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App. 1a
Federal Circuit Entry of Judgment with Opinion (2/13/20)

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

SAP AMERICA, INC.,
Plaintiff-Appellee

v.

LAKSHMI ARUNACHALAM,
Defendant-Appellant

2019-1794

Appeal from the United States District Court for the
Northern District of California in No. 4:13-cv-01248-PJH,
United States District Judge Phyllis J. Hamilton.

JUDGMENT

THIS CAUSE having been considered, it is

ORDERED AND ADJUDGED:

AFFIRMED

ENTERED BY ORDER OF THE COURT

February 13, 2020

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

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NOTE: This disposition is nonprecedential.

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

LAKSHMI ARUNACHALAM,
Plaintiff-Appellant

v.

PRESIDIO BANK,
Defendant-Appellee

2019-1223

Appeal from the United States District Court for the
Northern District of California in No. 3:12-cv-04962-TSH,
Magistrate Judge Thomas S. Hixson.

SAP AMERICA, INC.,
Plaintiff-Appellee

v.

LAKSHMI ARUNACHALAM,
Defendant-Appellant

2019-1794

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Appeal from the United States District Court for the Northern District of California in No. 4:13-cv-01248-PJH, Judge Phyllis J. Hamilton.

Decided: February 13, 2020

LAKSHMI ARUNACHALAM, Menlo Park, CA, pro se.

CANDICE C. DECAIRE, Kilpatrick Townsend & Stockton LLP, Seattle, WA, for defendant-appellee in 2019-1223. Also represented by ANDREW JAMES ISBESTER, San Francisco, CA.

THARAN GREGORY LANIER, Jones Day, Palo Alto, CA, for plaintiff-appellee in 2019-1794. Also represented by JOSEPH BEAUCHAMP, Houston, TX.

Before LOURIE, MOORE, and CHEN, *Circuit Judges*.

PER CURIAM.

Dr. Lakshmi Arunachalam, proceeding pro se, appeals two decisions from the U.S. District Court for the Northern District of California. The first relates to a patent infringement suit filed by Dr. Arunachalam against Presidio Bank. The second relates to a declaratory judgment action filed by SAP America, Inc. Both decisions concluded that Dr. Arunachalam was collaterally estopped from asserting the patents in question because many of the patent claims already had been invalidated in prior cases, and the remaining claims all suffered from the same defect that led to the invalidity of the previously litigated claims. *See Pi-Net Int'l Inc. v. JPMorgan Chase & Co.*, 42 F. Supp. 3d 579 (D. Del. 2014); *SAP Am. Inc. v. Arunachalam*, No. IPR2013-00194 (PTAB Sept. 18, 2014); *SAP Am. Inc. v. Arunachalam*, IPR2013-00195 (PTAB Sept. 18, 2014); *SAP Am. Inc.*

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v. Arunachalam, No. CBM2013-00013 (PTAB Sept. 18, 2014); and *SAP Am. Inc. v. Arunachalam*, No. CBM2014-00018 (PTAB Mar. 6, 2015). Because the decisions apply collateral estoppel for the same reasons, we address both cases together. For the reasons explained below, we *affirm*.

I. PROCEDURAL HISTORY

Dr. Arunachalam's case against Presidio Bank asserted patent infringement of numerous claims of U.S. Patent Nos. 5,987,500 (the '500 patent) and 8,108,492 (the '492 patent). SAP's case requested declaratory judgment of non-infringement of all claims for the '500 patent, the '492 patent, and U.S. Patent No. 8,037,158 (the '158 patent).

While these cases were pending, the U.S. District Court for the District of Delaware in *JPMorgan* invalidated claims 1–6, 10–12, 14–16, and 35 of the '500 patent; claims 1–8 and 10–11 of the '492 patent; and claim 4 of the '158 patent. *JPMorgan*, 42 F. Supp. 3d 579. Moreover, in addition to its declaratory judgment action, SAP also filed for inter partes review (IPR) and covered business method (CBM) review of those patents. The Patent Trial and Appeals Board (the Board) in the IPRs and CBMs entered its decisions after the district court in *JPMorgan* entered its decision. The Board found claims 1–6, 10–12, 14–17, and 35 of the '500 patent; claims 1–8 and 10–12 of the '492 patent; and claims 1–6 and 9–11 of the '158 patent unpatentable. Appeal Order, *Arunachalam v. SAP Am. Inc.*, No. 2015-1424 at 4 (Fed. Cir. Sept. 23, 2016). Dr. Arunachalam appealed the Board's decisions and we dismissed the appeal because Dr. Arunachalam was collaterally estopped from challenging the Board's decision in light of *JPMorgan*. *Id.* at 7. In our decision, we held Dr. Arunachalam collaterally estopped from challenging the Board's decision to invalidate claims that were not invalidated in *JPMorgan* because those claims "suffer[ed] from at least one of the same fatal lack-of-enablement flaws" as the claims

invalidated in *JPMorgan*. *Id.* at 5. In other words, because the additional claims suffered from the same invalidating defect as the claims invalidated in *JPMorgan*, we ruled that those additional claims likewise could not survive.

As a result, by the time the district court in the cases on appeal entered its decisions, the only claims not invalidated were claims 7–9, 13, and 18–34 of the '500 patent; claims 9 and 13 of the '492 patent; and claims 7 and 8 of the '158 patent. *See id.* at 3–4. Applying similar reasoning we used in our 2016 *Arunachalam* decision, the district court, in both decisions, held that Dr. Arunachalam was collaterally estopped from asserting all claims of the asserted patents, because the patent claims that had not been previously invalidated in earlier litigation nevertheless suffered from the same invalidating defect as the previously litigated claims.

II. DISCUSSION

When reviewing the application of collateral estoppel, we are “generally guided by regional circuit precedent, but we apply our own precedent to those aspects of such a determination that involve substantive issues of patent law.” *Ohio Willow Wood Co. v. Alps South, LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013). In the Ninth Circuit, “[c]ollateral estoppel applies to a question, issue, or fact when four conditions are met: (1) the issue at stake was identical in both proceedings; (2) the issue was actually litigated and decided in the prior proceedings; (3) there was a full and fair opportunity to litigate the issue; and (4) the issue was necessary to decide the merits.” *Oyeniran v. Holder*, 672 F.3d 800, 806 (9th Cir. 2012). “Where a patent has been declared invalid in a proceeding in which the ‘patentee has had a full and fair chance to litigate the validity of h[er] patent,’ . . . the patentee is collaterally estopped from relitigating the validity of the patent.” *Miss. Chem. Corp. v. Swift Agric. Chems. Corp.*, 717 F.2d 1374, 1376 (Fed. Cir. 1983) (quoting *Blonder-Tongue Labs., Inc. v. Univ. of Ill.*

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Found., 402 U.S. 313, 333 (1971)). Further, “[o]ur precedent does not limit collateral estoppel to patent claims that are identical. Rather, it is the identity of the *issues* that were litigated that determines whether collateral estoppel should apply.” *Ohio Willow Wood*, 735 F.3d at 1342 (emphasis in original).

To the extent that Dr. Arunachalam challenges the decisions in cases other than the cases directly on appeal here, including *JP Morgan* and the above-referenced Board decisions, Dr. Arunachalam was required to make those challenges in direct appeals from those cases. *See Pers. Audio, LLC v. CBS Corp.*, 946 F.3d 1348 (Fed. Cir. 2020); *Arunachalam v. Int’l Bus. Machs. Corp.*, 759 F. App’x 927 (Fed. Cir. 2019). As such, we will not address those challenges here. *See Pers. Audio*, 946 F.3d 1348; *Int’l Bus. Machs. Corp.*, 759 F. App’x 927. Regarding Dr. Arunachalam’s challenges and motions under *Fletcher v. Peck*, 10 U.S. (6 Cranch) 87 (1810), and “prosecution history estoppel” under *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (en banc), we have previously addressed these arguments, stating that “[t]he Supreme Court in *Oil States Energy Services, LLC v. Greene’s Energy Group, LLC*, — U.S.—, 138 S. Ct. 1365, 1375 & n.2, 1377–78, 200 L. Ed. 2d 671 (2018) rejected several similar constitutional challenges to the *inter partes* review process.” *Int’l Bus. Machs. Corp.*, 759 F. App’x at 933. Dr. Arunachalam has not provided any reason that the same reasoning does not apply to a district court’s authority to invalidate a patent. Accordingly, we reject Dr. Arunachalam’s constitutional challenges and deny her motions raising those same constitutional challenges.

As to Dr. Arunachalam’s challenges to the district court’s decisions on collateral estoppel, we agree with the district court that Dr. Arunachalam was collaterally estopped from asserting all claims under the ’500, ’492, and ’158 patents. First, we hold that Dr. Arunachalam continues to be collaterally estopped from challenging the

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invalidity of the claims held invalid in *JPMorgan* and the Board decisions. Appeal Order, *SAP Am. Inc.*, No. 2015-1424.

We next turn to the claims that were not addressed in the prior proceedings, which are claims 7–9, 13, and 18–34 of the '500 patent; claims 9 and 13 of the '492 patent; and claims 7 and 8 of the '158 patent. See Appeal Order, *SAP Am. Inc.*, No. 2015-1424, at 3–4.

As to the first condition for applying collateral estoppel (identical issue), we find that the remaining claims in the '500, '492, and '158 patents all rely on at least one of the claim terms found indefinite, not enabled, or failing written description by *JPMorgan* and that these remaining claims do not significantly alter the analysis of those terms. Claims 7–9, 13, and 18 of the '500 patent; claims 9 and 13 of the '492 patent; and claims 7 and 8 of the '158 patent are all dependent on previously invalidated independent claims and do not cure the deficiencies identified in the prior cases. See Appeal Order, *SAP Am. Inc.*, No. 2015-1424. Independent claims 19 and 27 of the '500 patent warrant closer analysis. These claims are directed to a “method of enabling object routing on a network” and “[a]n object router on a network.” In *JPMorgan*, the district court found several claims in the patents lacked enablement because “the specification does not actually define, in language that would allow a person of ordinary skill in the art to make and use the invention, what a ‘VAN switch’ is and how it accomplishes ‘object routing’ or real-time transactions.” *JPMorgan*, 42 F. Supp. at 592. The district court also found that “[t]he specification offers no explanation or information on any software programs.” *Id.* at 593. As such, the district court found that the term “object routing,” like “VAN switch,” was not enabled. *Id.* at 592–93. For claims 19 and 27, none of the claimed steps therein describe what object routing is or how it is accomplished. Thus, the limitations recited in these claims do not cure the lack of enablement identified in *JPMorgan*. Because

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claims 20–26 and 28–34 of the '500 patent are dependent on either claim 19 or 27 and do not cure the deficiencies in the enablement of “object routing,” they likewise fail for the same reason. Thus, the same issues are at stake in these litigations.

Regarding the second condition for collateral estoppel, whether the issues were previously litigated and decided, it is beyond dispute that the claim terms addressed in *JPMorgan* were previously litigated and finally decided. The third condition is whether Dr. Arunachalam was given a full and fair opportunity to litigate the issues. Dr. Arunachalam was represented by counsel in the motions for summary judgment in *JPMorgan*. We find this proceeding to be a full and fair opportunity to litigate the issues. Finally, for the fourth condition, the claim terms addressed in *JPMorgan* were determinative in the invalidity analysis. Thus, the issue of the validity of the remaining claims of the '500, '492, and '158 patents satisfies all four collateral estoppel conditions, and we find Dr. Arunachalam collaterally estopped from asserting these patents in the cases on appeal.

CONCLUSION

We have considered the rest of Dr. Arunachalam's arguments, including her requests to disqualify opposing counsel, and find them too skeletal and unpersuasive. Accordingly, we affirm the district courts' decisions that Dr. Arunachalam was collaterally estopped from asserting the '500, '492, and '158 patents. We have also considered Dr. Arunachalam's remaining motions and deny those motions.

AFFIRMED

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App. 9a
Federal Circuit Order on Petition for *En banc* Re-Hearing (4/9/20)

NOTE: This order is nonprecedential.

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

SAP AMERICA, INC.,
Plaintiff-Appellee

v.

LAKSHMI ARUNACHALAM,
Defendant-Appellant

2019-1794

Appeal from the United States District Court for the
Northern District of California in No. 4:13-cv-01248-PJH,
Judge Phyllis J. Hamilton.

ON PETITION FOR REHEARING EN BANC

Before PROST, *Chief Judge*, NEWMAN, LOURIE, DYK,
MOORE, O'MALLEY, REYNA, WALLACH, TARANTO, CHEN,
and HUGHES, *Circuit Judges**.

PER CURIAM.

O R D E R

* Circuit Judge Stoll did not participate.

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Appellant Lakshmi Arunachalam filed a petition for rehearing en banc. The petition was first referred as a petition for rehearing to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on April 16, 2020.

FOR THE COURT

April 9, 2020
Date

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

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App. 11a
District Court Order (4/2/19)

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

SAP AMERICA, INC.,

Plaintiff,

v.

LAKSHMI ARUNACHALAM,

Defendant.

Case No. 13-cv-01248-PJH

JUDGMENT

The issues having been duly heard and the court having granted plaintiff's motion for summary judgment,

it is Ordered and Adjudged

that judgment is hereby entered in favor of plaintiff on all of defendant's counterclaims of infringement of the patents-in-suit, U.S. Patent Nos. 8,037,158 ("the '158 Patent"), 5,987,500 ("the '500 Patent") and 8,108,492 ("the '492 Patent"), and against defendant on the same; and

that judgment is hereby entered in favor of plaintiff on its claims for declaratory judgment of non-infringement of the '158 Patent, the '500 Patent, and the '492 Patent, and against defendant on the same.

IT IS SO ORDERED.

Dated: April 2, 2019



PHYLLIS J. HAMILTON
United States District Judge

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

SAP AMERICA, INC.,

Plaintiff,

v.

LAKSHMI ARUNACHALAM,

Defendant.

Case No. 13-cv-01248-PJH

**ORDER RE CROSS MOTIONS FOR
SUMMARY JUDGMENT AND
VACATING HEARING**

Re: Dkt. Nos. 89, 93

Plaintiff SAP America, Inc. ("SAP") and defendant Dr. Lakshmi Arunachalam's ("Dr. Arunachalam") cross motions for summary judgment are before the court. The motions are fully briefed and this matter is suitable for decision without oral argument. Accordingly, the hearing set for April 10, 2019, is VACATED. Having read the parties' papers and carefully considered their arguments and the relevant legal authority, and good cause appearing, the court hereby rules as follows.

BACKGROUND

A. General Background

SAP filed this action on March 19, 2013, seeking a declaratory judgment of non-infringement of Dr. Arunachalam's patents: U.S. Patent Nos. 8,037,158 ("the '158 Patent"), 5,987,500 ("the '500 Patent") and 8,108,492 ("the '492 Patent") (together, the "patents-in-suit"). Dkt. No. 1. Pi-Net International, Inc. ("Pi-Net"), Dr. Arunachalam's company and her predecessor-in-interest in this case, counterclaimed asserting infringement of the patents-in-suit. Dkt. No. 49 at 6-8. On October 15, 2013, the court stayed this action pending the conclusion of ongoing reviews of the patents-in-suit by the Patent Trial and Appeal Board (the "PTAB"). Dkt. No. 54. This action remained stayed

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1 until December 2018 pending the completion of those reviews and defendant's
2 subsequent appeal to the Federal Circuit. Dkt. No. 90.

3 During the same period, the patents-in-suit were the subject of another
4 infringement action taking place in the District of Delaware, Pi-Net Int'l Inc. v. JPMorgan
5 Chase & Co., Civ. No. 12-282 (D. Del.) (henceforth "JPMorgan"). There, as discussed
6 below, the court found the claims asserted in that action to be invalid and granted
7 summary judgment against Pi-Net. Pi-Net Int'l Inc. v. JPMorgan Chase & Co., 42 F.
8 Supp. 3d 579, 596 (D. Del. 2014). That decision was rendered final after the Federal
9 Circuit dismissed Pi-Net's appeal, Pi-Net Int'l, Inc. v. JPMorgan Chase & Co., 600 F.
10 App'x 774, 775 (Fed. Cir. 2015) (Mem. Op.) (dismissing appeal), and Pi-Net's petition for
11 rehearing in the Federal Circuit, petition for a writ of certiorari, and petition for rehearing
12 at the Supreme Court were denied. Dkt. No. 94-13, Ex. M at 4 (the "PTAB Appeal
13 Order"), Arunachalam v. SAP America, Inc., No. 2015-1424, -1433, -1429, -1869, (Fed.
14 Cir. Sept. 23, 2016), cert. denied, 138 S. Ct. 129 (2017)).

15 Subsequent to the district court's decision in JPMorgan but prior to the Federal
16 Circuit's dismissal of the appeal, the PTAB completed its review of the patents-in-suit and
17 issued decisions finding the challenged claims invalid for multiple reasons. Dkt. Nos. 94-
18 1, 94-2, 94-3, 94-4 (Exs. A-D); PTAB Appeal Order at 4 (summarizing PTAB decisions).
19 The Federal Circuit subsequently stayed Dr. Arunachalam's PTAB-related appeals
20 pending final disposition of JPMorgan. PTAB Appeal Order at 4. After the Federal
21 Circuit dismissed the JPMorgan appeal, SAP moved to dismiss the pending PTAB-
22 related appeals based on collateral estoppel. Id. The Federal Circuit agreed and held
23 that "the final decision in JPMorgan bars any effort by [Dr. Arunachalam] to relitigate the
24 issue of whether the patent claims are invalid." Id. at 7.

25 SAP now moves for summary judgment in this action on the same grounds.

26 **B. Technology Overview**

27 The Federal Court has recently described the claimed technology as follows:

28 [T]he '158, '492, and '500 patents, [] share a specification and

1 relate to methods and apparatuses for providing “real-time,
2 two-way transactional capabilities on the Web.” When the
3 applications were filed, a Web user could largely perform only
4 one-way, browse-only interactions. The prior art Common
5 Gateway Interface (CGI) taught a standard interface for running
6 external programs on a Web server that enabled the creation
7 of documents dynamically when the server received a request
8 from the Web browser. However, according to the
9 specification, CGI only allowed for severely limited two-way
10 interactions because each CGI application had to be
11 customized for a particular type of application.

12 The patents purported to address this problem by proposing a
13 “configurable value-added network [(VAN)] switch for enabling
14 real-time transactions on the World Wide Web,” comprising
15 “means for switching to a transactional application in response
16 to a user specification from a World Wide Web application,
17 means for transmitting a transaction request from the
18 transactional application, and means for processing the
19 transaction request.” Another aspect of the inventions was a
20 routing method whereby information entries and attributes are
21 stored and associated with an object identity assigned a unique
22 network address.

23 PTAB Appeal Order at 2-3.

24 **C. Legal Standard**

25 **1. Summary Judgment**

26 Summary judgment is proper where the pleadings, discovery, and affidavits show
27 that there is “no genuine dispute as to any material fact and the movant is entitled to
28 judgment as a matter of law.” Fed. R. Civ. P. 56(a). Material facts are those which may
affect the outcome of the case. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248
(1986). A dispute as to a material fact is genuine if there is sufficient evidence for a
reasonable jury to return a verdict for the nonmoving party. Id. at 248-49.

29 The party moving for summary judgment bears the initial burden of identifying
30 those portions of the pleadings, discovery, and affidavits that demonstrate the absence of
31 a genuine issue of material fact. Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986).
32 When the moving party has met this burden of production, the nonmoving party must go
33 beyond the pleadings and, by its own affidavits or discovery, set forth specific facts
34 showing that there is a genuine issue for trial. Id. at 323-24. The court must view the
35 evidence in the light most favorable to the nonmoving party. See Tolan v. Cotton, 572

1 U.S. 650, 657 (2014). If the nonmoving party nevertheless fails to meet its burden, the
2 moving party wins.

3 **2. Collateral Estoppel**

4 The Federal Circuit applies “the law of the regional circuit to the general
5 procedural question of whether issue preclusion applies.” Soverain Software LLC v.
6 Victoria's Secret Direct Brand Mgmt., LLC, 778 F.3d 1311, 1314 (Fed. Cir. 2015).
7 “However, for any aspects that may have special or unique application to patent cases,
8 Federal Circuit precedent is applicable.” Aspex Eyewear, Inc. v. Zenni Optical Inc., 713
9 F.3d 1377, 1380 (Fed. Cir. 2013). That includes “issues of issue preclusion that implicate
10 substantive patent law issues, or issues of issue preclusion that implicate the scope of
11 [the Federal Circuit’s] own previous decisions.” Soverain Software, 778 F.3d at 1314.

12 “Issue preclusion,” also known as collateral estoppel, “is designed to bar[]
13 successive litigation of an issue of fact or law actually litigated and resolved in a valid
14 court determination.” Paulo v. Holder, 669 F.3d 911, 918 (9th Cir. 2011) (alteration in
15 original; internal quotation marks omitted). “The party asserting issue preclusion must
16 demonstrate: (1) the issue at stake was identical in both proceedings; (2) the issue was
17 actually litigated and decided in the prior proceedings; (3) there was a full and fair
18 opportunity to litigate the issue; and (4) the issue was necessary to decide the merits.”
19 See Howard v. City of Coos Bay, 871 F.3d 1032, 1041 (9th Cir. 2017) (internal quotation
20 marks omitted).

21 “[W]here a patent has been declared invalid in a proceeding in which the patentee
22 has had a full and fair chance to litigate the validity of his patent, the patentee is
23 collaterally estopped from relitigating the validity of the patent.” Miss. Chem. Corp. v.
24 Swift Agric. Chems. Corp., 717 F.2d 1374, 1376 (Fed. Cir. 1983) (internal quotation
25 marks omitted). In the patent context, collateral estoppel is not limited “to patent claims
26 that are identical. Rather, it is the identity of the issues that were litigated that determines
27 whether collateral estoppel should apply.” Ohio Willow Wood Co. v. Alps South, LLC,
28 735 F.3d 1333, 1342 (Fed. Cir. 2013) (emphasis in original). “If the differences between

the unadjudicated patent claims and adjudicated patent claims do not materially alter the question of invalidity, collateral estoppel applies.” Id.

D. Analysis

1. JPMorgan Found Certain Claims Of The Patents-In-Suit Invalid

In JPMorgan, Pi-Net asserted the following claims: **'158 Patent:** claim 4;¹ **'492 Patent:** claims 1-8, and 10-11; **'500 Patent:** claims 1-6, 10-12, 14-16, and 35. JPMorgan, 42 F. Supp. 3d at 588-94. Following claim construction, the JPMorgan court found the asserted claims invalid and entered summary judgment in favor of JPMorgan. Id. at 596. JPMorgan first found the claims invalid because they recited indefinite claim terms, including “VAN switch,” “switching,” “service network” and “value-added network system.” Id. at 588-92. Next, the district court found the asserted claims invalid because they lacked enablement. Id. at 592-93.² Accordingly, because the claims were invalid, the district court “grant[ed] [JPMorgan’s] motion for non-infringement of all asserted claims of the patents-in-suit,” id. at 595-95, and, as discussed above, that decision became final after Pi-Net exhausted all avenues of review.

2. Applying Collateral Estoppel, The Federal Circuit Holds That JPMorgan Implicitly Invalidated Additional Claims

As noted above, after the PTAB completed its reviews of the patents-in-suit, the Federal Circuit dismissed Dr. Arunachalam’s subsequent appeal because application of collateral estoppel barred Dr. Arunachalam from not only relitigating those claims directly at issue in JPMorgan but also the additional claims considered by the PTAB:

Collateral estoppel here properly rests upon 35 U.S.C. § 112, which requires “one skilled in the art, having read the

¹ Though the JPMorgan plaintiff only asserted infringement of claim 4 of the '158 Patent, JPMorgan invalidated that claim based on its dependence on claim 1, which the court found invalid. JPMorgan, 42 F. Supp. 3d at 591-92.

² The JPMorgan court also found that the “patents-in-suit [were] invalid for lack of written description.” See JPMorgan, 42 F. Supp. 3d at 593-94. Because the court concludes that collateral estoppel applies here based on JPMorgan’s indefiniteness and lack of enablement holdings, it does not reach the issue of whether collateral estoppel may also rest on JPMorgan’s finding that the patents-in-suit lack a sufficient written description.

specification, [to be able to] practice the invention without 'undue experimentation.'" Streck, Inc. v. Research & Diagnostic Sys., Inc., 665 F.3d 1269, 1288 (Fed. Cir. 2012) (internal citation omitted). Claim 4 of the '158 patent, claims 1–8 and 10–11 of the '492 patent, and claims 1–6, 10–12, 14–16, and claim 35 of the '500 patent were found invalid in JPMorgan. Claims 1, 2, 3, 5, 6, and 9–11 of the '158 patent, claim 12 of the '492 patent, and claim 17 of the '500 patent were not asserted in JPMorgan. But each of those claims suffers from at least one of the same fatal lack-of-enablement flaws: the district court in JPMorgan found that nothing in the intrinsic evidence of the '158 patent teaches how to make or use the "point of service application" limitation also recited in claims 1–3, 5, 6, and 9–11; and the remaining '492 and '500 patent claims also recite the VAN switch limitation.

PTAB Appeal Order at 7.

In short, the Federal Circuit held that the lack-of-enablement flaw litigated in JPMorgan applied to (and collaterally estopped litigation about) the following additional claims not explicitly addressed in JPMorgan: **'158 Patent**: 1-3, 5, 6, and 9-11; **'492 Patent**: 12; **'500 Patent**: 17. Id.

3. Collateral Estoppel Applies to All Remaining Claims Of the Patents-In-Suit

Here, defendant's counterclaim does not specify which claims she believes SAP infringed on, so the court assumes that all claims of the three patents-in-suit are asserted. However, as discussed above, many of those claims have already been held or recognized as invalid by JPMorgan or the Federal Circuit. Accounting for those claims, the following claims remain: **'158 Patent**: 7-8; **'492 Patent**: 9 and 13; **'500 Patent**: 7-9, 13, and 18-34. See Dkt. Nos. 94-6, 94-7, 94-8.

To apply collateral estoppel to the remaining claims, the court must determine whether the issues at stake here are identical to those decided in JPMorgan. As the Federal Circuit concluded, the court answers that question in the affirmative. Therefore, JPMorgan's determination about those identical issues applies to the additional remaining claims at issue here. See Ohio Willow Wood, 735 F.3d at 1342.

The two remaining '158 claims are invalid because both claims depends on claim 6—a claim that the Federal Circuit previously found invalid because it lacked enablement.

PTAB Appeal Order at 5 (relying on JPMorgan's finding that "nothing in the intrinsic evidence of the '158 patent teaches how to make or use the 'point of service application' limitation"). And those claims do not cure the lack-of-enablement flaws identified by JPMorgan and recognized by the Federal Circuit. Nor do they provide limitations that sufficiently define the indefinite terms identified by JPMorgan.

The court also finds that JPMorgan's reasoning extends by necessary implication to the two remaining '492 Patent claims. Claim 9 depends on but does not cure the indefinite terms present in claim 1—a claim that JPMorgan previously found invalid. JPMorgan, 42 F. Supp. 3d at 589. Claim 13 depends on a claim that the Federal Circuit previously found JPMorgan implicitly invalidated, see PTAB Appeal Order at 5 (applying JPMorgan to claim 12), without providing any curative limitations.

Lastly, the court finds that the issues decided in JPMorgan with respect the '500 Patent apply equally to the remaining 21 '500 patent claims at issue here. First, claims 7-9, 13, and 18 depend on claims that JPMorgan previously invalidated but do not cure the flaws identified by JPMorgan. See JPMorgan, 42 F. Supp. 3d at 591; Dkt. 94-7, Ex. G at 10:22-11:26. Second, independent claims 19 and 27 describe a "method for enabling object routing" or "[a]n object router." Dkt. 94-7, Ex. G at 11:27-36, 12:3-12. JPMorgan found that the specification relating to object routing lacked enablement, JPMorgan, 42 F. Supp. 3d at 592-93, and claims 19 and 27 do not cure that defect. The remaining claims depend on, without curing, claims 19 and 27.

With identical issues at stake in this action and JPMorgan, the court next turns to whether the other three collateral estoppel requirements have been met. As is likely clear from the above discussion, the issues discussed above were actually disputed and necessary to JPMorgan's decision invalidating the claims and granting summary judgment. In addition, like the Federal Circuit, the court concludes that "it is clear from JPMorgan that the issue of whether the patent enables one of ordinary skill in the art to practice the contemplated transaction" and whether the patent terms are sufficiently definite "was determined after Dr. Arunachalam's company, represented by counsel, had

a full and fair opportunity to present argument, evidence and expert testimony.” PTAB Appeal Order at 5.

None of Dr. Arunachalam's arguments persuade the court that collateral estoppel should not apply here. Indeed, Dr. Arunachalam's briefing does not engage on that issue. Dr. Arunachalam instead opts to level attacks on members of the judiciary and opposing counsel, while also contending that certain Federal Circuit and United States Supreme Court decisions are contrary to the United States Constitution. Those arguments, and Dr. Arunachalam's other arguments, are baseless and have been repeatedly rejected. See PTAB Appeal Order at 7; Arunachalam v. Int'l Bus. Machines Corp., No. 2018-2105, 2019 WL 350760, at *4 (Fed. Cir. Jan. 28, 2019); Arunachalam v. Apple, Inc., No. 5:18-CV-01250-EJD, 2018 WL 5023378, at *1 (N.D. Cal. Oct. 16, 2018).

CONCLUSION

For the foregoing reasons, the court concludes that the doctrine of collateral estoppel renders each of the claims of the patents-in-suit invalid for the reasons discussed above and further discussed in JPMorgan. Therefore, plaintiff is estopped from asserting the validity of the patents-in-suit in this infringement action against SAP. See Cygnus Telecommunications Tech., LLC v. Am. Int'l Telephonics, LLC, 569 F. Supp. 2d 1035, 1037 (N.D. Cal. 2008) (“in the patent infringement [] [context], a judgment of invalidity in a case collaterally estops the patent owner from asserting validity of those patent[s] in another case.”). For that reason, Dr. Arunachalam's motion for summary judgment is DENIED. Conversely, the court GRANTS summary judgment in favor of SAP on Dr. Arunachalam's counterclaims and GRANTS SAP summary judgment on its claim for a declaratory judgment of non-infringement.

IT IS SO ORDERED.

Dated: April 2, 2019



PHYLLIS J. HAMILTON
United States District Judge