The Court has “set down certain guideposts for what is permitted in a petitioner’s reply.” *Corephotonics*, 84 F.4th at 1008-09. Among them, in *Ariosa* the Court established that a petitioner may not rely “on previously unidentified portions of a prior-art reference to make a meaningfully distinct contention on reply.” *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1368 (Fed. Cir. 2015). Whether a “contention on reply” is ultimately held to be “meaningfully distinct” from the arguments advanced in an IPR petition may easily turn on the proper standard of appellate review, as in this case.

Here, in direct conflict with *Ariosa*, the panel decision applied the abuse of discretion standard to affirm the Board’s obviousness findings based on “previously unidentified portions” of a prior art reference that Atlas never raised in its IPR Petitions. Atlas argued in the Petitions that the IBM reference “measures the applied torque with ‘a hall effect sensor.’” J.A. 1407. However, after Wildcat pointed out that Hall-effect sensors cannot measure torque without a torque transducer, Atlas argued for the first time on reply that the IBM’s Hall-effect sensor was *part* of a purported “torque transducer.” J.A. 980-981. Overstepping the guidepost established in *Ariosa*, the panel erroneously held that “the Board did not abuse its discretion” by considering this “new theory”—even though Atlas’ Petitions never even used the word “transducer” (much less “torque transducer”). Op. at 8.

This Court has repeatedly had occasion to consider the proper standard of review *en banc*, as it should here. *See, e.g., In re Zurko*, 142 F.3d 1447, 1449 (Fed. Cir. 1998) (*en banc* decision to determine standard of review for Board fact-finding); *Lighting Ballast Control LLC v. Philips Elecs. N. Am. Corp.*, 744 F.3d 1272, 1276 (Fed. Cir. 2014) (*en banc* decision determining proper standard of review for claim construction).

En banc review is warranted to resolve the conflict over the proper standard of review for determining whether an IPR petitioner’s arguments on reply are “new” and outside the scope of its petition. By resolving this important and recurring

question, the Court can ensure that the “guideposts” for the Board established in *Ariosa* and other cases are consistently followed.

II. This Court Should Grant *En Banc* Review to Resolve the Conflict Regarding the Proper Standard of Review For Determining Whether An IPR Petitioner’s Reply Arguments Are “New.”

There is a clear conflict in this Court’s jurisprudence regarding the proper standard of review for determining whether an IPR petitioner has improperly raised, and the Board has improperly relied on, “new” arguments not raised in an IPR petition.

In one line of cases, the Court has held that the proper standard is *de novo* review. *See Corephotonics*, 84 F.4th at 1008 (whether a reply has improperly raised a new theory or argument “is a question of law we review *de novo*.”); *In re IPR Licensing, Inc.*, 942 F.3d 1363, 1369 (Fed. Cir. 2019) (“Whether the Board improperly relied on new arguments is reviewed *de novo*.”); *In re NuVasive, Inc.*, 841 F.3d 966, 970 (Fed. Cir. 2016) (“whether a ground the Board relied on was ‘new,’ requiring a new opportunity to respond, is a question of law, subject to *de novo* review”).

In a conflicting line of cases, however, the Court has applied abuse of discretion, as it did in this case. *See Rembrandt*, 76 F.4th at 1385 (applying “abuse of discretion” to review Board’s determination whether IPR “reply arguments” were “new theories”); *Ericsson Inc. v. Intell. Ventures I LLC*, 901 F.3d 1374, 1380 (Fed.

Cir. 2018) (“the Board has discretion to determine whether a petition for inter partes review identified the specific evidence relied on in a reply and when a reply contention crosses the line from the responsive to the new.”); *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016) (“the Board's determinations that IBS exceeded the scope of a proper reply...are reviewed for an abuse of discretion.”); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330 (Fed. Cir. 2019) (abuse of discretion); *Apple Inc. v. Andrea Elecs.*, 949 F.3d 697, 705 (Fed. Cir. 2020) (abuse of discretion); *Netflix*, 84 F.4th at 1376 (abuse of discretion); Op. at 8.

Here, the panel decision was symptomatic of this conflict. While the panel cited the *de novo* standard articulated in the *Corephotonics* line of cases (see Op. at 6), the panel actually applied the abuse of discretion standard, holding that “the Board did not abuse its discretion by considering the evidence and arguments raised in Atlas’ reply briefs.” Op. at 8.

De novo review is the proper standard of review for this issue, however. As the Court correctly recognized in *Corephotonics*, “the newness restriction stems from the statutory mandate that the petition govern the IPR proceeding.” *Corephotonics*, 84 F.4th at 1008 (citing Section 312(a)(3)). While the abuse of discretion line of cases has sometimes cited Section 312(a)(3), the Court’s decisions

have generally focused on the regulation under which the Board determines the scope of a proper reply. *Intelligent Bio-Sys.*, 821 F.3d at 1370 (citing § 42.23(b)).

However, the determination whether an IPR petitioner’s reply advances a new theory not raised in the petition is not a matter of “fact-finding” to which the Board should be given deference, but a legal question closer to the construction of a pleading, since it requires careful comparison between IPR petition and the reply. The inquiry is not unlike the determination of “[w]hether an amended pleading relates back to an original pleading,” which is a “question of law, and is therefore reviewed de novo.” *Guerrero v. RJM Acquisitions LLC*, 499 F.3d 926, 932 (9th Cir. 2007).

Perpetuating the abuse of discretion line of cases undermines the “guideposts” this Court has established for the Board and will lead to further uncertainty for litigants. *Corephotonics*, 84 F.4th at 1008-09. Allowing the Board “discretion” to consider reply arguments that stray too far from the IPR petition is inconsistent with the statutory requirement that IPR petitions must “identif[y]...**with particularity**...the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3) (emphasis added). De novo review is required to ensure that the Board adheres to the “fine line” involved in “interpreting the scope of a petition and determining what arguments have been fairly presented.” *Netflix*, 84 F.4th at 1377.

This Court has granted *en banc* review to resolve the proper standard of review in other contexts and should do so here. *See, e.g., In re Zurko*, 142 F.3d at 1449; *Lighting Ballast*, 744 F.3d at 1276.

III. The Court Should Grant *En Banc* Review to Ensure That the Board Adheres to the Court’s “Guideposts” For Determining Whether Reply Arguments Are in IPR “New.”

A. The IPR Statute and the APA Require That IPR Petitions Identify “With Particularity” the Evidence For Obviousness Challenges, a Determination Requiring a *De Novo* Standard of Review.

“Much as in the civil litigation system it mimics, in an inter partes review the petitioner is master of its complaint.” *SAS Institute, Inc. v. Iancu*, 584 U.S. 357, 363 (2018). “The statute hinges inter partes review on the filing of a petition” and “makes the petition the center-piece of the proceeding both before and after institution.” *Id.* at 1358.

However, “unlike district court litigation ... the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute.” *Intelligent Bio-Sys.*, 821 F.3d at 1369. “A petitioner may not rely on a vague, generic, and/or meandering petition and later fault the Board for failing to understand what the petition really meant. Ultimately, it is the petitioner's burden to present a clear argument.” *Netflix*, 84 F.4th at 1377.

For these reasons, the IPR statute imposes a “‘newness’ restriction” that “prohibits the petitioner from raising, in reply, an entirely new theory of prima facie

obviousness absent from the petition, even if the new theory is responsive to the patent owner's response or the Board's institution decision." *Corephotonics*, 84 F.4th at 1008. The Court has stated that "[i]t is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify '*with particularity*' the 'evidence that supports the grounds for the challenge to each claim.'" *Intelligent Bio-Sys.*, 821 F.3d at 1369 (emphasis added) (quoting 35 U.S.C. § 312(a)(3)).

This determination requires the Board (and, on appeal, this Court) to compare the arguments made on reply with those in the IPR Petition. In *Ariosa*, the Board rejected the petitioner's "reliance, in its Reply submissions, on previously unidentified portions of a prior-art reference to make a meaningfully distinct contention." 805 F.3d at 1367. Whereas the "[p]etitions and declarations" had quoted "a generic statement in Dhallan," on reply the petitioner cited for the first time "specific embodiments of Dhallan" not mentioned in its petitions. *Id.*; *see also In re NuVasive, Inc.*, 841 F.3d 966, 972-973 (Fed. Cir. 2016) (holding patent owner had no "notice" where petitioner "did not include in its petition the same citations to or assertions about the Michelson passage" that it raised on reply); *MModal LLC v. Nuance Commc'ns, Inc.*, 846 F. App'x 900, 906-07 (Fed. Cir. 2021) (finding arguments "new" where the petition "did not mention" portions of the prior art as meeting the claim limitation).

Likewise, in *Henny Penny*, the petitioner had argued in the petition that it was necessary to “integrat[e] Iwaguchi’s sensor into Kauffman’s system” to meet the claimed limitation, but on reply relied on different aspects of the same prior art—arguing for the first time that that one could “add the processor of Iwaguchi and use the electrical signal from the sensor of Kauffman as a basis for the processor to calculate TPMs.” *Henny Penny*, 938 F.3d at 1331. The Court held that the Board properly disregarded the “new theory.” *Id.*

Ultimately, the “guideposts” the Court has established in *Ariosa* and other cases flow from the statutory requirement that IPR petitions must “identif[y]...*with particularity*...the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). Determining whether an IPR petitioner’s reply argument is “new” requires careful comparison with its pleading in IPR—the petition—which is a legal question requiring a *de novo* standard of review.

B. Applying the Abuse of Discretion Standard, the Panel in This Case Departed From the Court’s “Guideposts,” in Conflict With *Ariosa* and Section 312(a)(3).

The erroneous results that flow from applying a more stringent standard of review to this issue are manifest in this case. Applying the abuse of discretion standard, the panel in this case departed from *Ariosa* and the requirements of Section 312(a)(3) in affirming the Board’s decision based on a “new theory” that the IBM’s disclosure “taught” or “suggested” a torque transducer. That “new theory” was

never “identified” in Atlas’ Petitions. Indeed, what makes this case even more egregious is the second part which forms the basis of the Board’s own decision that IBM “suggested” a torque transducer—a position that was not even articulated by Atlas itself on reply but was a new theory of the Board’s own making.

According to the panel decision, Atlas’ reply briefs cited expert testimony which “clarified that a person of ordinary skill in the art would consider IBM’s hall effect sensor to [sic] collect the data necessary to measure torque and thus form a part of a torque transducer that can actually output a measured torque value.” Op. at 7. Thus, the panel concluded that “Atlas’ reply briefs did not introduce evidence involving a new theory, but merely confirmed Atlas’ assertions in its petitions concerning the functionality of a hall effect sensor,” and “the Board did not abuse its discretion by considering the evidence and arguments raised in Atlas’ reply briefs.” *Id.* at 7-8.

However, in its Petitions, Atlas *never* argued that IBM teaches a torque transducer, and worse, *never* used the word “transducer.” Rather, Atlas argued that IBM disclosed a Hall-effect sensor that *by itself* measured torque, arguing that “controller 6 measures the applied torque with a ‘hall effect sensor.’” J.A. 1407. After Wildcat established that Hall-effect sensors cannot measure torque without a torque transducer, Atlas changed its argument to assert for the first time on reply that “IBM teaches a hall-effect *torque transducer*/sensor.” J.A. 980-981 (emphasis

added). The only mention of a transducer in IBM is as a separate component in a separate disclosure of IBM, relating to position, not torque, identified as a “pull-wire position transducer.” J.A. 0297-0298.

Although the panel decision deemed Atlas’ reply argument regarding a “torque transducer” to be merely an argument about “the functionality of a hall effect sensor” identified in its Petitions, this is belied by the fact that Atlas’ own expert conceded that Hall-effect sensors alone cannot measure torque:

Q.How does the Hall-effect sensor measure torque?

A. In numerous ways and I think we talked about that before because *remember, none of these sensors we use to “measure torque.”* The physical underlying principles are different. Hall effect sensors are magnetometers. They measure changes in magnetic field, okay.

J.A. 1934, 22-J.A. 1935, 4 (Atlas’ expert deposition testimony). The panel decision cites to a page from Atlas’ expert deposition testimony not actually cited by Atlas’ in its reply brief to the Board. Op. at 7 (citing J.A. 2487 (103:9-10)). There, Atlas’ expert opined that the “Hall-effect sensor is a portion of the torque transducer.” J.A. 2487 (103:9-10). The panel appears to have concluded from this statement that Atlas’ argument was really about the Hall-effect sensor. However, Atlas’ expert went on to testify:

Q. What is measuring the torque, the tool – in IBM, the tool or the microcontroller?

A. The torque transducer in the tool is providing the signal to the microcontroller. The microcontroller is making decisions, right, about – you know, the data is being provided by the torque

transducer, which in this case it's got a – it includes a Hall-effect sensor. And then the microprocessor is reviewing those data values, if you will, and making decisions and comparisons compared to stored values.

...

- A. Hall-effect sensors...they're packaged *with other circuit components to form a transducer* which then could measure a physical signal like temperature, pressure, torque, position, speed. That's all dependent on the electronic packaging within that torque sensor or transducer.

J.A. 2487-2488 (103:25-104-10); J.A. 2495 (111:2-10) (emphasis added).

Thus, far from indicating—as the panel erroneously held—that Atlas' reply arguments simply elaborated on “the functionality of a hall effect sensor” itself, Atlas' expert explicitly pointed to the “torque transducer in the tool” and asserted that it “includes a Hall-effect sensor,” a position that Atlas never took in the Petitions. Indeed, Atlas' expert testified that Hall-effect sensors are “packaged with other circuit components to form a transducer.” Yet Atlas never “identified” these “other circuit components” in its Petitions, let alone identified a “torque transducer,” as required by Section 312(a)(3). Notably, on appeal Atlas largely ignored Wildcat's point that Atlas' “torque transducer” argument was improper and was never able to indicate where it had identified a “torque transducer” in its Petitions, because it had not. Under *Ariosa* and *Henny Penny*, Atlas' reply arguments were “new” and should not have been relied on by the Board.

Even Atlas' late-raised torque transducer argument never indicated that IBM "suggests" a "torque transducer," the ground ultimately adopted by the Board. J.A. 0046. Wildcat never had notice of this position, which differed from Atlas' reply argument that IBM *taught* a "torque transducer." See *In re Lueders*, 111 F.3d 1569, 1571-72 (Fed. Cir. 1997) (noting that "what a prior art reference teaches or *suggests*" are "two different inquiries"). For this additional reason, Wildcat was deprived of notice of the basis for the Board's ultimate determination. See *M & K Holdings, Inc. v. Samsung Elecs. Co.*, 985 F.3d 1376, 1385 (Fed. Cir. 2021); 35 U.S.C. § 312(a)(3).

Despite clear conflicts with *Ariosa* and section 312(a)(3), the panel held that the Board properly considered Atlas' reply arguments as a matter of the Board's "discretion." Op. at 8. This Court should grant *en banc* review to confirm that a *de novo* standard of review must be applied to this issue, in order to ensure that the requirements of section 312(a)(3) and the "guideposts" set forth in *Ariosa* are properly followed by IPR petitioners and the Board. Continued muddying of the waters will only increase unpredictable Board results for litigants.

IV. The Panel Decision Further Erred in Affirming the Board's Failure to Consider the "Comparing" Limitation.

In addition, the panel erroneously affirmed the Board's finding that IBM discloses the "comparing" limitation, even though the Board never addressed the "comparing" limitation. While the panel conceded that "the Board does not conduct

an explicit analysis of this limitation,” it held the Board’s finding was “reasonably discernable.” Op. at 10.

In doing so, however, the panel was forced to resort to speculation—exactly what this Court has held to be impermissible. *See Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997) (explaining that the Board must explain its reasoning with sufficient specificity to enable this court, “*without resort to speculation*,” to effectively evaluate the Board’s findings) (emphasis added).

The panel impermissibly created its own basis for affirmance, finding “comparison” to be “logically necessary” and citing a passage from Atlas’ expert testimony that was not cited for this proposition by the Board, or cited by the Board for *any* proposition. Op. at 10 (citing J.A. 2484 100:15-25). Here, the Board’s “logic” in finding that IBM discloses the “comparing” limitation is not “reasonably discernible”—since the “Final Written Decision[s] [do] not address the [comparing] limitation at all.” *Provisur Techs., Inc. v. Weber, Inc.*, 50 F.4th 117, 124 (Fed. Cir. 2022). This is a question of law requiring application of a de novo standard of review and reversal of this case.

V. This Case is an Excellent Vehicle Addressing the Questions Presented.

The fact that the panel’s decision was non-precedential should not dissuade Court from granting this Petition. First, the issues Wildcat raises in this Petition has fully percolated and the Court’s jurisprudence is now conflicted. Second, the mere

fact that a decision is non-precedential should not insulate it from post-panel review, as several important cases show. *See Oil States Energy Svcs. v. Greene's Energy Group*, 137 S. Ct. 2239 (2018) (cert. granted after Fed. Cir. Rule 36 affirmance); *KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) (cert. granted on nonprecedential opinion); *Lighting Ballast*, 744 F.3d 1272 (granting en banc review after nonprecedential panel opinion).

CONCLUSION

For the foregoing reasons, the panel should grant rehearing, or the Court should grant rehearing *en banc*.

February 22, 2024

Robert Hart
Brandon C. Helms
Benjamin Cappel
ADDYHART P.C.
401 N. Michigan Ave
Suite 1200-1
Chicago, Illinois 60611
732.991.7285
robert@addyhart.com
bhelms@addyhart.com
benjamin@addyhart.com

Jeffrey W. Salmon
**JEFFREY W. SALMON LAW,
LLC**
320 Wilmette Ave.
Glenview, IL 60026
773.294.5581
jeff@jeffreywsalmonlawllc.com

Respectfully submitted,

Meredith Martin Addy

Meredith Martin Addy
ADDYHART P.C.
10 Glenlake Parkway
Suite 130
Atlanta, Georgia 30328
312.320.4200
meredith@addyhart.com

Peter F. Snell
Brad M. Scheller
**MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY AND POPEO, P.C.**
666 Third Avenue
New York, NY 10017
212.692.6850
pfsnell@mintz.com
bmscheller@mintz.com

Attorneys for Appellant Wildcat Licensing WI LLC

**CERTIFICATE OF COMPLIANCE WITH
TYPE-VOLUME LIMITATIONS**

Wildcat Licensing WI LLC v. Atlas Copco Tools and Assembly Sys., et al
No. 23-1303, 23-1304

This brief complies with the relevant type-volume limitation of the Federal Rule of Appellate Procedure and Federal Circuit Rules because it has been prepared using a proportionally-spaced typeface and includes 3851 words.

Dated: February 22, 2024

By: /s/ Meredith Martin Addy
Meredith Martin Addy