

In the Supreme Court of the United States

RICHARD SOWINSKI,

Petitioner,

v.

CALIFORNIA AIR RESOURCES BOARD,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

ROB BONTA
Attorney General of California
MICHAEL J. MONGAN
Solicitor General
ROBERT W. BYRNE
DAVID A. ZONANA
*Senior Assistant
Attorneys General*

SAMUEL T. HARBOURT*
Deputy Solicitor General
ROBERT D. SWANSON
JONATHAN A. WIENER
Deputy Attorneys General

STATE OF CALIFORNIA
DEPARTMENT OF JUSTICE
455 Golden Gate Avenue
Suite 11000
San Francisco, CA 94102-7004
(415) 510-3919
Samuel.Harbourt@doj.ca.gov
**Counsel of Record*

May 24, 2021

QUESTION PRESENTED

Whether petitioner's suit is barred on ordinary claim preclusion grounds.

TABLE OF CONTENTS

	Page
Introduction.....	1
Statement	1
Argument.....	4
Conclusion	17

TABLE OF AUTHORITIES

	Page
CASES	
<i>ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.</i> 694 F.3d 1312 (Fed. Cir. 2012).....	6
<i>Alden v. Maine</i> 527 U.S. 706 (1999)	16
<i>Alice Corp. Pty. v. CLS Bank Int'l</i> 573 U.S. 208 (2014)	16
<i>Allen v. Cooper</i> 140 S. Ct. 994 (2020)	16
<i>Bilski v. Kappos</i> 561 U.S. 593 (2010)	16
<i>Brain Life, LLC v. Elekta Inc.</i> 746 F.3d 1045 (Fed. Cir. 2014).....	10, 12, 14
<i>Brown v. Felsen</i> 442 U.S. 127 (1979)	6
<i>Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd.</i> 527 U.S. 666 (1999)	15
<i>Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank</i> 527 U.S. 627 (1999)	16

TABLE OF AUTHORITIES
(continued)

	Page
<i>General Chemical Co. v. Standard Wholesale Phosphate & Acid Works, Inc.</i> 101 F.2d 178 (4th Cir. 1939)	13, 14
<i>Huck on Behalf of Sea Air Shuttle Corp. v. Dawson</i> 106 F.3d 45 (3d Cir. 1997)	6, 9
<i>In re PersonalWeb Techs. LLC</i> 961 F.3d 1365 (Fed. Cir. 2020).....	10, 14
<i>Kessler v. Eldred</i> 206 U.S. 285 (1907)	4, 10, 11, 14
<i>Lawlor v. Nat’l Screen Serv. Corp.</i> 349 U.S. 322 (1955)	<i>passim</i>
<i>Lucky Brand Dungarees, Inc. v. Marcel Fashions Grp., Inc.</i> 140 S. Ct. 1589 (2020).....	5, 8, 9
<i>Manuel v. City of Joliet</i> 137 S. Ct. 911 (2017)	12
<i>Parklane Hosiery Co. v. Shore</i> 439 U.S. 322 (1979)	5
<i>Rubber Tire Wheel Co. v. Goodyear Tire & Rubber Co.</i> 232 U.S. 413 (1914)	11, 14
<i>Sears, Roebuck & Co. v. Stiffel Co.</i> 376 U.S. 225 (1964)	16

TABLE OF AUTHORITIES
(continued)

	Page
<i>Selden Co. v. General Chemical Co.</i> 73 F.2d 195 (3d Cir. 1934)	14
<i>Sowinski v. Cal. Air Res. Bd.</i> 720 F. App'x 615 (Fed. Cir. 2017)	2
<i>SpeedTrack, Inc. v. Office Depot, Inc.</i> 791 F.3d 1317 (Fed. Cir. 2015).....	10, 11, 14
<i>Stewart v. Bancorp</i> 297 F.3d 953 (9th Cir. 2002)	6
<i>Storey v. Cello Holdings, LLC</i> 347 F.3d 370 (2d Cir. 2003)	9
<i>Va. Off. for Prot. & Advocacy v. Stewart</i> 563 U.S. 247 (2011)	16
STATUTES & COURT RULES	
42 U.S.C. §§ 7651-7651o.....	17
Federal Rule of Civil Procedure 41(b).....	8
OTHER AUTHORITIES	
Restatement (Second) of Judgments § 25 (1982).....	6
Shapiro et al., <i>Supreme Court Practice</i> (11th ed. 2019)	13, 14, 15

**TABLE OF AUTHORITIES
(continued)**

Page

United States Patent and Trademark
Office, Patent Maintenance Fees,
<https://fees.uspto.gov/MaintenanceFees/fees/details?applicationNumber=09696152&patentNumber=6601033>
(last visited May 19, 2021) 16

Wright, Miller, & Cooper, *Federal
Practice and Procedure* (3d ed. 2016) *passim*

INTRODUCTION

Petitioner asks the Court to consider whether the Federal Circuit has erred by “adopt[ing] its own unique version of *res judicata*,” called the “*Kessler* doctrine,” as a “necessary supplement to issue and claim preclusion.” Pet. I. In this case, however, respondent sought dismissal of petitioner’s suit—and then defended that dismissal on appeal—on ordinary claim preclusion grounds. Neither the parties nor the courts applied or even referenced the *Kessler* doctrine (until petitioner invoked it in an unsuccessful petition for rehearing en banc). This is accordingly not a proper vehicle for considering whether the Federal Circuit erred in other cases by “appl[ying] ‘a separate and distinct doctrine known as the *Kessler* Doctrine.’” Pet. 3. That is especially so because petitioner’s suit is meritless and barred by sovereign immunity in any event. The Court should deny the petition.

STATEMENT

This case concerns the preclusive effect of a prior suit’s dismissal on “a second suit against the same defendant, asserting the same patent against the same infringing activity.” Pet. 10.

First Suit. In 2015, petitioner Richard Sowinski filed suit in California state court against the California Air Resources Board, the respondent here, as well as several individual state officials and private corporations. Pet. App. 2a. The complaint alleged that the defendants infringed a patent claiming a method “for validating and trading” pollution-control credits. *Id.*;

see also J.A. 89.¹ Seeking injunctive relief and damages “in excess of \$100 million,” *id.* at 102-103, petitioner alleged that each of the defendants was infringing his patent on an ongoing basis by managing or participating in the State’s cap-and-trade program, see Pet. App. 2a. Petitioner also alleged that such infringement qualifies as unfair competition and “elder financial abuse” under California state law (the latter because he is over 70 years old). J.A. 103-104; see *id.* at 90.

Following removal of the case to federal district court, the defendants moved to dismiss for failure to state a claim. Pet. App. 3a. Because petitioner “did not file a response” within “the period set in the local rules,” the court dismissed the case for failure to prosecute. *Id.*; see also *id.* at 6a. The dismissal was “with prejudice and without leave to amend.” *Id.* at 3a. Petitioner appealed, and the court of appeals affirmed in an unpublished opinion. *Id.*; see *Sowinski v. Cal. Air Res. Bd.*, 720 F. App’x 615, 618 (Fed. Cir. 2017).

Second Suit. In 2018, following affirmance of the first suit’s dismissal, petitioner filed a second complaint “substantially identical to his prior complaint.” Pet. App. 4a.² He continued to allege the same three legal claims—patent infringement, unfair competition,

¹ All “J.A.” citations are to the joint appendix filed in the court of appeals in the proceedings below. See C.A. Dkt. 35 (filed Aug. 19, 2019).

² Petitioner initially brought his second suit in California state court, see J.A. 156-173 (filed January 31, 2018), but then voluntarily dismissed and re-filed in federal district court, see *id.* at 7-22 (filed July 2, 2018).

and elder abuse—but “sought damages only for infringement” that postdated the district court’s dismissal of the first suit. Pet. App. 4a. He also omitted the individual and corporate defendants who were named as defendants in the prior suit, leaving the Board as the only named defendant. J.A. 7-8. He continued to seek damages “in excess of \$100 million,” as well as the same injunctive relief against the Board that he requested in his first suit. *Id.* at 19; *see id.* at 18, 21-22.³

After petitioner applied to proceed *in forma pauperis*, the district court conducted a “review of the complaint” to determine “if the complaint is frivolous, malicious, or fails to state a claim upon which relief may be granted.” Pet. App. 11a. Concluding “that the Complaint is frivolous and fails to state a claim,” *id.*, the court denied *in forma pauperis* status and dismissed the suit without leave to amend, *id.* at 15a. The court noted that petitioner had raised the same claims in his prior suit and held that “the dismissal of [petitioner’s first suit] precludes Plaintiff’s Complaint in the instant matter.” *Id.* at 13a; *see also id.* at 15a (“Plaintiff’s Complaint is clearly barred by *res judicata*.”).⁴

³ Petitioner appears to have copied and pasted most of the complaint from his first suit into the body of the complaint from the second suit. *Compare* J.A. 89-106, *with id.* at 7-22. The second complaint, for example, still includes the portions of the first complaint seeking damages from the individual and corporate defendants who were named in the first suit but dropped from the second. *Id.* at 19.

⁴ Prior to the court’s dismissal at the screening stage, the Board filed a motion to dismiss the case on “several grounds,” including “*res judicata*, Eleventh Amendment immunity from suit, and patent invalidity.” Pet. App. 4a. The district court’s ruling addressed only the first ground. *Id.*

Petitioner appealed, and the court of appeals affirmed on the same basis. Emphasizing that petitioner sued “the same” defendant and failed to allege any “different conduct or acts” from those alleged in his first suit, Pet. App. 7a, the court of appeals concluded that the “district court acted within its discretion and in accordance with law, in applying res judicata,” *id.* at 9a. While acknowledging that petitioner had limited his request for damages to alleged infringement “arising subsequent to [his] prior action,” *id.* at 7a (internal quotation marks omitted), the court of appeals explained that petitioner’s suit did not materially differ from his first action, *see id.* at 8a (“a claim based on new and different facts is not precluded, whereas a claim based on the same facts is precluded” (citing *Lawlor v. Nat’l Screen Serv. Corp.*, 349 U.S. 322 (1955))). The court of appeals did not cite this Court’s decision in *Kessler v. Eldred*, 206 U.S. 285 (1907), or directly reference the Federal Circuit’s *Kessler* doctrine. *See* Pet. App. 1a-9a.

Petitioner then sought rehearing en banc. The court of appeals denied the petition without calling for a response. Pet. App. 19a.

ARGUMENT

Petitioner’s suit is “substantially identical” to a prior suit he filed against the California Air Resources Board for patent infringement, unfair competition, and elder abuse. Pet. App. 4a. Because that prior suit was dismissed with prejudice, the Board argued that this suit was barred by ordinary claim preclusion principles; the district court ordered dismissal here on that basis, *id.* at 15a; and the court of appeals affirmed on the same grounds, *see id.* at 7a-9a. Petitioner is thus incorrect that this case presents an opportunity for the Court to re-evaluate the “*Kessler* doctrine,” a separate

and “unique” doctrine that petitioner believes is “squarely at odds with ‘traditional’ principles of issue and claim preclusion.” Pet. 3. In any event, petitioner fails to demonstrate that any questions regarding the continued vitality of the *Kessler* doctrine are worthy of this Court’s review. And this case would be an exceptionally poor vehicle to address legal issues surrounding the preclusive effect of prior judgments: sovereign immunity presents an independent barrier to petitioner’s second suit, and his underlying claims are plainly meritless. The Court should deny the petition.

1. The issue that the parties litigated before the lower courts—and that the lower courts decided—was whether petitioner’s second suit was barred by ordinary claim preclusion, often referred to as *res judicata*.

a. This Court has recognized two principal “doctrines regarding the preclusive effect of prior litigation.” *Lucky Brand Dungarees, Inc. v. Marcel Fashions Grp., Inc.*, 140 S. Ct. 1589, 1594 (2020). The “first is issue preclusion (sometimes called collateral estoppel), which precludes a party from relitigating an issue actually decided in a prior case and necessary to the judgment.” *Id.* The second is “claim preclusion (sometimes itself called *res judicata*).” *Id.* “Unlike issue preclusion, claim preclusion prevents parties from raising issues that could have been raised and decided in a prior action—even if they were not actually litigated.” *Id.* The purpose of both doctrines is to “promot[e] judicial economy by preventing needless litigation.” *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 326 (1979).

Claim preclusion applies not only to legal issues “that could have been raised” in a prior action, *Lucky Brand*, 140 S. Ct. at 1594, but also to any remedies that could have been sought: “after judgment for or

against the plaintiff, the claim is ordinarily exhausted so that the plaintiff is precluded from seeking any other remedies deriving from the same grouping of facts.” Restatement (Second) of Judgments § 25 cmt. f (1982). For example, where both retrospective and prospective damages may be sought for conduct that “should [be] expect[ed] to continue without change”—such as a “permanent,” ongoing “nuisance” or patent infringement—all available damages “should be sought in the first action.” 18 Wright, Miller, & Cooper, *Federal Practice and Procedure* § 4409 & nn.34-37 (3d ed. 2016) (Wright & Miller); *see also ActiveVideo Networks, Inc. v. Verizon Commc’ns, Inc.*, 694 F.3d 1312, 1343 (Fed. Cir. 2012) (recognizing court’s authority to award “prospective damages,” in addition to retrospective damages, “for ongoing” harms such as patent infringement).

As a general matter, therefore, a plaintiff may not re-litigate claims simply by filing a new suit and limiting his request for damages to harm “suffered subsequent to the [judgment] in the prior lawsuit.” *E.g.*, *Huck on Behalf of Sea Air Shuttle Corp. v. Dawson*, 106 F.3d 45, 49 (3d Cir. 1997) (internal quotation marks omitted). Because such damages could have been sought in the first suit, the plaintiff does not get a second bite at the apple. *See id.* (calling plaintiff’s argument to the contrary “absurd”).

b. Before the district court and on appeal, the parties litigated the question whether ordinary claim preclusion principles applied to petitioner’s second suit. The Board sought dismissal on that basis, invoking standard *res judicata* precedent. *See* D. Ct. Dkt. 12 at 12-14 (citing, *inter alia*, *Lawlor v. Nat’l Screen Serv. Corp.*, 349 U.S. 322, 328 (1955), *Brown v. Felsen*, 442 U.S. 127, 131 (1979), and *Stewart v. Bancorp*, 297 F.3d

953, 956 (9th Cir. 2002)). The Board acknowledged that the complaint in the second suit alleged that petitioner “suffered damage only after his previous complaint [in the first suit] was dismissed,” but the Board argued that the second suit was nonetheless subject to claim preclusion because petitioner “could and did bring these claims against [the Board] in the previous case.” *Id.* at 12, 13. The district court agreed, concluding that petitioner’s “Complaint is clearly barred by res judicata.” Pet. App. 15a. Petitioner’s unsuccessful motion for reconsideration argued that his new complaint “cannot be barred by res judicata” in light of Supreme Court and circuit precedent. D. Ct. Dkt. 19 at 8.

On appeal in the Federal Circuit, the parties again litigated whether standard claim preclusion principles barred the second suit. Petitioner argued that “res judicata cannot apply to claims arising after the prior judgment.” C.A. Dkt. 26 at 15; *see id.* at 17 (“The only issue in this appeal is . . . whether ‘the claims asserted’ in this action ‘were, or could have been, raised in the prior action.’”). The Board argued that the district court properly held that petitioner’s second suit “is barred by claim preclusion,” C.A. Dkt. 31 at 12, distinguishing “the *Lawlor* rule that claim preclusion does not bar suits based on new and different facts,” *id.* at 19; *see id.* at 20 (“None of these cases stand for the proposition that merely changing the date on damages sought for the same accused conduct nullifies claim preclusion.”). Neither party invoked the Federal Circuit’s *Kessler* doctrine. And the court of appeals ultimately held that the “district court acted within its discretion and in accordance with law, in applying res judicata.” Pet. App. 9a.

c. The lower courts correctly applied ordinary preclusion principles to bar petitioner’s second suit. While issue preclusion does not apply because petitioner’s first action was dismissed for failure to prosecute—thereby preventing any legal issues from being “actually decided,” *Lucky Brand*, 140 S. Ct. at 1594—claim preclusion does apply. As petitioner acknowledges, he “brought a second suit against the same defendant, asserting the same patent against the same infringing activity.” Pet. 10; *see* Pet. App. 7a. Indeed, petitioner appears to have copied and pasted much of the complaint from his first suit into the body of the complaint in his second suit. *See supra* p. 3, n.3. The only relevant change was that petitioner limited his request for damages to “the period after conclusion of” the first suit. Pet. App. 7a. As explained above, however, that does not alter the preclusion analysis because petitioner could have sought—and in fact *did* seek—all available relief in his first suit, including both retrospective and prospective damages. *See, e.g.*, J.A. 97 (first complaint) (“As a result of the infringement of the SOWINSKI PATENT, Plaintiff Sowinski has been damaged, will be further damaged, and is entitled to be compensated for such damages.”).⁵

As noted, petitioner’s principal response in the courts below was that claim preclusion is inapplicable where a second suit is premised on activity “arising subsequent to a prior action.” Pet. App. 8a (internal quotation marks omitted). But that is only the “general[]” rule; it applies where a plaintiff alleges “new ‘material operative facts’” arising after termination of

⁵ The dismissal of the first suit for failure to prosecute qualifies as a “final judgment” entitled to preclusive effect. Pet. App. 5a-7a; *see also* Fed. R. Civ. P. 41(b); 18A Wright & Miller § 4435.

the first suit. *Lucky Brand*, 140 S. Ct. at 1596 (alteration omitted). Where, as here, two successive suits challenge the same continuing course of conduct, and the only difference is that the second suit seeks damages for conduct postdating dismissal of the first suit, no “new material facts” exist. *See, e.g., Huck on Behalf of Sea Air Shuttle Corp.*, 106 F.3d at 49; 18 Wright & Miller § 4406 & nn.34-37; *supra* p. 6. The lower courts thus properly applied standard *res judicata* principles to bar petitioner’s suit. And even if there were any doubt as to their conclusion “that ordinary claim preclusion applied” to petitioner’s second suit, *e.g.*, Pet. 15 n.5 (emphasis omitted), that would not provide any basis for granting plenary review of other issues not litigated in or addressed by the courts below.⁶

2. Before this Court, petitioner contends that the court of appeals relied on the “*Kessler* doctrine” rather than “ordinary claim preclusion,” Pet. 15 n.5 (emphasis omitted), and urges the Court to grant review to correct “the Federal Circuit’s departure from traditional preclusion principles,” *id.* at 21. But petitioner fails to demonstrate that this case would be a suitable vehicle for considering any questions regarding the *Kessler* doctrine—or that those questions merit this Court’s review in any event.

⁶ In a footnote addressing claim preclusion, petitioner invokes *Lawlor*, 349 U.S. at 322, and *Storey v. Cello Holdings, LLC*, 347 F.3d 370 (2d Cir. 2003). *See* Pet. 15 n.5. Unlike petitioner’s suit, however, those cases involved “new material facts” postdating judgment in prior suits. *See Lawlor*, 349 U.S. at 328 (antitrust suit involving “a substantial change in the scope of the defendants’ alleged monopoly”); *Storey*, 347 F.3d at 385-386 (suit involving a “new act” “after final judgment in the First Action” that could have made a material difference to the plaintiff’s ability to prove “bad faith” on the defendant’s part) (internal quotation marks omitted).

a. In a handful of cases, the Federal Circuit has applied “a separate and distinct doctrine, known as the *Kessler* Doctrine, that precludes some claims that are not otherwise barred by claim or issue preclusion.” *Brain Life, LLC v. Elekta Inc.*, 746 F.3d 1045, 1055-1056 (Fed. Cir. 2014); *see generally Kessler v. Eldred*, 206 U.S. 285, 288 (1907). Under that doctrine, an “adjudged non-infringer” and certain other similarly situated parties may “avoid [the] repeated harassment” of being sued “for continuing [their] business as usual post-final judgment in a patent action.” *Brain Life*, 746 F.3d at 1056 (emphasis omitted); *see also In re PersonalWeb Techs. LLC*, 961 F.3d 1365, 1376 (Fed. Cir. 2020), *cert. pet. pending* No. 20-1394; *SpeedTrack, Inc. v. Office Depot, Inc.*, 791 F.3d 1317, 1324 (Fed. Cir. 2015).

In *SpeedTrack*, 791 F.3d at 1319-1321, for example, a patent owner first sued Walmart for using a computer program alleged to infringe the plaintiff’s patent. After that suit ended in a judgment of noninfringement, the plaintiff sued Office Depot for using the same computer program. *Id.* at 1321-1322. Claim preclusion arguably did not apply because the defendants differed (though the court did not resolve the issue because of difficult “privity” questions). *Id.* at 1323; *see* 18A Wright & Miller § 4464.1. Issue preclusion did not apply because the plaintiff pursued a “theory of infringement” that it had not raised in the *Walmart* action. *SpeedTrack*, 791 F.3d at 1322. The *Kessler* doctrine, however, did apply because the alleged infringement was based on “the same patent using the same . . . software found not to infringe in *Walmart*.” *Id.* at 1324. “[W]hen [an] alleged infringer prevails,” the court explained, “the specific accused device acquires the ‘status’ of a noninfringing device vis-à-vis the asserted patent claims.” *Id.* In other words, the

prevailing party, as well as others who use, make or sell the accused device, gain the right to treat the device as “noninfringing” in subsequent patent suits alleging infringement of the same patent, even where ordinary preclusion principles would not apply. *Id.* at 1324-1325; *see also Rubber Tire Wheel Co. v. Goodyear Tire & Rubber Co.*, 232 U.S. 413, 418-419 (1914) (under “the doctrine of *Kessler v. Eldred*,” a “final adjudication” of noninfringement establishes a “trade right” to “make and sell” the noninfringing product).

b. Petitioner contends that the Federal Circuit’s understanding of *Kessler* rests on a “misreading of *Kessler* itself,” Pet. 3, and, if not, that *Kessler* should be overruled because it is now an “obsolete decision,” *id.* But neither argument is properly presented here. Contrary to petitioner’s suggestion, the court of appeals did not “invok[e]” the *Kessler* doctrine to decide this case. Pet. I; *see also id.* at 11, 15 n.5, 22. Indeed, neither of the lower courts even mentioned *Kessler*.

It would have been surprising if the courts below had relied on *Kessler* because the Board never asked them to do so. As discussed above, the Board has relied on ordinary claim preclusion principles throughout this case—not the *Kessler* doctrine. *See supra* pp. 6-9; C.A. Dkt. 31 at 1-2, 14-22; D. Ct. Dkt. 12 at 12-14; *id.* 27 at 4-8. So petitioner is seriously mistaken in asserting that “there is no dispute that claim preclusion does not apply.” Pet. 22. Not only is there a dispute over that question, it was the *central* dispute in the briefing below. *Supra* pp. 6-9. And the very first mention of *Kessler* in the parties’ briefing came in petitioner’s request for en banc review. *See* C.A. Dkt. 54. Because the court of appeals did not call for a response, this brief in opposition represents the first filing in which the Board has addressed *Kessler*.

Petitioner argues that this case nonetheless provides a “strong vehicle” for addressing *Kessler* principally because the court of appeals quoted from a passage in *Brain Life*. Pet. 22; *see id.* at 15 n.5. It is true that the court of appeals quoted from *Brain Life*, Pet. App. 8a, one of several modern Federal Circuit cases addressing the *Kessler* doctrine, *see supra* p. 10; *Brain Life*, 746 F.3d at 1055-1059. But the court of appeals never suggested that it was applying the *Kessler* doctrine—or that the doctrine altered its analysis of the parties’ dispute over the application of ordinary claim preclusion principles. As another patent plaintiff recently observed in petitioning this Court for review in a separate case, “[a]lthough the [Sowinski] opinion contains one brief quotation from *Brain Life*, the court appears to have relied on that case to support its claim preclusion ruling, not to invoke *Kessler* as a separate basis for dismissal.” Pet. for a Writ of Certiorari at 29, *PersonalWeb Techs., LLC v. Patreon, Inc.*, No. 20-1394 (Apr. 2, 2021). That reading is supported by the fact that the court of appeals paired the quotation from *Brain Life* with a citation to *Lawlor*, *see* Pet. App. 8a—one of this Court’s leading precedents on standard claim preclusion, which decidedly does not involve the *Kessler* doctrine. *See Lawlor*, 349 U.S. at 326-330.

In any event, the court of appeals’ short discussion of *Brain Life* does not amount to the kind of thorough consideration of a question that this Court generally requires before granting plenary review. *Cf. Manuel v. City of Joliet*, 137 S. Ct. 911, 922 (2017) (this Court is “a court of review, not of first view”). Nor does this Court ordinarily grant plenary review in cases, like this one, where the question presented has not been fully briefed and litigated by the parties below. In such cases, the Court cannot be assured that it will

receive the type of adversarial briefing that it generally expects and depends on when resolving a case on the merits. If the Court granted review here, for example, the Board would expect to defend the judgment below on the same ordinary claim preclusion grounds it has pressed throughout this case. *See supra* pp. 5-9. It would not expect to urge application of the *Kessler* doctrine in the first instance before this Court.

c. Petitioner also fails to demonstrate that any questions regarding the scope or continued vitality of *Kessler* merit this Court's review. This Court has previously declined to consider such questions. *See Speedtrack, Inc. v. Office Depot, Inc.*, No. 15-461 (denied Jan. 11, 2016). There is no reason to do otherwise now.

Petitioner contends that the Federal Circuit's application of *Kessler* "conflict[s] with decisions of the Third and Fourth Circuits." Pet. 20. But the decisions he cites from those circuits were issued more than 80 years ago; it is hard to imagine a better example of a stale circuit conflict. *See* Shapiro et al., *Supreme Court Practice* § 4.4, pp. 4-14-4-15 (11th ed. 2019). Moreover, any conflict has long since lost all practical significance: no *Kessler* questions are likely to arise outside of the Federal Circuit today because that circuit (which did not exist 80 years ago) now has exclusive jurisdiction over patent appeals. *See id.* § 4.21, p. 4-61.⁷

⁷ In any event, neither of the decisions cited by petitioner squarely conflicts with the Federal Circuit's modern application of *Kessler*. In *General Chemical Co. v. Standard Wholesale Phosphate & Acid Works, Inc.*, 101 F.2d 178, 180-181 (4th Cir. 1939), the court relied on *Kessler* in recognizing an exception to tradi-

To be sure, this Court sometimes grants plenary review of Federal Circuit decisions in the absence of a circuit conflict to consider patent-law issues of “importance.” Shapiro et al., *Supreme Court Practice, supra*, § 4.21, p. 4-62. But petitioner fails to demonstrate the existence of any such important issue here. The Court first recognized “the doctrine of *Kessler v. Eldred*” over a century ago. *Rubber Tire Wheel Co.*, 232 U.S. at 418; *supra* p. 10. Since then, occasions for its application have been “sparse.” *Brain Life*, 746 F.3d at 1056. Indeed, petitioner cites only two Federal Circuit rulings actually applying the doctrine since the court “revisited *Kessler* in *Brain Life*.” Pet. 8; *see id.* at 9 (citing *PersonalWeb*, 961 F.3d at 1379, and *Speed-Track*, 791 F.3d at 1328-1329).

It is not surprising that the issue arises so infrequently. In most cases where *Kessler* might conceivably be relevant, issue or claim preclusion will apply. Where a plaintiff’s first suit is litigated to final judgment on the merits, issue preclusion will generally bar the plaintiff from suing other parties on the same grounds decided in the first suit. *See supra* pp. 5, 10. And in a case like this one, where the plaintiff’s first infringement suit is dismissed for failure to prosecute

tional “mutuality” limits on issue preclusion, *see* Pet. 6-8 (discussing such limits), but had no occasion to consider whether *Kessler* might have broader implications (such as those endorsed in the Federal Circuit’s recent decisions discussed above, *supra* pp. 10-11). And in *Selden Co. v. General Chemical Co.*, 73 F.2d 195, 197 (3d Cir. 1934), the court only briefly referenced *Kessler*. It held that *Kessler* did not bar a second infringement suit where the defendant in the first suit had allegedly engaged in litigation misconduct by misrepresenting its manufacturing processes. *See id.* at 196-197. The court had no occasion to consider any other potential applications of *Kessler*. *See id.* at 197.

or on other procedural grounds, claim preclusion will often bar the plaintiff from bringing a second suit against the same defendant on grounds that could have been raised in the first suit. *See supra* pp. 5-9. There does not appear to be any pressing need for this Court’s review of the question presented by petitioner—and there is certainly no basis for the Court to address that question in this case.⁸

3. Finally, even if the *Kessler* doctrine were somehow presented by this case, it would have no effect on “the ultimate outcome of the case” if the Court were to reject the doctrine. Shapiro, et al., *Supreme Court Practice, supra*, § 4.4(f), p. 4-18.

First, as an arm of state government, the Board is entitled to sovereign immunity unless it has either consented to suit or Congress has validly abrogated its immunity from suit. *See, e.g., Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 670 (1999). The Board has not consented. *See* D. Ct. Dkt. 12 at 14-16 (invoking sovereign immunity before the district court). And this Court held long ago that Congress has not validly abrogated States’ im-

⁸ The petition in *PersonalWeb Technologies, LLC v. Patreon, Inc.*, No. 20-1394, seeks review of the same question raised by the petitioner in this case. Because that question is not properly presented here, *supra* pp. 11-13, the Court need not delay consideration of this petition for *PersonalWeb*—or hold this case for *PersonalWeb* in the event that the Court grants review in that case. *See* Pet. for a Writ of Certiorari at 28, *PersonalWeb Techs., LLC v. Patreon, Inc.*, No. 20-1394 (Apr. 2, 2021) (explaining that *PersonalWeb* is a “better vehicle” because “*Sowinski* does not clearly rest on *Kessler*”); *id.* at 29 (“the court [in *Sowinski*] held the claims barred by *claim preclusion*”).

munity from patent infringement suits. *See Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627, 647 (1999); *see also Allen v. Cooper*, 140 S. Ct. 994, 1000-1001 (2020). Respect for “sovereign dignity” thus requires dismissal of petitioner’s suit. *Alden v. Maine*, 527 U.S. 706, 715 (1999).⁹

Second, petitioner’s underlying legal claims are meritless. Petitioner’s patent expired in 2015; he cannot now seek relief for the post-2015 infringement alleged in his complaint. *See Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964).¹⁰ The patent is also invalid. This Court has repeatedly made clear that no one may properly obtain a patent claiming a “basic,” “long prevalent,” abstract idea. *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (internal quotation marks omitted); *see also Alice Corp. Pty. v. CLS Bank Int’l*, 573 U.S. 208, 223 (2014). Petitioner’s patent attempts to do just that: it purports to claim a “business method” in obtaining and trading credits for “reduc[ing] . . . pollution levels.” J.A. 201; *see id.* at 180, 218-219. As the patent itself acknowledges, however,

⁹ Sovereign immunity bars petitioner’s requests for both damages and injunctive relief. *See supra* p. 3. While injunctive relief is sometimes appropriate against state *officials* in federal statutory cases, *see Va. Off. for Prot. & Advocacy v. Stewart*, 563 U.S. 247, 255 (2011), petitioner’s complaint does not name any such officials as defendants, *supra* p. 3.

¹⁰ The patent expired because petitioner failed to pay the required maintenance fees. *See* United States Patent and Trademark Office, Patent Maintenance Fees, <https://fees.uspto.gov/MaintenanceFees/fees/details?applicationNumber=09696152&patentNumber=6601033> (last visited May 19, 2021).

“regulators have encouraged the development of ‘pollution-credit offsets.’” *Id.* at 201. Indeed, long before petitioner’s patent application was filed in 2000, state and federal agencies had implemented pollution-credit trading schemes. *See, e.g.*, 42 U.S.C. §§ 7651-7651o (enacted in 1990).¹¹

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

ROB BONTA
Attorney General of California
MICHAEL J. MONGAN
Solicitor General
ROBERT W. BYRNE
DAVID A. ZONANA
Senior Assistant Attorneys General
SAMUEL T. HARBOURT
Deputy Solicitor General
ROBERT D. SWANSON
JONATHAN WIENER
Deputy Attorneys General

May 24, 2021

¹¹ Petitioner’s state law claims, including his elder abuse claim, turn entirely on his allegations of patent infringement. *See* J.A. 20-21. They accordingly fail for the same reasons his infringement claim fails.