

No. ____

IN THE
Supreme Court of the United States

IKORONGO TECHNOLOGY LLC AND
IKORONGO TEXAS LLC,
Petitioners,

v.

BUMBLE TRADING, LLC
Respondents.

**On Petition for a Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit**

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Patent Owner and Petitioner obtained reissue patents with new patent claims, which broadened certain limitations and narrowed others vis-à-vis the original patent claims. The district court held the new claims invalid for failing to meet the “original patent” requirement of 35 U.S.C. §251. In doing so, the district court refused to compare the new claims to the originally issued claims to determine if they were directed to the same invention disclosed and claimed in the original patent, holding it was prohibited from doing so under *Antares Pharma, Inc. v. Medac Pharma Inc.*, 771 F.3d 1354 (Fed. Cir. 2014). The court of appeals endorsed this reasoning *sub silentio* by summary affirmance.

The question presented is:

Should *Antares Pharma, Inc. v. Medac Pharma Inc.*, 771 F.3d 1354 (Fed. Cir. 2014) be overruled as in direct contradiction to this Court’s decision in *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals, Corp.*, 315 U.S. 668 (1942)?

PARTIES TO THE PROCEEDINGS BELOW

The parties to the proceedings below were:

Plaintiffs/Petitioners Ikorongo Texas LLC and
Ikorongo Technology LLC,

Defendant/Respondent Bumble Trading, LLC.

CORPORATE DISCLOSURE STATEMENT

Petitioners Ikorongo Texas LLC and Ikorongo
Technology LLC have no parent corporations and no
publicly held corporation owns more than 10% of
either company.

RELATED PROCEEDINGS

Under Rule 14.1(b)(iii), Petitioners note the
following proceedings directly related to this case:

**IKORONGO TEXAS LLC v. BUMBLE TRADING
LLC**, No. 6:20-cv-00256-ADA, U.S. District Court for
the Western District of Texas. Judgment entered
April 20, 2022.

**IKORONGO TEXAS LLC v. BUMBLE
TRADING LLC**, No. 2022-2044, U.S. Court of Appeals
for the Federal Circuit. Judgment entered September
8, 2023. Order denying petition for *en banc* rehearing
entered November 13, 2023.

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INTRODUCTION

The Federal Circuit’s decision directly contradicts this Court’s decision in *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals, Corp.*, 315 U.S. 668 (1942) and is inconsistent with the text and purpose of the remedial reissue statute.

Consistent with *Industrial Chemicals*, courts – including the Federal Circuit itself – regularly compared the new reissue claims to the originally issued patent claims in considering compliance with the original patent requirement under 35 U.S.C. § 251 for decades. And consistent with the remedial nature of the reissue statute, most broadening reissue patents were held to meet the requirement. Yet, that changed with the Federal Circuit’s decision in *Antares Pharma, Inc. v. Medac Pharma Inc.*, 771 F.3d 1354 (Fed. Cir. 2014). In the decade since that decision, the Federal Circuit has not upheld the validity of any reissue patent challenged for allegedly failing to meet the original patent requirement.

Here, the court of appeals affirmed the district court’s application of the dubious legal standard laid out in *Antares* in a heretofore unprecedented manner—to forbid consideration of the original patent claims in its “original patent” analysis of the reissue claims. It also found *Antares* required that the “particular combinations” of the reissue claims be “clearly and unequivocally” disclosed “separate and apart” from other aspects of the invention.

This holding is in stark and consequential conflict with well-established precedent of this Court. Specifically, in *Industrial Chemicals*, this 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 this Court is that 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 (emphasis added).

Contrary to this clear precedent, the court of appeals affirmed the district court’s legally erroneous order based on its *Antares* decision, which is wholly inconsistent with the statute and with *Industrial Chemicals*. This deviation from precedent is also 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 found to violate the original patent requirement are actually *narrower* than the original patent claims. A logical byproduct of the 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.

This conflict raises significant questions of law and, if left unaddressed, undermines 35 U.S.C. § 251’s remedial purpose.

The petition for a writ of certiorari should be granted.

PETITION FOR A WRIT OF CERTIORARI

Petitioners Ikorongo Technology LLC and Ikorongo Texas LLC respectfully petition this Court for a writ of *certiorari* to the United States Court of Appeals for the Federal Circuit, vacating the holding of invalidity and remanding the case for further proceedings consistent with that holding.

OPINIONS BELOW

The order of the U.S. District Court for the Western District of Texas granting Bumble’s motion for summary judgment of invalidity of the patents-in-suit for failure to comply with the “original patent” requirement of 35 U.S.C. §251 is reported at *Ikorongo Tech., LLC v. Bumble Trading, LLC*, 598 F. Supp. 3d 500 (W.D. Tex. 2022). It is also reproduced at pages 3a-27a of the appendix to this petition. The Federal Circuit affirmed without opinion, and its judgment is unpublished and reproduced at pages 1a and 2a of the Appendix. The Federal Circuit denied Ikorongo’s petition for rehearing *en banc* in an unpublished order, which is reproduced at Appendix pages 28a and 29a.

JURISDICTION

The court of appeals rendered its decision on September 8, 2023. It denied rehearing on November 13, 2023. On February 5, 2024, Chief Justice Roberts granted an extension of time to file this petition for a writ of certiorari until April 11, 2024. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

This petition involves 35 U.S.C. § 251 (Reissue of Defective Patents). The statutory language is reproduced at pages 30a and 31a of the Appendix.

STATEMENT OF THE CASE

This case arises from a patent-infringement case involving U.S. Patent Nos. RE45,543 (“543 Reissue”) and RE47,704 (“704 Reissue”) (collectively, the “Reissue Patents”), both of which are reissues of U.S. Patent No. 7,080,139 (“139 Patent” or “Original Patent”). Ikorongo owns the Reissue Patents. Bumble operates an online dating / social networking app that Ikorongo asserts infringes claims 57, 63, 64, 66, 68 and 70 of the ’543 Reissue and claims 33, 34, 38, 45, and 46 of the ’704 Reissue (collectively, the “Reissue Claims”). The district court granted summary judgment in favor of Bumble, finding that the asserted claims were invalid for failing to comply with the “original patent” requirement of 35 U.S.C. § 251. *See* Appendix at page 3a.

The Original Patent

The title of the Original Patent reads “Method and Apparatus for Selectively Sharing and Passively Tracking Communication Device Experiences.” FC-Appx000243.¹ The abstract describes the invention as follows:

The present invention includes methods and devices for passively tracking and

¹ Citations to the appendix before the U.S. Court of Appeals for the Federal Circuit are abbreviated herein as “FC-Appx.”

selectively sharing user experiences with communication devices, including computers, web-enabled telephones, and PDAs. User rating or comments on their experiences can be captured.

Id.; accord FC-Appx000263 at 2:26-28 (Detailed Description) (“A common theme among aspects of the present invention is collecting data regarding a user’s computer usage experience and sharing that data.”).

The abstract then explains that “[p]articular aspects of the present invention are described in the claims, specification and drawings.” FC-Appx000243.

The overview section describes tracking communication device activity. FC-Appx000264. Activity can be tracked in three general areas (or “domains”): “Internet activity 120, wireless network location track and interaction activity 121 and enterprise intranet activity 122.” FC-Appx000264-000265 at 4:65-5:1. The patent specifies the types of activities that can be tracked in these domains: “view, listen, rate, comment, assign emoticon, send, watch, download, bookmark or visit.” FC-Appx000265 at 5:1-3. The specification then provides examples of such activities:

A user views a URL, watches a visual presentation and listens to an audio presentation. A user visits a restaurant or other location.

FC-Appx000265 at 5:3-5. “At least a portion of the user’s computer usage experiences are tracked.” FC-Appx000271 at 18:38-39. The specification also explains that some users who “view[], watch[], listen[], or visit[]” may choose to respond to such an

“experience” by rating or commenting on it. *Id.* at 5:5-9. Those “responses” can also be tracked. *Id.* at 5:1-3.

The Original Patent has 32 claims (the “Original Claims”), including independent Claims 1, 31, and 32 (Claims 2-30 depend directly or indirectly on Claim 1). FC-Appx000272-000273. Original Claim 1 describes a method of collecting and sharing both internet-usage activity information and location activity information:

1. A method of sharing computer user experiences, including:

- communicating with a registration server to register a user, for automatic client-side collection of computer usage experiences for future sharing, wherein the computer-usage experiences include one or more of browsing URLs or visiting a location with a location-aware device that records the visited location;

- accessing one or more of the user’s messaging buddy lists and selecting one or more buddies with whom to share the automatically collected computer usage experiences;

- defining categories of computer usage experiences to be shared with particular selected buddies;

- tracking automatically on the client-side at least a portion of the user’s computer usage experiences and reporting the user’s computer usage experiences to a tracking server to be published to the particular buddies in

accordance with their defined categories of sharing.

FC-Appx000272 at 20:19-37. Original Claim 31 then describes a similar invention that tracks and shares the “Internet browsing experiences” and “Internet usage” activity but is silent as to location information. FC-Appx000273. And Original Claim 32 describes the converse—an invention that tracks and shares the location data:

32. A method of sharing computer user experiences, including:

registering a user with a registration server to collect and share visited location data using a client-side application collected while visiting a location with a location-aware device that records the visited location;

accessing one or more of the user’s messaging buddy lists to identify one or more buddies with whom the tracking data may be shared;

defining rights of the buddies to access the visited location data;

posting at least a portion of the user’s visited location data for the buddies to access according to their defined rights.

Id. at 22:23-37.

The Reissue Patents and the Asserted Claims

The Reissue Patents were both filed as broadening reissues.² However, the Reissue Claims at issue are not broader in all respects. Indeed, as the district court noted, “many of the disputed aspects are ***narrower*** than the original claims.” FC-Appx000011.

For example, Claim 33 of the ’704 Reissue reads as follows:

A method of operation of a location-aware cellular phone device comprising:

 sending registration information to a registration server from the location-aware cellular phone device;

 enabling access to one or more lists of other users to identify one or more other users with whom visited geographic location data is to be shared;

 enabling definition of access rights for the one or more other users to access the visited geographic location data;

² The original reissue application was filed on July 14, 2008—within two years of the Original Patent’s issue date. *See* FC-Appx000302 at 1:15-24. The ’543 Reissue and ’704 Reissue were ultimately issued in 2015 and 2019, respectively, following a series of reissue applications. *See id.*; FC-Appx000345 at 1:15-37; *see also In re Staats*, 671 F.3d 1350, 1355-56 (Fed. Cir. 2012) (recognizing that later broadening reissue applications can be filed during the pendency of other broadening reissue applications).

collecting the visited geographic location data for geographic locations visited by the location-aware cellular phone device using a client-side application, the visited geographic location data comprising a plurality of the geographic locations visited by the location-aware cellular phone device, each geographic location visited time-stamped with a time of visit, the geographic locations visited automatically and passively recorded by the location-aware cellular phone device using a satellite-based location-fixing protocol and a detection network directory; and

reporting information indicating the visited geographic location data collected by the location-aware cellular phone device.

FC-Appx000355.

The district court found that Claim 33 of the '704 Reissue was representative of the asserted claims for purposes of the original patent analysis here.

The Underlying Litigation

Ikorongo brought the underlying patent-infringement claims on March 31, 2020. FC-Appx000024, Dkt. No. 1. Following discovery, Bumble moved for summary judgment of invalidity under 35 U.S.C. § 251. The district court issued a Memorandum Opinion and Order (“Order”) granting the motion on April 12, 2022, *see* Appendix at 3a to 27a.

The district court identified three aspects common to the Reissue Claims: (1) “collecting ‘visited geographic location data;’ (2) sharing such visited geographic location data . . . separate and apart from sharing general experiences; and (3) using a satellite-based location-fixing protocol.” Appendix at 20a. The district court found that aspect (1) satisfied § 251’s original-patent requirement, but that aspects (2) and (3) did not. *See* Appendix at 20a to 25a. In reaching its decision, the district court considered the Original Patent’s specification, but refused to consider the Original Claims. *See* Appendix at 18a and 26a.

Ikorongo timely appealed. The court of appeals summarily affirmed the district court’s order without opinion and denied Ikorongo’s petition for rehearing *en banc*. This petition follows.

REASONS FOR GRANTING THE WRIT

I. The *Antares* Rule preventing consideration of the Original Claims Conflicts with the Statute and *Industrial Chemicals*

The district court expressly held that *Antares* prevented it from considering the original patent claims in its Section 251 analysis. Appendix at 18a and 26a. In summarily affirming the district court, the court of appeals, *sub silentio*, adopted this bright line rule, 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 historical practice of this Court and the lower courts 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 Petitioner has seen, broadened) aspects. In *Industrial Chemicals*, this 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 (emphasis added).

This 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, this 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 (emphasis added). 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.

The court of appeals had done the same in cases applying Section 251, before *Antares*. In *In Re Peters*, the court of appeals 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). The court then examined the specification to determine whether the originally claimed tip configuration was critical to the invention. *Id.*

Even in *Antares*, the court of appeals compared the reissue claims to the original claims. 771 F.3d at 1356. In doing so, the 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 precluding examination of the original claims is contrary to the plain text of 35 U.S.C. § 251 and the clear precedent of *Industrial Chemicals*.

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, FC-Appx000355; *cf.* Claim 32 of '139 Patent, FC-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. FC-Appx000012-15.

Likewise, the originally issued claims disclose sharing “responses” (e.g., comments, ratings) as dependent claims, and therefore are not “necessary” to the invention. *See, e.g.*, FC-Appx000273 (Original Claims 27 and 28 (providing annotation tools for associating for notes/ratings with tracking entries)). 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 lower courts’ 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.*” Appendix at 18a (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 (emphasis added). 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.* (emphasis added).

Further, there is no good policy reason to ignore the original claims in an “original patent” analysis under §251. Section 251 is intended to be remedial, and this Court has specifically recognized that “[t]he object of the patent law is to secure to inventors a monopoly of what they have actually invented . . . and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation.” *Topliff v. Topliff*, 145 U.S. 156, 171 (1892) (discussing an earlier version of the reissue statute). In fact, consideration of the original patent claims can only foster the consideration of whether or not the reissue claims are to the same invention as the original patent.

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

The lower court’s error in ignoring the original claims was compounded by the 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 Appendix at 15a to 16a; Appendix at 17a (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.” See Appendix at 16a. This same erroneous standard has now been cited by the court of appeals in *Forum U.S., Inc. v. Flow Valve, LLC*, 926 F.3d 1346, 1352 (Fed. Cir. 2019), *Cioffi v. Google LLC*, No. 2018-1049, 2023 WL 2981491 at *4 (Fed. Cir. Apr. 18, 2023), *cert. denied*, No. 23-421 (Nov. 13, 2023) and *In re Float’N’Grill*, 72 F.4th 1347, 1351 (Fed. Cir. 2023). Indeed, the court of appeals has not affirmed the patentability of any reissue under the “original patent” requirement of § 251 since *Antares’s* introduction of this new “standard.”

But this language from *Antares* is inappropriate, judge-made law created of whole-cloth. It 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.”

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 did not so limit its reasoning. Rather, it created 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 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. *Microsoft Corp. v. I4I Limited Partnership*, 564 U.S. 91, 95 (2011) (“We consider whether § 282 requires an invalidity defense to be proved by clear and convincing evidence. We hold that it does.”). Second, while the *Antares* court cited *Industrial Chemicals* in support of its test, neither the word “clearly” nor “unequivocally” appears in the *Industrial Chemicals* opinion. More significantly yet, *Industrial Chemicals* never uses the word “separate.” Instead, this 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 (emphasis added). 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 this Court’s “same invention” test with a brand new and meaningfully different “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*’ “same invention” test). *Id.* at 1356. Further, its requirement of heightened “clear and unequivocal” support is inappropriate, and untethered from any pertinent precedent, common-sense rationale, or public policy.

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 this Court has previously reversed the Federal Circuit. *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, this 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).

CONCLUSION

For the foregoing reasons, the petition should be granted, the judgment below should be vacated, and the case should be remanded for further proceedings.

Respectfully submitted,

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**APPENDIX A — JUDGMENT OF THE UNITED
STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT, FILED SEPTEMBER 8, 2023**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2022-2044

IKORONGO TEXAS LLC, IKORONGO
TECHNOLOGY LLC,

Plaintiffs-Appellants,

v.

BUMBLE TRADING LLC,

Defendant-Appellee.

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

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.

2a

Appendix A

ENTERED BY ORDER OF THE COURT

/s/ Jarrett B. Perlow

Jarrett B. Perlow
Clerk of the Court

September 8, 2023

Date

**APPENDIX B — MEMORANDUM OPINION
AND ORDER OF THE UNITED STATES DISTRICT
COURT FOR THE WESTERN DISTRICT OF TEXAS,
WACO DIVISION, FILED APRIL 12, 2022**

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

Civil Action 6:20-cv-256-ADA

IKORONGO TECHNOLOGY LLC
and IKORONGO TEXAS LLC,

Plaintiffs,

v.

BUMBLE TRADING LLC,

Defendant.

MEMORANDUM OPINION AND ORDER

The Court considers Bumble Trading LLC’s (“Bumble” or “Defendant”) Motion for Summary Judgment of Invalidity Under 35 U.S.C. § 251, which contains the original patent requirement. After considering the briefing (Dkt. Nos. 100, 125, 148) and oral arguments, the Court **GRANTS** Bumble’s motion and finds the asserted claims 57, 63, 64, 66, 68, and 70 of U.S. Patent No. RE45,543 (“543 Reissue”) and asserted claims 33, 34, 38, 45, and 46 of U.S. Patent No. RE47,704 (“704 Reissue”) invalid.

*Appendix B***FACTUAL BACKGROUND**

The '543 Reissue and the '704 Reissue are reissues of original U.S. Patent No. 7,080,139 (“139 Patent”). The '139 Patent originally issued on July 18, 2006. The '543 Reissue reissued on June 2, 2015, nearly nine years later. The '704 Reissue reissued on November 5, 2019, over thirteen years later.

Ikorongo Technology LLC and Ikorongo Texas LLC (“Plaintiffs”) sued Bumble for infringing the asserted claims. Neither party disputes the contents of the asserted patents or their file histories. No factual disputes continue to underly claim construction. Thus, no disputed material facts preclude summary judgment.

Original U.S. Patent No. 7,080,139

Because the specification plays an important role in meeting the original patent requirement, the Court provides an extended description of the '139 Patent. The original '139 Patent bears the title, “Method and Apparatus for Selectively Sharing and Passively Tracking Communication Device Experiences,” and its abstract echoes that focus:

The present invention includes methods and devices for *passively tracking and selectively sharing user experiences* with communication devices, including computers, web-enabled telephones, and PDAs. User rating or comments on their experiences can be captured.

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'139 Patent at Abstract (emphasis added). The detailed description states that a “common theme among aspects of the present invention is collecting data regarding a user’s computer usage experience and sharing that data.” *Id.* at 2:26-28. The summary states that the “present invention includes methods and devices for sharing communication device usage experiences, including computer usage experiences.” *Id.* at 1:30-32. “So-called ‘buddies’ identified on buddy lists of instant messaging products can share selected aspects of their computer usage experiences.” *Id.* at 2:28-30; *see also id.* at 18:19-20.

The '139 Patent contains figures showing the operation of the invention. Among these, figures 1, 8-11, 16, and 22-24 have the most relevance. Figure 1 provides an overview of the system. Toward the left, it shows “[t]racked activity may include Internet activity 120, **wireless network location track [sic] and interaction activity 121.**” *Id.* at 4:65-67 (emphasis added). The '139 Patent then immediately describes the types of activities tracked:

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.

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Id. at 5:1-9 (emphasis added).

Figure 8A shows a user interface for administering a list of online buddies to share experiences with. Figure 8D shows an interface for selecting topics such as “Food,” “Games,” “Music,” and “Shopping” to share with the selected online buddies. Figures 9-11 show user interfaces for sharing experiences with online buddies, including what users did, what topic each experience relates to, details of the experience, where the experience occurred, a thumbs up or thumbs down, and a time of the experience. *Id.* at 9:16-20. The specification refers to these types of examples as “experiences tracked,” such as in:

The computer user **experiences tracked** could include viewing URLs, downloading files, listening to songs, viewing videos, making purchases, sending items from a user to their buddies, or general messaging between the user and buddies.

In addition to computer user experiences, mobile communication device **locations can be tracked**, using any of the technologies described above. Activities related to location may include visiting the location, rating, commenting on it, assigning an emoticon, or connecting with another buddy or buddy of a buddy at the location. Proximity to a location may be variation on visiting the location.

Id. at 18:53-64 (emphasis added).

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The system tracks, collects, and shares user experiences using “various databases and combinations of databases.” *Id.* at 2:43-74. “One database is a visited URL database (‘VUD’)” that stores URLs visited by users. *Id.* at 2:49-51. “Another database used to practice aspects of the present invention is the visited location database (‘VLD’) 100B” that tracks physically visited locations. *Id.* at 3:9-10. Both the VUD and VLD store additional information describing an experience associated with each URL visit or physical location visit. *Id.* at Figure 23 steps 2355-2366, 2:60-67, 3:10-12.

The VUD is used for “sharing communication device and computer usage experiences. One type of sharing communication device user experiences is sharing computer usage experiences, including Internet browsing experiences.” *Id.* at 17:41-45. “At least a portion of the user’s computer usage experiences are tracked and reported to a tracking server.” *Id.* at 18:38-39. “The computer user experiences tracked could include viewing URLs, downloading files, listening to songs, viewing videos, making purchases, sending items from a user to their buddies, or general messaging between the user and buddies.” *Id.* at 18:52-57. An entry in the VUD may include, for each visited URL, a rating, emoticon, title, timestamps, ratings, description, comments, and other types of information. *Id.* at 2:50-3:8; *see also id.* at 5:1-9.

Like how the VUD stores a user’s experiences when browsing the internet, the “VLD stores similar information for locations visited by users or participants carrying portable devices.” *Id.* at 3:11-12. For each visit,

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the VLD monitors for “activity related to a location, such as bookmarking a location, rating a location, adding an emoticon or comments about the location,” and adds information such as a “rating, location address, location description, a timestamp” or other information. *Id.* 17:3-17:25. The ’139 Patent repeatedly shows that the VLD database stores the “Location Address, Location Description, Location Category(s), Username(s), Timestamp(s), Rating(s), Emoticon(s), Comment(s) & Bookmark(s).” *Id.* at Figure 16 element 100, Figure 22 element 100B, Figure 24 element 100B. “The VLD **also could** store **geographic** information regarding the location.” *Id.* at 3:26-27 (emphasis added). “Sophisticated devices may include circuits that determine the device’s location; these circuits may utilize GPS, DGPS, Loran or any other location fixing protocol. The physics of how the device and the location are associated are relatively unimportant; an independent service may be used to track locations visited by a user based on any of the protocols identified above or any other protocol.” *Id.* at 3:31-38. “**In addition to** computer user experiences, mobile communication device locations can be tracked, using any of the technologies described above.” *Id.* at 18:58-60 (emphasis added); *see also id.* at 3:12-25 (describing Bluetooth for tracking). Figure 23 shows a process related to location monitoring. The following passage describes the types of information stored in the VLD when various triggers occur:

A location network directory **2312** is accessible, which reflects location of wireless devices **2354** and contains information such as the

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devices' location address, location description, a timestamp, and user ID **2358**. With this information, the system sets the action or activity type to "visit" a location and logs an entry into a visited location database **2358**. The system also monitors **2355** for activity related to a location, such as bookmarking a location, rating a location, adding an emoticon or comments about the location. . . . Typical activities include bookmarking **2359**, rating, or adding an emoticon **2363** or free text comment to a location reference. When a location is bookmarked **2359**, the system adds a bookmark flag, location address, location description, a timestamp and a user ID to the VLD or a buffer for later addition to the VLD. When a location is rated **2361**, the system adds the rating, location address, location description, a timestamp and the user ID to the VLD or a buffer for later addition to the VLD. When a location is flagged with an emoticon **2363**, the system adds the emoticon, location address, location description, a timestamp and the user ID to the VLD or to a buffer for later addition to the VLD. Similarly, when a user makes a comment on a location **2365**, the system adds the comment, location address, location description, a timestamp and the user ID to the VLD or to a buffer for later addition to the VLD. For each of these activities, fewer or more fields may be utilized in various embodiments.

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Id. at 16:67-17:26.

The '139 Patent then describes how users can selectively share their experiences with buddies, for example, with friends on a “buddy list.” *See, e.g., id.* at 18:4-37. The parties do not dispute that this feature is part of the original invention and properly contained in the reissued claims. Still, the shared information guides the Court’s analysis. Figure 9 shows “who 981 did 892 what 984 where 985 in what topic area 982 when 988. Ratings 986 and comments 987 also may be provided.” *Id.* at 9:17-20. As to sharing the “where,” “the name of a restaurant may be used instead of its Bluetooth access point address,” and a banner, logo, or icon may represent the location *Id.* at 9:41-46.

Finally, Figure 23 describes an embodiment specific to “wireless devices, such as cellular telephones and pagers.” *Id.* at 16:49-50. “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 16:53-56. The system “periodically receives information regarding the location of the wireless device 2356.” *Id.* at 16:60-62.

The original '139 Patent contains 32 claims, including independent claims 1, 31, and 32. Of the independent claims, claim 1 is the longest. It relates to sharing categories of computer usage experiences with buddies when a user either browses URLs or visits a location. Claim 1 of the '139 Patent recites:

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1. A method of sharing computer user experiences, including:

communicating with a registration server to register a user, for automatic client-side collection of computer usage experiences for future sharing, wherein the computer usage experiences include one or more of browsing URLs or visiting a location with a location-aware device that records the visited location;

accessing one or more of the user's messaging buddy lists and selecting one or more buddies with whom to share the automatically collected computer usage experiences;

defining categories of computer usage experiences to be shared with particular selected buddies;

tracking automatically on the client-side at least a portion of the user's computer usage experiences and reporting the user's computer usage experiences to a tracking server to be published to the particular buddies in accordance with their defined categories of sharing.

Claim 32 is the shortest and focuses on "sharing computer user experiences" with buddies by posting "the user's visited location data." It recites:

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32. A method of sharing computer user experiences, including:

registering a user with a registration server to collect and share visited location data using a client-side application collected while visiting a location with a location-aware device that records the visited location;

accessing one or more of the user's messaging buddy lists to identify one or more buddies with whom the tracking data may be shared;

defining rights of the buddies to access the visited location data;

posting at least a portion of the user's visited location data for the buddies to access according to their defined rights.

The Reissue Patents RE45,543 and RE47,704

About nine years after the inventors filed the application for the original patent, and after a series of patent assignments, the patent's new owners filed the applications that issued as the '543 Reissue and the '704 Reissue. The applicant filed these as broadening reissues. Dkt. No. 125 at 5 ("the '543 and '704 Patents were filed as broadening reissues"). Claim 33 of the '704 Reissue is representative of the asserted claims in that they focus on collecting and recording visited "geographic location data

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... using a satellite-based location-fixing protocol” and do not require sharing other experience information related to the visit. Claim 70 of the ’543 Reissue does not require the use of a “satellite-based location-fixing protocol” and instead requires geographic location data collected from a “client-side application” as well as “quantifying relative influence of at least one user on other users.” Claim 33 of the ’704 Reissue recites:

33. A method of operation of a location-aware cellular phone device comprising:

 sending registration information to a registration server from the location-aware cellular phone device;

 enabling access to one or more lists of other users to identify one or more other users with whom visited geographic location data is to be shared;

 enabling definition of access rights for the one or more other users to access the visited geographic location data;

 collecting the visited geographic location data for geographic locations visited by the location-aware cellular phone device using a client-side application, the visited geographic location data comprising a plurality of the geographic locations visited by the location-aware cellular phone device, each geographic

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location visited time-stamped with a time of visit, the geographic locations visited automatically and passively recorded by the location-aware cellular phone device using a satellite-based location-fixing protocol and a detection network directory; and

reporting information indicating the visited geographic location data collected by the location-aware cellular phone device.

This reissue patent claim can be coarsely summarized as a method for tracking a user with a GPS-enabled cell phone and sharing “visited geographic location data” to friends. Plaintiffs do not separately argue the dependent claims.

THE ORIGINAL PATENT REQUIREMENT

Settled Law

The statutory basis of the “original patent requirement” lies in 35 U.S.C. § 251(a), which reads:

Whenever any patent is, through error, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a

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new and amended application, for the unexpired part of the term of the original patent.

Thus, the reissued claims must be “for the invention disclosed in the original patent.” 35 U.S.C. § 251(a). This § 251 requirement for the reissued invention to be disclosed in the original patent remains separate from the written description requirement of 35 U.S.C. § 112.

Compliance with the original patent requirement is a question of law. *Forum US, Inc. v. Flow Valve, LLC*, 926 F.3d 1346, 1350-51 (Fed. Cir. 2019). A court may consider expert testimony to ascertain the meaning of a technical or scientific term, but expert testimony cannot supplant what a patent’s disclosure “actually say[s].” *Forum*, 926 F.3d at 1351, 1352.

The Supreme Court and Federal Circuit have interpreted this statute to mandate that the alleged invention of a reissue claim be “clearly and unequivocally disclose[d] . . . **as a separate invention**” in the original patent’s specification. *Antares Pharma, Inc. v. Medac Pharma Inc.*, 771 F.3d 1354, 1362 (Fed. Cir. 2014) (synthesizing “150 years” of Supreme Court cases) (emphasis added). Reissue claims violate the original patent requirement where the original specification “merely suggested or indicated” or “serially mentioned” the limitations within a reissued claim. *Id.* at 1359, 1363. “[I]t is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification.” *Id.* Rather, the “particular combinations” of reissue claim limitations must be

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disclosed in the original patent specification “in an explicit and unequivocal manner.” *Id.* at 1363. “Whether or not the written description requirement of § 112 was satisfied here, . . . for § 251, it is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification. Rather, the specification must clearly and unequivocally disclose the newly claimed invention as a separate invention.” *Id.* at 1362 (internal citations and quotations omitted).

This heightened standard protects the general public. The U.S. Patent Office may issue broadening reissue patents even after it publishes the issued patent and closes prosecution. When a reissue enlarges the scope of the patent, the patent owner “led the public to rely on the implied disclaimer involved in the terms of the original patent.” *Miller v. Bridgeport Brass Co.*, 104 U.S. 350, 356, 26 L. Ed. 783, 1882 Dec. Comm’r Pat. 49 (1881). Thus, the scope of broadening reissue claims is limited to separate inventions that are clearly and unequivocally disclosed in the original specification. *Antares*, 771 F.3d at 1362.

Precedent includes examples of properly and improperly reissued claims. In *Antares*, the specification stated, “[a]lternatively, a push button could be located at the proximal end of the device,” but this “alternative” suggestion failed to rise to the level of an explicit and unequivocal disclosure of a safety feature of an injection device claimed on reissue when broadened from a claim on jet-injection devices. *Id.* at 1363. In contrast, the Federal Circuit held that an inventor properly added claims on computer-controlled rollers when the original claims

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covered only manually controlled rollers because the specification described an embodiment exactly aligned with the broader scope by stating that the rollers could be “raised either mechanically by the roller cams or electronically by the computer controlling the router. *In re Amos*, 953 F.2d 613, 614, 617-19 (Fed. Cir. 1991).

Resolution of Disputed Law

The parties dispute two nuances of the original patent requirement.

First, Plaintiffs argue that the Court can find clear and unequivocal support for broadened reissued claims in the original claims. Plaintiffs appear to take this position because disputes rarely arise over reissued claim elements that remain identical to an original claim element. In these types of cases, the parties usually dispute only whether a small, broadened part of the claim meets the original patent requirement. But in cases such as this, where the reissued claim completely rewrites the original claim, the Court disagrees with Plaintiffs because “by definition in reissue the original claims do not disclose the invention claimed on reissue.” *Antares*, 771 F.3d at 1362; 35 U.S.C. § 251 (“Whenever any patent is, **through error**, deemed wholly or partly inoperative or invalid . . . the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent”) (emphasis added). That is why “the original patent requirement focuses on the original specification rather than the original claims.” *Antares*, 771 F.3d at 1362.

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Second, Bumble argues that “disparate” references to claim elements cannot be “stitched-together” when scattered across “all corners of the specification” to satisfy the original patent requirement. Dkt. 148 at 6. The Court disagrees. In evaluating the original patent requirement, the Court looks to the original patent in its entirety but excludes the erroneous claims. Patent claims frequently recite multiple steps or components, and patent specifications frequently contain corresponding, sequential sections written over many pages to explain the details of each claimed step or component. Patents often also contain an overview section stitching together these sequential sections of the specification into an overarching system or method. Thus, descriptions of an original invention scattered across a specification may provide clear and unequivocal support for reissued claims, for example, when tied together by an overview.

ANALYSIS**The Reissue Patents Broaden the Original Claims**

As a preliminary matter, the Court compares the reissued claims to the claims of the ‘704 Reissue to determine if the reissued claims broaden the scope of invention. “A broadened reissue claim is a claim which enlarges the scope of the claims of the patent A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in at least one respect, even though it may be narrower in other respects.” MPEP § 1412.03.

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Each of the reissue claims is broader in at least one respect. The reissue claims generally cover different aspects of the invention compared to the original claims. For example, original claim 32 requires “registering a user with a registration server,” but reissue claim 33 of the ’704 Reissue does not. The parties do not meaningfully dispute that the reissue claims are broadening. Dkt. No. 125 at 5 (admitting “the ’543 and ’704 Patents were filed as broadening reissues”).

The Court agrees with Plaintiffs that many of the disputed aspects are narrower than the original claims. But the law requires meeting the original patent requirement if at least one aspect of the claim is broader, even if other aspects are narrowing. None of the cases provided by Plaintiffs allow the Court to exempt sections of the claim from the original patent requirement. Thus, the Court enforces the original patent requirement by determining if all challenged aspects of the reissued claims were clearly and unequivocally disclosed in the original ’139 Patent.

Parties’ Arguments

Defendant argues that the reissued claims differ substantially from the original invention because the original ’139 Patent focuses on sharing general “experiences” with buddies, not on a phone for sharing only a user’s visited geographic location data. The reissue claims focus on collecting and sharing “visited geographic location data” using a “satellite-based location-fixing protocol,” except for the distinctions noted above.

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Defendant argues that the original '139 Patent does not clearly and unequivocally disclose any embodiment that focuses on the “geographic” location-tracking aspect and sharing of “visited geographic location data” separate from other aspects related to sharing user “experiences.”

Plaintiffs argue that the specification clearly and unequivocally supports the claims of the reissue patents. The specification describes tracking a user’s visit to a location ('139 Patent at 5:1-9, 18:23-29, 18:58-64), logging the visited location in a visited location database ('139 Patent at 3:26-27, 3:43-48, 5:1-3, 16:63-17:2), and sharing experiences with buddies (*passim*). Plaintiffs argue that the shared “experiences” include sharing geographic location data about the visits. Plaintiffs then argue that the specification complies with § 112, that the claims of the original '139 Patent provide clear and unequivocal support, and that expert testimony supports its argument.

Resolution

The Court scoured the specification for a clear and unequivocal disclosure of the following aspects common to the reissue claims: (1) collecting “visited geographic location data;” (2) sharing such visited geographic location data (“posting at least a portion of the user’s visited location data” in reissue claim 33) separate and apart from sharing general experiences; and (3) using a satellite-based location-fixing protocol. The Court considered the '139 Patent in its entirety, including the passages cited in Plaintiffs’ brief and the figures identified during oral argument. The specification fails to clearly

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and unequivocally disclose aspects (2) and (3) as parts of the original invention.

As to aspect (1), the specification mentions “geographic” location data only once as data optionally collected in addition to location information in the VLD. *Id.* at 3:26-27 (“The VLD also could store geographic information regarding the location, such as geo-coded data.”). This type of data collection fits with the overarching ideas of passively tracking a user by collecting data. *Id.* at abstract, 2:26-28. Thus, this optional storage of visited geographic location data satisfies the original patent requirement for aspect (1) of the reissued claims.

As to aspect (2), the Court finds 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. The separation plays an important role because it changes the fundamental nature of the invention from a system for sharing experiences, such as reviews of activities, into a tracking device that allows your friends to track your location.

The specification only mentions “geographic” location data at 3:26-27 and describes this geographic location data as something “also” stored alongside other experience and location information. Thus, the only explicit reference to “geographic” location data does not unequivocally support claiming storing “geographic” location data in the VLD as the original invention without “also” claiming storing the rest of the information in the VLD.

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The “particular combinations” of reissue claim limitations, in this case geographic location data separate from other experience information, must be disclosed in the original patent specification “in an explicit and unequivocal manner.” *Antares*, 771 F.3d at 1363. The Court instead finds that the specification repeatedly and consistently describes sharing other experience-related information in combination with the location. ’139 Patent at Figure 9 (showing general experience information), Figure 16 element 100 (listing types of accompanying experience information), Figure 22 element 100B (listing types of accompanying experience information), 2:49-3:12; 5:1-9, 13:36-40, 17:1-25, 17:41-45, 18:53-64. The mention of “location” or “visit” in a lengthy list of combinations and alternative possibilities of what is included in an “experience” does not make it clear and unequivocal that the original invention focuses on sharing only “geographic” location data. *See Antares*, 771 F.3d at 1359 (finding that safety features “serially mentioned as part of the broader disclosure” did not amount to an explicit and unequivocal disclosure). Nowhere does the ’139 Patent describe a system or method that shares the specific combination of only geographic location data without other related experience information, as claimed.

The specification’s repeated mentions of a “visit” or “location,” without more, do not serve as a clear and unequivocal reference to “visited geographic location data.” The question is not whether the words “visit” or “location” as used in the specification *might encompass* geographic location data; the question is whether that use of “visit” or “location” clearly and unequivocally

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does so. The figures show sharing a “location” or “visit” by using “useful shorthands” such as names, logos, and banners. *Id.* at figure 9, 9:39-49. Thus, any disclosure of sharing a “location” or “visit” may refer to sharing the name of the location or logo and fails to serve as a clear and unequivocal reference to “geographic” location data.

Even when the specification does mention sharing location information, it arises in the context of sharing location information *in addition* other aspects of the experience. The abstract describes the original invention as “methods and devices for passively tracking **and** selectively sharing user experiences.” *Id.* (emphasis added). The specification repeatedly echoes this requirement. *Id.* at 3:26-27 (“The VLD **also could** store geographic location information regarding the location, such as geo-coded data”) (emphasis added), 4:65-67 (“wireless network location track [sic] **and** interaction activity 121”) (emphasis added), 18:58-60 (“**In addition to** computer user experiences, mobile communication device locations can be tracked”) (emphasis added). Plaintiffs provide no reason for the Court to ignore these repeated statements that the original invention includes location information *in addition to* other aspects of an experience.

As to aspect (3)¹ the specification does not make it clear and unequivocal that “satellite-based” location tracking is part of the original invention. The original specification does not use the word “satellite” at all. At best, the specification recites:

1. Not applicable to the '543 Reissue, claim 70.

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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. The physics of how the device and the location are associated are relatively unimportant; an independent service may be used to track locations visited by a user based on any of the protocols identified above or any other protocol.

Id. at 27-38. Because the specification deemed this detail “unimportant,” it cannot serve as clear and unequivocal support for a limitation defining the scope of the original invention. A clear and unequivocal statement would have instead explicitly described “satellite” based tracking as an important limitation instead of treating it like an unimportant variation more suited for a dependent claim. The mention of “GPS” and “DGPS” as part of a serial list of suggestions does 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]” as recited in reissue claim 33, at the exclusion of Bluetooth, triangulation, radio signal, Loran, and other location fixing protocols. *See Antares*, 771 F.3d at 1363 (finding that safety features “serially mentioned as part of the broader disclosure” did not amount to an explicit and unequivocal disclosure). What is “necessary” in the original invention is a “wireless device 2354, which

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supports a location detection service. This support may be Bluetooth, GPS or any other location detection technology.” ’139 Patent at 16:53-56.

Public policy supports the Court’s conclusions. For about nine and thirteen years for the ’543 Reissue and ’704 Reissue, respectively, the patent owner led the public to rely on the implied disclaimer involved in the terms of the original patent. *Miller*, 104 U.S. at 356. The original ’139 Patent put the public on notice of an invention related to sharing experiences, generally, with buddies. A fair reading did not put the public on notice that the claims should have been corrected to cover a satellite-based, geographic location tracking invention for sharing one’s visited geographic location data with buddies, without including the sharing of related experience information.

Plaintiffs’ Remaining Arguments Rejected

The cited cases do not support Plaintiffs’ arguments. In *Amos*, “the exact embodiment claimed on reissue was expressly disclosed in the specification.” *Antares*, 771 F.3d at 1363 (explaining the holding in *Amos*, 953 F.2d at 617-19). Here, the exact embodiment with “the geographic locations visited automatically and passively recorded by the location-aware cellular phone device using a satellite-based location-fixing protocol” as recited in reissue claim 33 remains missing from the specification. Additionally, the use of “geographic” location data is mentioned only in addition to other experience information, and the scope of all “satellite-based” location fixing protocols remains missing entirely.

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In *Antares*, the “original claims [were] significantly different in scope and coverage than the asserted claims.” 771 F.3d at 1362. Thus, the Federal Circuit looked to the specification and found that “the original specification does not adequately disclose the later-claimed safety features” because “[t]he specification discussed only one invention: a particular class of jet injectors.” *Id.* “Although safety features were mentioned in the specification, they were never described separately from the jet injector.” *Id.* at 1363. Here, the Court finds that the original ’139 Patent specification discloses two class of inventions: experience sharing systems and methods for internet activity and experience sharing systems and methods for visits, but not geographic location tracking devices. Although the original ’139 Patent mentions “GPS” based tracking in the specification as part of tracking users for sharing their general experiences when visiting locations, tracking users using any “satellite-based” tracking protocol is never described at all, much less described separately from generally sharing experiences at a particular location.

Plaintiffs’ other arguments remain unpersuasive. Plaintiffs argued that original claim 32 supports the reissued claims. The Court did not look to original claim 32 of the ’139 Patent to find the invention disclosed in the original patent because “by definition in reissue the original claims do not disclose the invention claimed on reissue. Thus, we must look to the specification.” *Antares*, 771 F.3d at 1362. Plaintiff also urged the Court to consider supporting expert testimony. The Court considered it but found the testimony of Plaintiffs’ expert

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unnecessary because expert testimony cannot supplant what a patent's disclosure actually says. *Forum*, 926 F.3d at 1351, 1352. Plaintiffs argued that the original '139 Patent undisputedly provides § 112 written description support for the claims. But “[w]hether or not the written description requirement of § 112 was satisfied here, . . . for § 251, it is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification. Rather, the specification must clearly and unequivocally disclose the newly claimed invention as a separate invention.” *Antares*, 771 F.3d at 1362 (internal citations and quotations omitted).

CONCLUSION

It is **ORDERED** that Defendant Bumble Trading LLC's Motion for Summary Judgment of Invalidity Under 35 U.S.C. § 251 (Original Patent Requirement) is **GRANTED**. Accordingly, under 35 U.S.C. § 251, asserted claims 57, 63, 64, 66, 68, and 70 of U.S. Patent No. RE45,543, and asserted claims 33, 34, 38, 45, and 46 of U.S. Patent No. RE47,704, are invalid.

SIGNED this 12th day of April, 2022.

/s/ Alan D Albright
ALAN D ALBRIGHT
UNITED STATES DISTRICT JUDGE

**APPENDIX C — DENIAL OF REHEARING
OF THE UNITED STATES COURT OF
APPEALS FOR THE FEDERAL CIRCUIT,
FILED NOVEMBER 13, 2023**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2022-2044

IKORONGO TEXAS LLC, IKORONGO
TECHNOLOGY LLC,

Plaintiffs-Appellants,

v.

BUMBLE TRADING LLC,

Defendant-Appellee.

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

ON PETITION FOR REHEARING EN BANC

Before MOORE, *Chief Judge*, LOURIE, DYK, PROST, REYNA,
TARANTO, CHEN, HUGHES, STOLL, CUNNINGHAM, and
STARK, *Circuit Judges*.¹

PER CURIAM.

1. Circuit Judge Newman did not participate.

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Appendix C

ORDER

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

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 November 20, 2023.

November 13, 2023

Date

FOR THE COURT

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

**APPENDIX D — RELEVANT STATUTORY
PROVISIONS**

§ 251. Reissue of defective patents

(a) **IN GENERAL.**—Whenever any patent is, through error, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

(b) **MULTIPLE REISSUED PATENTS.**—The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

(c) **APPLICABILITY OF THIS TITLE.**—The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent or the application for the original patent was filed by the assignee of the entire interest.

Appendix D

(d) REISSUE PATENT ENLARGING SCOPE OF CLAIMS.—No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

(July 19, 1952, ch. 950, 66 Stat. 808; Pub. L. 106–113, div. B, §1000(a)(9) [title IV, § 4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A–582; Pub. L. 107–273, div. C, title III, § 13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1906; Pub. L. 112–29, §§ 4(b)(2), 20(d), Sept. 16, 2011, 125 Stat. 296, 333.)