

No. 22-_____

IN THE

Supreme Court of the United States

INGENIO, INC., D/B/A KEEN, ETHER, THRYV, INC.,

Petitioners,

v.

CLICK-TO-CALL TECHNOLOGIES, LP,

Respondent.

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

PETITION FOR A WRIT OF CERTIORARI

D. CLAY HOLLOWAY
AMANDA N. BROUILLETTE
KILPATRICK TOWNSEND &
STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, GA 30309

ADAM H. CHARNES
KILPATRICK TOWNSEND &
STOCKTON, LLP
2001 Ross Avenue
Suite 440
Dallas, TX 75201

MITCHELL G. STOCKWELL
Counsel of Record
KILPATRICK TOWNSEND &
STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, GA 30309
(404) 815-6500
mstockwell
@kilpatricktownsend.com

Attorneys for Petitioners

QUESTIONS PRESENTED

This case is the sister case to the *inter partes* review (“IPR”) considered by this Court in *Thryv, Inc v. Click-to-Call Technologies, LP*, 140 S. Ct. 1367 (2020). This case now concerns whether the IPR at issue in the prior case bars Petitioners (“Thryv”) under 35 U.S.C. § 315(e)(2) from challenging a single claim that was presented in the petition, but which was not instituted upon and addressed in the IPR. Consistent with the Patent Trial and Appeal Board’s (“Board” or “PTAB”) practice before the Court’s ruling in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), the PTAB chose not to institute on all such grounds and claims addressed in the petition. As a result, the PTAB did not address claim 27 or the grounds challenging that claim in its final written decision.

For years, the Federal Circuit interpreted 35 U.S.C. § 315(e)(2) according to its plain text as applying only to claims and grounds the petitioner reasonably could have raised in the *instituted* *inter partes* review. Before this case, the Federal Circuit correctly recognized the statute distinguished between claims on which institution was granted and review proceeded to final written decision and claims excluded from the final written decision. In this case, however, the Federal Circuit overruled its precedent and ignored the express statutory language addressing estoppel to hold Thryv is estopped from challenging claim 27.

The questions presented are:

1. Whether 35 U.S.C. § 315(e)’s IPR estoppel provision applies only to claims addressed in the final

written decision, even if other claims were or could have been raised in the petition.

2. Whether the Federal Circuit erroneously extended IPR estoppel under 35 U.S.C. § 315(e) to all grounds that reasonably could have been raised in the petition filed before an inter partes review is instituted, even though the text of the statute applies estoppel only to grounds that “reasonably could have [been] raised during that inter partes review.”

PARTIES TO THE PROCEEDINGS

Petitioners are Thryv, Inc., Ingenio, Inc. and Ether, which were the appellants below.

Respondent is Click-to-Call Technologies, LP, which was the appellee below.

RULE 29.6 DISCLOSURE STATEMENT

Thryv Holdings, Inc. is the parent corporation of all petitioners. Thryv Holdings, Inc. has no parent corporations and no publicly held company owns 10% or more of its stock.

DIRECTLY RELATED PROCEEDINGS

- *Click-to-Call Technologies LP v. Ingenio, Inc., Yellowpages.com, LLC*, No. 2015-1242, United States Court of Appeals for the Federal Circuit. Judgment entered August 16, 2018. Judgment vacated, mandate recalled, and case dismissed for lack of jurisdiction on May 28, 2020.
- *Thryv, Inc., fka Dex Media, Inc. v. Click-To-Call Technologies, LP*, United States Supreme Court, No. 18-916. Judgment entered April 20, 2020.
- *Click-to-Call Technologies LP v. Ingenio, Inc., Thryv, Inc., Ether, a Division of Ingenio, Inc., and Ingenio, Inc. d/b/a Keen*, No. 1:12-CV-465-LY, United States District Court for the Western District of Texas. Judgment entered September 2, 2021.
- *Click-to-Call Technologies LP v. Ingenio, Inc., dba Keen, Ether, Thryv, Inc.*, No. 2022-1016, United States Court of Appeals for the Federal Circuit. Judgment entered August 17, 2022.

TABLE OF CONTENTS

	<i>Page</i>
QUESTIONS PRESENTED	i
PARTIES TO THE PROCEEDINGS.....	iii
RULE 29.6 DISCLOSURE STATEMENT	iv
DIRECTLY RELATED PROCEEDINGS.....	v
PETITION FOR A WRIT OF CERTIORARI	1
OPINIONS BELOW	1
JURISDICTION	1
STATUTORY PROVISIONS INVOLVED	2
STATEMENT OF THE CASE	2
A. The America Invents Act	2
B. The Federal Circuit’s Prior Interpretation of the IPR Estoppel Provision.....	4
C. The Proceedings Below	6
REASONS FOR GRANTING THE PETITION	10
I. THE FEDERAL CIRCUIT’S DECISION OVERRIDES THE PLAIN LANGUAGE OF THE STATUTE.	11
II. THE FEDERAL CIRCUIT’S FOCUS ON EITHER THE PETITION OR WHAT POST- SAS REMAND COULD HAVE BEEN SOUGHT DOES NOT JUSTIFY OVERRULING CLEAR STATUTORY LANGUAGE.....	14
III. APPLE’S PETITION FOR CERTIORARI ACCURATELY IDENTIFIES THE	

STATUTORY BOUNDARY FOR IPR ESTOPPEL.....	18
IV. THIS CASE IS AN IDEAL VEHICLE TO RESOLVE THE ISSUES CONCERNING IPR ESTOPPEL.	21
CONCLUSION	22

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Cal. Inst. Of Tech. v. Broadcom Ltd.</i> , Nos. 2020-2222, 2021-1527 (Fed. Cir. Feb. 22, 2022)	5, 10, 15
<i>Click-to-Call Technologies LP v.</i> <i>Ingenio, Inc., Thryv, Inc., Ether, a</i> <i>Division of Ingenio, Inc., and</i> <i>Ingenio, Inc. d/b/a Keen</i> , No. 1:12-CV-465-LY	v
<i>Click-to-Call Technologies LP v.</i> <i>Ingenio, Inc., Yellowpages.com, LLC</i> , No. 2015-1242	v
<i>Cuozzo Speed Techs., LLC v. Lee</i> , 579 U.S. 261 (2016)	2, 3
<i>Dex Media, Inc. v. Click-To-Call</i> <i>Technologies, LP</i> , No. 18-916	v
<i>In re Doyle</i> , 293 F.3d 1355 (Fed. Cir. 2002)	13
<i>Intuitive Surgical, Inc. v. Ethicon LLC</i> , 25 F.4th 1035 (Fed. Cir. 2022).....	14
<i>Ex parte McCardle</i> , 74 U.S. (7 Wall.) 506 (1868).....	17

<i>Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC</i> , 138 S. Ct. 1365 (2018).....	3, 4
<i>SAS Institute, Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018)	i, 3, 4, 10, 14, 15, 16, 17
<i>Shaw Industrial Group, Inc. v. Automated Creel Systems, Inc.</i>	5, 10
<i>Steel Co. v. Citizens for a Better Env’t</i> , 523 U.S. 83 (1998).....	16
<i>Synopsys, Inc. v. Mentor Graphics Corp.</i> , 814 F.3d 1309 (Fed. Cir. 2016), <i>overruled on other grounds by Aqua Prods., Inc. v. Matal</i> , 872 F.3d 1290 (Fed. Cir. 2017)	4, 5
<i>Thryv, Inc v. Click-to-Call Technologies, LP</i> , 140 S. Ct. 1367 (2020).....	i, v, 7, 8, 16
<i>United States v. Ron Pair Enters., Inc.</i> , 489 U.S. 235 (1989).....	14
Statutes	
28 U.S.C. § 1254(1).....	1
35 U.S.C. § 311(a).....	3
35 U.S.C. § 311(b).....	12
35 U.S.C. § 312(a)(3)	3, 12

35 U.S.C. § 314(a).....	3
35 U.S.C. § 314(d).....	8
35 U.S.C. § 315(e).....	ii, 5, 6, 14, 15
35 U.S.C. § 315(e)(2).....	i, 2, 9, 11, 18
35 U.S.C. § 316(d).....	12
35 U.S.C. § 318	12
35 U.S.C. § 318(a).....	2, 4, 15, 16
AIA.....	2
Other Authorities	
37 C.F.R. § 42.4(a)	3
37 C.F.R. § 42.108(a)	4
157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl)	13
H.R. Rep. No. 112-98, pt. 1 (2011)	2, 13
U.S. Patent No. 5,818,836.....	6, 7

PETITION FOR A WRIT OF CERTIORARI

Petitioner respectfully requests a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The August 17, 2022, opinion of the United States Court of Appeals for the Federal Circuit, is published at 45 F.4th 1363 and is reprinted in the Appendix to the Petition (“App.”) at App. 1a-19a. The November 9, 2022, opinion of the Federal Circuit, denying rehearing, is unpublished and unreported, and is reprinted at App. 76a-77a.

The August 4, 2021 Report and Recommendation from a Magistrate Judge in the Western District of Texas is unpublished but available at 2021 WL 3410316 and is reprinted at App. 25a-43a. The August 30, 2021 Order on the Report and Recommendation in the Western District of Texas is unpublished but available at 2021 WL 4692404 and is reprinted at App. 20a-24a.

The Board’s final written decision is reprinted at App. 44a-75a.

JURISDICTION

The judgment of the United States Court of Appeals for the Federal Circuit was entered on August 17, 2022. App. 1a. Petitioners’ Petition for Rehearing was denied on November 9, 2022. App. 77a. On January 27, 2023, the Chief Justice granted petitioners an extension of time to file this petition until March 9, 2023. No. 22A674. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Section 315(e)(2) of Title 35 of the U.S. Code provides as follows:

(e) ESTOPPEL. —

...

(2) CIVIL ACTIONS AND OTHER PROCEEDINGS.—

The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

STATEMENT OF THE CASE

A. The America Invents Act

In 2011, Congress enacted the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011). With the AIA, Congress intended to provide a “quick and cost effective alternative[] to litigation” and to “improve patent quality and restore confidence in the presumption of validity that comes with issued patents in court.” H.R. Rep. No. 112-98, pt. 1, at 45, 48 (2011). The AIA replaced the former system of inter partes reexamination with a new adjudicatory proceeding called inter partes review (“IPR”). *See Cuozzo Speed Techs., LLC v. Lee*, 579 U.S.

261, 267-8 (2016). IPR is “a second look at an earlier administrative grant of a patent.” *Id.* at 279. The AIA created, within the Patent and Trademark Office (“PTO”), the Board, which “conducts the proceedings, reaches a conclusion, and sets forth its reasons.” *Id.* at 268.

The AIA established a two-step process for IPR proceedings. *First*, “[a]ny person other than the patent owner can file a petition for inter partes review.” *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1371 (2018); *see* 35 U.S.C. § 311(a). The AIA requires the petition to identify “the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). The patentee then has “the right to file a preliminary response to the petition” containing “reasons why no inter partes review should be instituted based upon the failure of the petition to meet any requirement of this chapter.” *Id.* § 313.

The PTAB, acting on behalf of the Director of the PTO, *see* 37 C.F.R. § 42.4(a), determines whether to “institute” an IPR. *See* 35 U.S.C. § 314(a). The PTAB may institute an IPR if it concludes that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” *Id.* “The decision whether to institute inter partes review is committed to the Director’s discretion.” *Oil States*, 138 S. Ct. at 1371.

Before this Court’s decision in *SAS*, the PTAB exercised its discretion by issuing, in some cases, “partial” institutions. As *SAS* summarized, the Board could conclude that a subset of claims challenged by the petitioner was likely to succeed. *SAS Inst.*, 138 S.

Ct. at 1354. The Director justified such “partial” institutions based on regulation stating “the [Director] may authorize the review to proceed on all or some of the challenged claims and on all or some o[f] the grounds of unpatentability asserted for each claim.” *Id.* (quoting 37 C.F.R. § 42.108(a)). From that point on, a pre-SAS review proceeded on just the subset of claims or grounds the Director found were likely to succeed in finding invalidity.

If the PTAB institutes an IPR, the Board conducts a trial to determine if any of the challenged patent claims should be cancelled. *See Oil States*, 138 S. Ct. at 1371-72. The trial process includes “many of the usual trappings of litigation,” as “[t]he parties conduct discovery and join issue in briefing and at an oral hearing.” *SAS*, 138 S. Ct. at 1354. Thereafter, the PTAB must “issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added” by amendment. 35 U.S.C. § 318(a).

But in pre-SAS reviews where a “partial” institution occurred, the final written decision would only address the claims that proceeded beyond the institution decision and would not address the claims the Director refused to review. *SAS*, 138 S. Ct. at 1354..

B. The Federal Circuit’s Prior Interpretation of the IPR Estoppel Provision

Before this case, the Federal Circuit grounded IPR estoppel based on the text of the statute.

For example, *Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1316 (Fed. Cir. 2016), *overruled on other grounds by Aqua Prods., Inc. v. Matal*, 872

F.3d 1290 (Fed. Cir. 2017), made it clear that under the IPR estoppel statute “[t]he validity of claims for which the Board did not institute inter partes review can still be litigated in district court.” Such a result generated “no inconsistency” because IPR “cannot replace the district court in all instances.” *Id.*

In *Shaw Industrial Group, Inc. v. Automated Creel Systems, Inc.*, the petitioner asserted for certain claims a prior art reference, but the grounds based on that reference were not instituted. 817 F.3d 1293, 1290-300 (Fed. Cir. 2016), *overruled in part by Cal. Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 991 (Fed. Cir. 2022) (“*Caltech*”), *petition for cert. docketed*, No. 22-203 (Sept. 7, 2022)).¹ *Shaw* thus analyzed whether 35 U.S.C. § 315(e) would apply to claims and grounds that were in a petition, but on which the Director declined to institute a review. *Id.* at 1300. *Shaw* held that because the claims and grounds that did not progress beyond the petition were not raisable during the review, having been denied such review, no estoppel attached. *Id.*

Even when the Federal Circuit proceeded to overrule *Shaw* in the *Caltech* decision, it initially limited the impact of its decision. Specifically, *Caltech* reasoned that “we need not decide the scope of preclusion in cases in which the Board declined to institute on all grounds and issued its final written decision pre-SAS.” 25 F.4th at 991 n.5. The Federal

¹ The petition for certiorari was filed by Apple, Inc., another of the defendants in the *Caltech* case. The question presented in Apple’s petition is the same as question 2 presented herein. This Court has initially considered Apple’s petition and issued an order on January 17, 2023 calling for the views of the Solicitor General.

Circuit's view that estoppel under § 315(e) estoppel did not extend to claims that the Director had excluded from review accordingly remained post-*Caltech*.

C. The Proceedings Below

i. The District Court Action and the Related IPR Proceeding

Respondent Click-to-Call Technologies, LP (“CTC”) filed complaints asserting infringement of U.S. Patent No. 5,818,836 (“’836 Patent”) against multiple parties in the Western District of Texas. App. 26a-27a. One of those actions accused AT&T, Inc., Ingenio, Inc., and YellowPages.com, LLC, of infringing the ’836 Patent. *Id.* The litigation was stayed pending resolution of the IPR proceedings described below. *Id.* During that stay, mergers and a corporate name change altered the name of the relevant defendant to Thryv, Inc. *Id.*

On May 28, 2013, Ingenio, LLC (one of the interim entities in petitioners’s corporate history), and other parties filed an IPR petition challenging the ’836 Patent on grounds of anticipation and obviousness. App. 27a-29a. While the IPR petition was pending, respondent was required to narrow the asserted claims and did so limiting the case to claims 1, 2, 8, 12, 13, 16, 26, and 27. *Id.* at 4. Shortly thereafter, the PTAB, found that “there is a reasonable likelihood” that the petitioners could show that 13 identified claims of the ’836 Patent were unpatentable, and it therefore instituted inter partes review as to those claims. *Id.* at 4a-5a.

The “partial” institution broke down along the lines of the asserted references. Petitioners had

presented various “grounds” based on different prior art. One set of grounds involved the Freeman prior art and associated references, while another set of grounds involved the Dezonno prior art, either alone or combined with associated references. *Id.* at 4a. One of the grounds based on Freeman included claims 24 and 27, while the grounds based on Dezonno did not address those claims. *Id.*

In December 2013, petitioner moved to stay the district court proceedings and the district court stayed proceedings pending resolution of the IPR. *Id.* at 5a.

On October 28, 2014, the PTAB issued a Final Written Decision. App. 5a-6a. The decision held that the 13 claims on which the Board instituted the IPR were either anticipated or obvious and therefore were unpatentable. App. at 74a. Relevant here, the Board’s decision relied on the Dezonno reference to find that the claims were anticipated and obvious over the prior art. *Id.* Because claim 27 was not selected for institution and not addressed in the ground based on Dezonno, it was not addressed in the Board’s decision. *Id.*

ii. The Appellate Proceedings and this Court’s Prior Decision Concerning the IPR

After the Final Written Decision finding the 13 claims permitted for review were anticipated and obvious, respondent appealed to the Federal Circuit. *Thryv v. Click-to-Call*, 140 S. Ct. at 1370. Respondent argued only that the petition was time barred, not that the findings of anticipation and obviousness of the 13 claims was flawed. *Id.* at 1371. The Federal Circuit dismissed that appeal for lack of subject

matter jurisdiction. *Id.* This Court granted certiorari, vacated, and remanded the case back to the Federal Circuit where the case was dismissed again. *Id.* at 1372. Subsequently, the Federal Circuit held that the time bar provisions of the implementing IPR statute were reviewable by the Federal Circuit. *Id.*

To preserve its IPR victory, petitioner sought certiorari that the time bar issue was not reviewable. This Court ultimately sided with petitioner, vacated the Federal Circuit’s judgment and “remand[ed] the case with instructions to dismiss for lack of appellate jurisdiction.” *Id.* at 1377.

After all those proceedings, the 13 claims addressed in the Final Written Decision were invalid, and no further appellate jurisdiction existed based on the operative IPR statute—35 U.S.C. § 314(d).

iii. The District Court’s Summary
Judgment Decision

Following confirmation of the IPR results in view of this Court’s decision, respondent sought to lift the stay in the district court to press its infringement claims by asserting that claims 27 (part of respondent’s election of claims) and claims 24 and 28 (not part of that election) should proceed. App. 6a. This district court concluded that claims 24 and 28 were not part of the case following the election of claims before the stay. App. 35a-36a.

Petitioner moved for summary judgment that, in light of the findings by the PTAB during the IPR, claim 27 could not be asserted on two, distinct bases. *First*, petitioner urged that respondent was barred from asserting claim 27 because the common law doctrine of collateral estoppel applied to invalidate

that claim. App. 32a. *Second*, and separately, petitioner urged that claim 27 was anticipated by Dezonno. *Id.* Respondent opposed, arguing that IPR estoppel precluded the ground of anticipation and that common law collateral estoppel did not apply. *Id.* at 41a.

The district court, through the magistrate's recommendation that was adopted *in toto*, found that claim 27 was anticipated, and did not address the common law collateral estoppel defense. App. 20a-24a. The district court stated, because "the court determines the doctrine of anticipation applies and renders claim 27 invalid, the court also concludes it is unnecessary to address Defendants' invalidity contention based on collateral-estoppel." App. 23a. Notably, the district court found that IPR estoppel did not apply because the Board had not instituted review of claim 27. App. 41a.

iv. The Federal Circuit Appeal Raising Estoppel

Respondent appealed the district court's finding of anticipation by Dezonno, arguing that 35 U.S.C. § 315(e)(2) estops petitioner from challenging claim 27. App. 6a.

The Federal Circuit held that IPR estoppel under § 315(e)(2) applied to petitioner's summary judgment motion because claim 27 "reasonably could have been raised" in the underlying IPR. App. 8a-9a. The Federal Circuit noted that § 315(e)(2) states estoppel extends to claims addressed in the final written decision but that its absence from the decision in this case does not absolve petitioner of the estoppel effect. *Id.* at 10a.

The Federal Circuit further noted that its decision in *Shaw* had held that “unpatentability grounds that were in a petition but rejected by the Board at institution were not subject to IPR estoppel.” App. 13a. Nevertheless, the Federal Circuit concluded that because claim 27 was addressed in a non-instituted ground, that petitioner could have raised that claim against Dezonno. *Id.*

The Federal Circuit relied heavily on *Caltech*, which had overruled *Shaw*. App. 13a. The Federal Circuit cited *Caltech*’s holding that “it is the petition, not the institution that defines the scope of the IPR,” and thus “it is the ‘petitioner’s contentions’ that define . . . the extent of the estoppel.” App. 11a (quoting *Caltech*, 25 F.4th at 990). The Federal Circuit reasoned that “[petitioner] chose not to assert that Dezonno anticipated claim 27 in its petition and put all its eggs in the Freeman basket. In other words, the Board was never given the chance to consider whether Dezonno anticipated claim 27.” App. 14a, n.3. Accordingly, the Federal Circuit reasoned that PTAB’s error in granting “partial” institutions before the Court’s decision in *SAS* and the Federal Circuit’s affirmance of that practice, claim 27 could have been challenged even though it was excluded by the Board. *Id.* at 13a-14a. The result was to further overrule *Shaw* and overturn the finding of invalidity by the district court based on estoppel. *Id.* 14a.

Thryv petitioned for panel and en banc rehearing, which the Federal Circuit denied. App. 77a.

REASONS FOR GRANTING THE PETITION

Should this Court accept Apple’s petition for certiorari and reverse *Caltech*, the Federal Circuit’s

decision in this case should be vacated. Because this Court's disposition of Apple's petition in the *Caltech* cases will directly address that issue, Thryv respectfully submits that the instant petition should, at minimum, be held pending this Court's disposition of the Apple petition, and then disposed of accordingly.

But Thryv's case raises an independent, and even more crucial, question: whether IPR estoppel applies to all claims that were or could have been raised in the petition, even if the PTAB does not address all such claims in the final decision.

I. THE FEDERAL CIRCUIT'S DECISION OVERRIDES THE PLAIN LANGUAGE OF THE STATUTE.

The Federal Circuit's decision contradicts the plain language of the statute. By expanding statutory estoppel to cover any claim that was or could have been raised in a petition but which was not addressed in the IPR or the final decision, the Federal Circuit effectively rewrote the statute.

1. The language of § 315(e)(2) refutes the Federal Circuit's holding, especially when read in the context of the statute as a whole. That section is clear that when there is "inter partes review of *a claim* in a patent . . . that *results in a final written decision*," the petitioner may not assert that "*the claim* is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review." 35 U.S.C. § 315(e)(2) (emphasis added). In other words, IPR estoppel only applies to claims that result in, and are addressed by, a final written decision.

Notably, the statutory section is also careful to distinguish between claims and grounds. As to claims, estoppel only applies to “the claim” that is addressed in the final written decision. But, as to grounds, estoppel applies to “any ground” that was “raised or reasonably could have been raised during that inter partes review.” In the case of claims, the trigger for estoppel to apply is both clear and narrow—estoppel applies only to claims addressed in the final written decision.

2. The statute as a whole makes clear why the trigger for estoppel is so narrow as to the claims challenged. The statute allows the petitioner to “request to cancel as unpatentable 1 or more claims” (35 U.S.C. § 311(b)), and specifies the petition “identif[y], in writing and with particularity, each claim challenged.” 35 U.S.C. § 312(a)(3). Moreover, Section 316(d)(1) allowed the patent owner to “file 1 motion to amend the patent” but only to “[c]ancel any challenged patent claim” or, “[f]or each challenged claim, propose a reasonable number of substitute claims.”

These provisions show Congress plainly aimed to allow the IPR to focus upon only a subset of claims, and only those claims would, in turn, be subject to amendment. As a result, under 35 U.S.C. § 318, “[i]f an inter partes review is instituted and not dismissed,” the Board would only “issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d).”

The overall statutory structure streamlined IPRs and advanced the intent behind the statutory change. IPRs aimed to provide a “quick and cost effective

alternative[] to litigation” and to “improve patent quality and restore confidence in the presumption of validity that comes with issued patents in court.” H.R. Rep. No. 112-98, pt. 1, at 45, 48 (2011). Congress specifically intended IPRs to result in faster adjudication than either patent litigation in federal court or the previous mechanism of inter partes reexamination. *See* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (an AIA co sponsor explaining that Congress intended IPRs to “substantially accelerate the resolution of inter partes cases”).

3. In drafting the IPR estoppel statute, “Congress spoke to [the] matter” of what claims the estoppel applies to: claims that reach a final written decision. *In re Doyle*, 293 F.3d 1355, 1363 (Fed. Cir. 2002). And courts “may not rewrite the statute based on [their] own view of the proper outcome.” *Id.* But that is precisely what the Federal Circuit has done. It has revised the statute to bar Thryv and other petitioners from challenging not simply the claims addressed in the actual final written decision, but any other claim that could have been so addressed.

This Court’s review is accordingly needed to restore the proper scope of IPR estoppel. It must be limited to only those claims actually addressed in the final written decision.

II. THE FEDERAL CIRCUIT’S FOCUS ON EITHER THE PETITION OR WHAT POST-SAS REMAND COULD HAVE BEEN SOUGHT DOES NOT JUSTIFY OVERRULING CLEAR STATUTORY LANGUAGE.

This Court has long held that “[a]s long as the statutory scheme is coherent and consistent, there generally is no need for a court to inquire beyond the plain language of the statute.” *SAS*, 138 S. Ct. at 1357 (quoting *United States v. Ron Pair Enters., Inc.*, 489 U.S. 235, 240-41 (1989)). Every word of the statute has meaning and, here, the language plainly limits estoppel to claims addressed in the final written decision.

1. The Federal Circuit itself previously recognized the clear command of the statutory language and appropriately limited the reach of estoppel.

For example, *Intuitive Surgical, Inc. v. Ethicon LLC*, 25 F.4th 1035 (Fed. Cir. 2022), addressed Section 315(e)(1), which includes the same functional estoppel language but applies it to Patent Office versus district court proceedings. *Intuitive Surgical* upheld the PTAB’s decision to estop the petitioner from proceeding on a third petition after the Board had already resolved two other petitions that addressed the same claims. In affirming, *Intuitive Surgical* explained that the petitioner could have better managed its challenges, reasoning that “[a] petitioner may also file multiple petitions where each petition focuses on a separate, manageable subset of the claims to be challenged—as opposed to subsets of grounds—as Section 315(e)(1) estoppel applies on a claim-by-claim basis.” 25 F. 4th at 1041-42. In other words, a petitioner could strategically choose to

challenge certain claims and not others in any given petition without any risk of estoppel on the unchallenged claims.

Even in the *Caltech* decision that overruled *Shaw*, the Federal Circuit took pains to clarify that IPR estoppel only bars a petitioner from later raising **grounds, but not claims**, it reasonably could have raised in the IPR. The original *Caltech* opinion stated that IPR estoppel applies to “all **claims and** grounds not in the IPR but which reasonably could have been included.” Errata at 1, *Cal. Inst. Of Tech. v. Broadcom Ltd.*, Nos. 2020-2222, 2021-1527 (Fed. Cir. Feb. 22, 2022) (No. 67) (emphasis added). An errata deleted the reference to claims and clarified that IPR estoppel applies only to “all grounds not stated in the petition but which reasonably could have been asserted against the claims included.” *Id.* *Caltech* thus definitively indicated that IPR estoppel only bars grounds that reasonably could have been raised, not claims that reasonably could have been in the IPR, but were not.

2. Abandoning its prior interpretations, the Federal Circuit sought to justify its new and atextual interpretation by focusing on the petition, rather than the final written decision. The Federal Circuit thought this shift justified by this Court’s decision in *SAS*. But *SAS Institute* did not change the statutory text of Section 315(e) or its plain meaning. *SAS* instead construed Section 318(a), a different provision with different language. Notably, Section 315(e) makes no explicit reference to “patent claim(s) challenged by the petitioner,” as does Section 318(a). It instead references “an inter partes review of a claim” and requires such review to “result[] in a final

written decision under section 318(a)” for estoppel to apply to “that claim.” In short, the statutory text makes plain that “an inter partes review” must occur as to any claim as to which estoppel will attach.

SAS, of course, corrected the Board’s previous error in granting only partial institutions, holding that “[t]he agency cannot curate the claims at issue [in the petition] but must decide them all.” 138 S. Ct. at 1353. But the IPR addressed by this case, as the Federal Circuit acknowledged, was decided under the Board’s erroneous pre-SAS practice of partial institution. App. 12a (noting “the Board’s mistake” in partially instituting the IPR). But nothing in SAS suggests that estoppel should extend beyond the statute as written and reach claims never addressed in the actual final written decision.

3. The Federal Circuit implicitly recognized as much when it turned to speculation about what “could have” been raised. Specifically, it held that “[d]ue to the long appellate history of the IPR proceeding, the appeal of Ingenio’s IPR was still pending at the time SAS issued,” then speculated that Ingenio “could have” then sought to address claim 27, and ultimately found that Ingenio “forewent the route taken by many other parties post-SAS to have the Board address all claims and all grounds in their petitions.” App. 11a.

Such a theoretical possibility was barred by this Court’s remand “instructions to dismiss for lack of appellate jurisdiction.” *Thyrv*, 140 S. Ct. at 1377. It is axiomatic that “[w]ithout jurisdiction the court cannot proceed at all in any cause. Jurisdiction is power to declare the law, and when it ceases to exist, the only function remaining to the court is that of announcing the fact and dismissing the cause.” *Steel Co. v.*

Citizens for a Better Env't, 523 U.S. 83, 94 (1998) (quoting *Ex parte McCardle*, 74 U.S. (7 Wall.) 506, 514 (1868)). Because there was no jurisdiction over the appeal, the Federal Circuit had no power to entertain a post-SAS remand request. Thus, the PTAB's decision was final as of the October, 2014 issuance of the final written decision—years before SAS.

Importantly, the Federal Circuit's new estoppel standard will have far-reaching effects on IPR petitioners. So long as a petitioner "could" have addressed a claim within a petition, estoppel must apply to all such claims. As a practical matter, petitioners must now put up all arguments against all claims or risk estoppel as to unchallenged claims, rather than petitioning to address only a limited set of claims and grounds. Such a result contradicts the statute and this Court's decision in SAS, which gave petitioners freedom to "define the scope of the litigation." 138 S. Ct. at 1357. Post-SAS, petitioners should have been able to control the scope of the estoppel by focusing on the specific claim(s) to challenge.

Under the Federal Circuit's new rule, however, petitioners may be estopped based on unchallenged claims that could have been addressed in the petition and IPR. That result upends the Congressional desire to create efficient and focused proceedings. Only by correcting the Federal Circuit's interpretation and returning to the statutory language can the aim of ensuring focused disputes consistent with the goals of inter partes reexamination and litigation generally be achieved.

**III. APPLE’S PETITION FOR CERTIORARI
ACCURATELY IDENTIFIES THE
STATUTORY BOUNDARY FOR IPR
ESTOPPEL.**

Should this Court accept Apple’s petition for certiorari and reverse *Caltech*, the Federal Circuit’s decision in this case should be vacated. Because this Court’s disposition of Apple’s petition in *Caltech* directly impacts the second question presented by this petition, Thryv respectfully submits that the instant petition should, at minimum, be held pending this Court’s disposition of the Apple petition, and then disposed of accordingly.

1. Notable similarities exist between Thryv’s petition and the Apple petition. Both address the Federal Circuit’s refusal to give meaning to the statutory language governing estoppel. In Thryv’s case, estoppel is being extended to a claim not in the final written decision but only in the petition in a pre-SAS “partial” institution context. While Apple’s petition involves different facts, both petitions identify a key error—the Federal Circuit’s focus on what was either in, or available at, the petition stage fails to give meaning to whether a claim could be challenged on a ground “during that inter partes review.” This is especially true in Thryv’s case because the “could have been raised” language modifies “ground” not “claim.”

The plain language of the statute is clear, estoppel only attaches to “review of a claim . . . that results in a final written decision . . . on any ground that the petitioner raised or reasonably could have raised during that inter partes review.” 35 U.S.C. § 315(e)(2). As Apple has highlighted, the Federal Circuit is

ignoring “a claim in a patent under this chapter that results in a final written decision” and “during that inter partes review” and expanding estoppel in ways that destroy IPR’s utility as an efficient challenge in lieu of litigation, and replace it with a shield precluding litigation once a petition for IPR has been filed. Apple Reply 6.

Because “during” has its ordinary meaning of occurring within a defined time, which Apple cites (Apple Pet. 15) and Caltech does not dispute, estoppel cannot attach to a ground that was not part of the final written decision because it did not survive the institution decision. The Federal Circuit’s entire construction ignores that if a ground challenging a claim cannot be addressed during the period following institution, it cannot subsequently be in the final written decision, and therefore cannot be the basis for estoppel.

2. In Thryv’s case, the Federal Circuit repeatedly emphasized that claim 27 was in the petition and therefore Thryv could have raised Dezonno for claim 27 “in the petition” meaning it could have been raised “during that inter partes review.” App. 13a. But that incorrectly shifts the time for estoppel to take effect from what the PTAB addressed in the final written decision (“during that inter partes review”) as the statute requires, to what a petitioner could argue “in the petition.” These are not the same thing.

Apple correctly points out that the institution decision is not the intended harbinger for the scope of estoppel. Apple Reply 3. Actual examples exist of petitioners withdrawing claims that were instituted before final written decision. Apple Pet. 21-22. That is no different than a party pre-SAS choosing certain

grounds for one claim and different grounds for a different claim. In both circumstances, grounds of invalidity and their corresponding claims were part of the petition, but were not “raised during that inter partes review” because they were removed before final written decision. As such, neither should be subject to the estoppel provisions.

In Thryv’s case, the Federal Circuit continues to ignore that Congress intentionally uses the words “in the petition” when drafting other AIA provisions but chose to define the scope of estoppel to what was addressed “during that inter partes review” as identified in the final written decision. Canons of statutory construction counsel against ignoring Congress’s aims in drafting. Apple Pet. 18. And, those canons demonstrate that, in Thryv’s case, the Federal Circuit’s repeated statement that claim 27 was in the petition does not overcome the statutory language.

3. Caltech has urged that the legislative history supports ignoring the clause “during that inter partes review” in favor of simply considering whether a ground to a claim could have been raised in the petition. Caltech Opp. 17-20. But, critically, other than generic purpose language, the best evidence Caltech provides supports the proper construction presented by Thryv and Apple.

For example, general intention testimony does not demonstrate that the estoppel provision should ignore the plain language. Statements such as those by former Director Kappos does not comport with the scope as codified. Caltech Opp. p. 19. The statute says that estoppel applies to “a claim . . . in a final written decision . . . on any ground that the petitioner raised or reasonably could have raised during that inter

partes review.” So the then-Director’s testimony is not reflective of the scope as written.

Instead, consider the former estoppel provisions in the former inter partes reexamination regime Congress sought to improve upon with IPRs. Caltech argues that estoppel in that statutory regime was based on availability of the art. *Id.* at 20. But the instant statute abandons mere availability. Now, estoppel as to a ground is tied to capability of the art being raised “during that inter partes review,” not “in the petition.” And critically to Thryv’s case, the “could have been raised” language does not impact claims that are not addressed by the final written decision.

Thus, if the Court accepts Apple’s petition and gives meaning and import to the statutory linkage of estoppel to what “could have [been] raised during that inter partes review,” Thryv could not be estopped. Thryv could raise neither claim 27, nor other grounds precisely because before the IPR was instituted the Board barred consideration of those topics “during” the IPR. As such, the Federal Circuit’s application of estoppel was erroneous and contrary to proper construction of the statute.

IV. THIS CASE IS AN IDEAL VEHICLE TO RESOLVE THE ISSUES CONCERNING IPR ESTOPPEL.

Thryv’s petition presents an independent and important issue for this Court to resolve—whether petitioners can truly be in charge of the direction and content of their IPR, or whether estoppel will force petitioners to challenge all, rather than the key subset, of claims. Likewise, Thryv’s case overlaps with the issue Apple has raised concerning whether

and how to give meaning to the statutory requirement that estoppel attach only to grounds that could have been raised during the IPR.

The AIA proceedings have been in place for well over a decade now. Estoppel issues will be and shall continue to accrue at an accelerating rate. Thryv's case provides an appropriate vehicle for restoring the statutory language and ensuring the Congressional intent of fast, focused and efficient IPR challenges is realized.

CONCLUSION

For the foregoing reasons, the Court should grant the petition.

Respectfully submitted.

AMANDA N. BROUILLETTE
KILPATRICK TOWNSEND &
STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, GA 30309
(404) 815-6500

ADAM H. CHARNES
KILPATRICK TOWNSEND &
STOCKTON LLP
2001 Ross Avenue
Suite 4400
Dallas, TX 75201

MITCHELL G. STOCKWELL
Counsel of Record
KILPATRICK TOWNSEND &
STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, GA 30309
(404) 815-6500

mstockwell
@kilpatricktownsend.com

Counsel for Petitioner

APPENDIX

TABLE OF APPENDICES

	<i>Page</i>
APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, FILED AUGUST 17, 2022	1a
APPENDIX B — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF TEXAS, AUSTIN DIVISION, FILED AUGUST 30, 2021	20a
APPENDIX C — REPORT AND RECOMMENDATION OF THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF TEXAS, AUSTIN DIVISION, FILED AUGUST 4, 2021	25a
APPENDIX D — DECISION OF THE UNITED STATES PATENT AND TRADEMARK OFFICE, PATENT TRIAL AND APPEAL BOARD, DATED OCTOBER 28, 2014	44a
APPENDIX E — DENIAL OF REHEARING OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, DATED NOVEMBER 9, 2022	76a

1a

**APPENDIX A — OPINION OF THE UNITED
STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT, FILED AUGUST 17, 2022**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2022-1016

CLICK-TO-CALL TECHNOLOGIES LP,

Plaintiff-Appellant,

v.

INGENIO, INC., DBA KEEN, ETHER, THRYV, INC.,

Defendants-Appellees.

August 17, 2022, Decided

Appeal from the United States District Court for the
Western District of Texas in No. 1:12-cv-00465-LY, Judge
Lee Yeakel.

Before STOLL, SCHALL, and CUNNINGHAM,
Circuit Judges.

STOLL, *Circuit Judge.*

This appeal involves the district court patent-
infringement suit that is the sister case to the inter partes
review considered by the Supreme Court in *Thryv, Inc*

Appendix A

v. Click-to-Call Technologies, LP, 140 S. Ct. 1367, 206 L. Ed. 2d 554 (2020). Significant to this case, despite Ingenio seeking IPR of all of the asserted claims of the patent at issue, U.S. Patent No. 5,818,836, the Patent Trial and Appeal Board only partially instituted the IPR. Specifically, in its final written decision, the Board addressed and found persuasive unpatentability grounds based on one reference, Dezonno, but refused to consider grounds based on another reference, Freeman. Notably, the Freeman grounds challenged asserted claim 27 of the '836 patent, whereas the Dezonno grounds did not. During the pendency of the appeal of the IPR, and while the district court case was stayed, the Supreme Court overruled the practice of partial institutions in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 200 L. Ed. 2d 695 (2018). Ingenio, however, never sought remand under *SAS* for the Board to consider Ingenio's challenge to claim 27.

The district court revived the case once the IPR proceeding was finally concluded. In the post-IPR district court proceedings, Ingenio moved for summary judgment, arguing that the only asserted claim not finally held unpatentable in the IPR, claim 27, was invalid based on the same reference that Ingenio had used against the other asserted claims in its IPR petition—Dezonno. Click-to-Call argued that Ingenio was estopped from pressing this invalidity ground against claim 27 due to IPR estoppel under 35 U.S.C. § 315(e)(2), but the district court did not accept this argument.

This case thus requires us to consider the application of 35 U.S.C. § 315(e)(2) under a rather unusual set of facts.

Appendix A

The Board instituted pre-SAS and did not institute on all grounds. And when given the opportunity to do so post-SAS, Ingenio did not seek remand for institution on the non-instituted grounds. We conclude that under the facts of this case, the district court erred in not applying IPR estoppel under 35 U.S.C. § 315(e)(2) to claim 27 based on Dezonno. Accordingly, we reverse as to claim 27 and remand for further proceedings.

Click-to-Call also argues that the district court abused its discretion in not allowing Click-to-Call to amend its selection of asserted claims to add two claims that were not at issue in the IPR (claims 24 and 28). The district court did not abuse its discretion in this regard, and thus we affirm the district court's denial of Click-to-Call's request to amend.

BACKGROUND

Click-to-Call filed a complaint for patent infringement against several entities (including Ingenio) more than ten years ago, on May 29, 2012. J.A. 30. Originally, Click-to-Call asserted sixteen claims of the '836 patent. J.A. 64-65 (asserting claims 1, 2, 8, 12-13, 15-16, 19, 22-24, 26-30). In response, on May 28, 2013, Ingenio filed a petition for IPR challenging the sixteen asserted claims and one additional claim (claim 18). In its petition, Ingenio challenged these claims on six grounds, three based on Dezonno and three based on Freeman.

While the IPR petition was pending, the district court issued a *Markman* order construing certain claim

Appendix A

terms on August 16, 2013. J.A. 38 (docket report showing D.I. 137 (Consolidated *Markman* Order)). On September 11, 2013, the district court entered a scheduling order requiring plaintiffs to narrow their asserted claims to only eight claims. J.A. 38 (docket report showing D.I. 138 (Scheduling Order)); J.A. 1255. Click-to-Call complied on October 11, 2013, selecting claims 1, 2, 8, 12, 13, 16, 26, and 27. J.A. 1258.

Less than a month after this selection, the Board partially instituted IPR based on Ingenio's petition. J.A. 1539-68 (Oct. 30, 2013). The Board instituted only on the Dezonno-based grounds and refused institution of the Freeman-based grounds. As shown below, claim 27 was challenged in the petition based only on Freeman, not Dezonno.

Reference(s)	Basis	Claims Challenged
Dezonno	§ 102(e)	1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 ¹
Dezonno	§ 103(a)	1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 ²
Dezonno and Mosaic Handbook	§ 103(a)	22 and 29
Freeman and Attention Shoppers	§ 103(a)	1, 2, 8, 12, 13, 15, 16, 18, 19, 22-24, and 26-30
Freeman, Attention Shoppers, and Blinken	§ 103(a)	8, 15, and 16
Freeman, Cyberspace, and Whole Internet	§ 103(a)	1, 2, 8, 12, 13, 15, 16, 18, 19, 22-24, 26, 29, and 30

Appendix A

J.A. 1547 (Board’s institution decision listing grounds) (green shading added to instituted grounds, yellow highlighting added to the only challenge of claim 27).

Back at the district court, Ingenio moved to stay the case until the IPR was resolved. The district court granted the motion on December 5, 2013. J.A. 39 (docket report showing D.I. 147 (Order Granting Motion to Stay Case)). This stay would last for years because of the lengthy subsequent appellate history of the IPR.

The Board issued its final written decision on October 28, 2014. The Board found all claims challenged on the Dezonno grounds to be unpatentable. J.A. 1597. Click-to-Call appealed based on a time-bar dispute.¹ After all appeals, the Board’s decision became final after our May 28, 2020 order dismissing the appeal. *Click-to-Call Techs., LP v. Ingenio, Inc.*, 810 F. App’x 881 (Fed. Cir. 2020). During the pendency of the IPR appeal, Ingenio did not ask for remand under *SAS* to review the non-instituted grounds. Thus, dependent claim 27 survived the IPR. That claim recites: “The method of claim 1, wherein the second information comprises an advertisement.” ’836 patent Ex Parte Reexamination Certificate col. 4 ll. 26-27.

1. During the IPR, Click-to-Call had argued that Ingenio’s petition was time barred under 35 U.S.C. § 315(b). The Board disagreed and reached the merits. *Oracle Corp. v. Click-to-Call Techs. LP*, No. IPR2013-00312, 2014 WL 5490583 (P.T.A.B. Oct. 28, 2014). Click-to-Call appealed, and we held that the Board erred in its time-bar determination. *Click-to-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir. 2018). The Supreme Court, however, held that this time-bar question was unreviewable under 35 U.S.C. § 314(d). *Thryv*, 140 S. Ct. at 1373-74.

Appendix A

After the IPR finally concluded, the district court lifted the stay. On October 20, 2020, Ingenio filed a motion for summary judgment of invalidity. In responding to Ingenio's motion, Click-to-Call requested leave to amend its asserted claims to add two other claims (claims 24 and 28) that were not at issue in the IPR. In addition, Click-to-Call argued that Ingenio was estopped from pressing invalidity of claim 27 based on Dezonno due to IPR estoppel under 35 U.S.C. § 315(e)(2). The magistrate judge filed a Report and Recommendation recommending granting Ingenio's motion on the basis that Dezonno anticipated claim 27 and that Click-to-Call should not be granted leave to amend its asserted claims. J.A. 7-19. The district court adopted the Report and Recommendation on August 30, 2021, and granted summary judgment of invalidity. J.A. 3-6. Final judgment issued on September 2, 2021. J.A. 1-2.

Click-to-Call appealed. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

We review a grant of summary judgment according to the law of the regional circuit, here, the Fifth Circuit. *LaserDynamics, Inc. v. Quanta Comput., Inc.*, 694 F.3d 51, 66 (Fed. Cir. 2012). The Fifth Circuit reviews a district court's grant of summary judgment de novo. *Id.* Summary judgment is improper where there is a genuine dispute of material fact and where "the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986).

Appendix A

Statutory interpretation, including interpretation of the IPR estoppel statute, is a question of law that we review de novo. *Intuitive Surgical, Inc. v. Ethicon LLC*, 25 F.4th 1035, 1040 (Fed. Cir. 2022); see also *Cal. Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 989 (Fed. Cir. 2022) (“*Caltech*”).

We review district court decisions on procedural matters in patent cases, such as granting leave to amend claim selections, for an abuse of discretion. See *O2 Micro Int’l Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1366-68 (Fed. Cir. 2006); *Mayeaux v. La. Health Serv. & Indem. Co.*, 376 F.3d 420, 425 (5th Cir. 2004) (reviewing a ruling on a motion for leave to amend a pleading for an abuse of discretion).

I

We first turn to Click-to-Call’s argument that the district court erred in refusing to estop Ingenio from arguing that claim 27 is anticipated by Dezonno. We agree that the district court erred by not addressing the actual basis of Click-to-Call’s estoppel argument, and we hold as a matter of law that IPR estoppel applies. At the outset, the district court erred by analyzing Click-to-Call’s argument only under common law issue preclusion. J.A. 18 (Report and Recommendation); J.A. 4 (adopting the Report and Recommendation). Click-to-Call’s argument regarding Dezonno and claim 27 was grounded in IPR estoppel under 35 U.S.C. § 315(e)(2), not standard issue preclusion. J.A. 1717-20 (Click-to-Call’s response to Ingenio’s motion for summary judgment). Thus, the district court erred in failing to address the basis of Click-to-Call’s argument.

Appendix A

Furthermore, the district court’s reason for rejecting Click-to-Call’s argument—a reason derived from the issue-preclusion rubric—does not apply to IPR estoppel. The district court rejected Click-to-Call’s estoppel argument under the “actually litigated” prong of issue preclusion. J.A. 18 (citing *United States v. Shanbaum*, 10 F.3d 305, 311 (5th Cir. 1994) (explaining that, for issue preclusion to apply, the “issue must have been fully and vigorously litigated in the prior action”)). But IPR estoppel has no such express requirement. And it would not be reasonable to engraft such a requirement into IPR estoppel, given that the IPR statute also estops grounds that “reasonably could have [been] raised.” § 315(e)(2). Thus, it was error to reject Click-to-Call’s IPR estoppel argument on the basis that anticipation by Dezonno “was not litigated in the IPR,” J.A. 18, because Ingenio might still be estopped if it “reasonably could have raised” that ground in the IPR. Accordingly, we reject the district court’s basis for denying Click-to-Call’s estoppel argument.

We turn now to the merits of Click-to-Call’s estoppel argument. We hold that IPR estoppel applies here as a matter of law and precludes Ingenio from arguing that claim 27 is anticipated by Dezonno. Ingenio’s IPR petition included a challenge to claim 27 (based upon Freeman, but not Dezonno) and included unpatentability challenges to other claims based on Dezonno (including an anticipation challenge to claim 1 on which claim 27 depends), evidencing its awareness of the Dezonno reference. Accordingly, anticipation of claim 27 in view of Dezonno—the invalidity challenge the district court accepted—is a ground that Ingenio “reasonably could have

Appendix A

raised” in the IPR. Ingenio’s arguments to the contrary based on the language of § 315(e)(2) and *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293 (Fed. Cir. 2016), are unpersuasive.

Specifically, Ingenio argues that it is not estopped because claim 27 “was not part of the Board’s Final Written Decision,” which it contends is required by § 315(e)(2). Appellees’ Br. 9. Ingenio focuses on the below-underlined language in § 315(e)(2), referencing “a claim in a patent” and “the claim,” in addition to requiring that the IPR “results in a final written decision”:

(e) ESTOPPEL.— . . .

(2) CIVIL ACTIONS AND OTHER PROCEEDINGS.—The petitioner in an inter partes review of a *claim in a patent* under this chapter that *results in a final written decision* under section 318(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that *the claim* is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

Appendix A

35 U.S.C. § 315(e)(2) (emphases added); *see* Appellees' Br. 8-9. Ingenio argues that as a result of this language, IPR estoppel is applied on a claim-by-claim basis and is limited to only those claims that were "subject to a final written decision." Appellees' Br. 8-9.

The fact that claim 27 was not part of the Board's final written decision, however, does not have the dispositive weight Ingenio ascribes to it because of the unusual procedural posture of this case. It is true that § 315(e) estoppel applies on a "claim-by-claim basis." *Intuitive*, 25 F.4th at 1042 (analyzing § 315(e)(1) estoppel at the U.S. Patent and Trademark Office). And the statute does specify that it applies estoppel from "an inter partes review of a claim in a patent under this chapter that results in a final written decision." § 315(e)(2). But here, Ingenio included claim 27 in its petition, and the IPR did result in a final written decision. The fact that the Board, due to a legal error corrected by *SAS*, failed to include claim 27 in its final written decision does not absolve Ingenio of the estoppel triggered by its choice to challenge claim 27 at the Board.

As described in the Background, Ingenio crafted its petition to challenge claim 27 only on the alternative Freeman-based ground, rather than Dezonno. The Board, consistent with its practice at the time in 2013, instituted only on the Dezonno-based grounds, thus leaving claim 27 unaddressed. This partial-institution practice, however, was inconsistent with the IPR statute and was overruled by the Supreme Court in *SAS*. 138 S. Ct. at 1359-60. The Court explained that "the statute

Appendix A

tells us that the petitioner’s contentions, not the Director’s discretion, define the scope of the litigation all the way from institution through to conclusion.” *Id.* at 1357. Our court has also recognized the primacy of a petitioner’s contentions, specifically in the context of IPR estoppel. In *Caltech*, we noted that “it is the petition, not the institution decision, that defines the scope of the IPR.” *Caltech*, 25 F.4th at 990 (citing *SAS*, 138 S. Ct. at 1357-58). Thus, it is the “petitioner’s contentions” that define “the scope of the [IPR] litigation” and thus the extent of the estoppel (so long as the IPR ends in a final written decision). Here, the scope of the IPR as defined in the petition included claim 27 and Dezonno, even if it did not include a challenge to claim 27 based upon Dezonno.

Furthermore, unlike pre-*SAS* petitioners whose partially instituted proceedings went final before *SAS* issued, Ingenio was not helpless to remedy the Board’s institution error. Due to the long appellate history of the IPR proceeding, the appeal of Ingenio’s IPR was still pending at the time *SAS* issued in 2018. Ingenio, however, never sought a *SAS* remand directing the Board to address its non-instituted claims and grounds. *See* Appellant’s Reply Br. 3 (noting Ingenio’s failure to request *SAS* remand); Oral Arg. at 18:30-19:10, https://oralarguments.cafc.uscourts.gov/default.aspx?fl=22-1016_06092022.mp3 (Ingenio conceding it “could have” sought *SAS* remand to address claim 27 but did not because its Dezonno ground was successful). Ingenio thus forewent the route taken by many other parties post-*SAS* to have the Board address all claims and all grounds in their petitions. *See, e.g., Adidas AG v. Nike, Inc.*, 894 F.3d 1256, 1258 (Fed. Cir.

Appendix A

2018) (granting *SAS* remand); *BioDelivery Scis. Int'l, Inc. v. Aquestive Therapeutics, Inc.*, 898 F.3d 1205, 1208 (Fed. Cir. 2018) (citing cases where remand was granted). Ingenio's choice to leave unremedied the Board's mistake does not shield it from estoppel as to a claim it included in its IPR petition.

Ingenio also relies on *Shaw* in opposing IPR estoppel. Appellees' Br. 9-10. In *Shaw*, the appellant had been successful in partially invalidating the claims of a certain patent. *Shaw*, 817 F.3d at 1297. The petitioner included a huge number of unpatentability grounds (fifteen) in its petition. The Board, according to its then-current practice, instituted review of only some of the grounds, denying others as redundant. *Id.* at 1296-97. One ground that was denied as redundant relied on a prior art reference called "Payne" as allegedly rendering invalid certain claims. *Id.* at 1296. In the end, the Board determined that the claims had not been shown to be unpatentable based on the instituted ground. *Id.* at 1297. The Board did not address the non-instituted grounds, including Payne. *Id.*

The petitioner sought a writ of mandamus from our court to instruct the Board to reconsider its redundancy decision and to institute IPR on the Payne ground. One argued basis for the writ was that the petitioner "may be estopped from arguing the [Payne] ground in any future proceedings." *Id.* at 1299. Our court denied the request for mandamus, agreeing with the PTO (who intervened in that case) that "the denied ground never became part of the IPR." *Id.* at 1300. Accordingly, the denied ground was not raised nor could it have been reasonably raised

Appendix A

“during” the IPR—i.e., after institution—and thus the petitioner would not be estopped. *Id. Shaw*, therefore, held that unpatentability grounds that were in a petition but rejected by the Board at institution were not subject to IPR estoppel.

Ingenio argues that it should not be estopped because, as in *Shaw*, claim 27 was not considered “during” the IPR, “which only begins *after* institution” and claim 27 “was not a part of the Board’s Final Written Decision.” Appellees’ Br. 9-10. Ingenio’s reliance on *Shaw* is misplaced.

We recently overruled *Shaw*. *Caltech*, 25 F.4th at 991. In *Caltech*, we relied on SAS’s abrogation of the Board’s practice of partial institutions as undermining *Shaw*’s rationale. To give effect to the language “reasonably could have raised,” we held that “estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the petition.” *Id.* at 991. Here, claim 27 was “included in the petition” and there is no reasonable argument that Ingenio could not have raised Dezonno against that claim. And under SAS, Ingenio was entitled to have *all* of its claims and grounds considered after institution. *See SAS*, 138 S. Ct. at 1355 (“Much as in the civil litigation system it mimics, in an inter partes review the petitioner is master of its complaint and normally entitled to judgment on all of the claims it raises, not just those the decisionmaker might wish to address.”); *see also PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (“We will treat claims and

Appendix A

grounds the same in considering the *SAS* issues currently before us.”² Thus, Ingenio’s reliance on *Shaw* is out of date and IPR estoppel applies.³

We therefore reverse the district court and hold that Ingenio is estopped under 35 U.S.C. § 315(e)(2) from asserting anticipation of claim 27 by Dezonno, the only invalidity basis applied by the district court.

2. Ingenio hypothesizes that “[i]t is equally likely the PTAB would have rejected the entire petition instead of instituting the entire petition in the post-*SAS* world.” Appellees’ Br. 11 n.1. Perhaps. See, e.g., *Biodelivery Scis. Int’l, Inc.*, 935 F.3d at 1366-67. But if that were the case, estoppel would not apply at all because the IPR would not have “result[ed] in a final written decision under section 318(a).” § 315(e)(2).

3. Even if *Shaw* had not been overruled, its exemption would not apply here. In *Shaw*, this court held that IPR estoppel does not apply to grounds not instituted by the Board. If Ingenio asserted in district court that Freeman in view of Lewis rendered obvious claim 27—the ground that Ingenio pressed in its IPR petition but was denied by the Board—it would have had a much stronger argument that its case is analogous to *Shaw*. Here, Ingenio chose not to assert that Dezonno anticipated claim 27 in its petition and put all its eggs in the Freeman basket. In other words, the Board was never given the chance to consider whether Dezonno anticipated claim 27. Thus, *Shaw* would not apply because the Board never denied institution of claim 27 as anticipated by Dezonno. Ingenio argues that, like in *Shaw*, “there was no means by which [Ingenio] could have raised the invalidity of Claim 27 during the IPR.” Appellees’ Br. 10. That is incorrect. As explained above, Ingenio could have sought a *SAS* remand.

*Appendix A***II**

Next, we turn to the district court’s denial of Click-to-Call’s request to amend its listing of asserted claims to add claims 24 and 28, which were not challenged in the IPR. This is a decision concerning the management of a district court’s case docket, a decision we review under a highly deferential lens for an abuse of discretion. *S&W Enters., L.L.C. v. SouthTrust Bank of Ala., NA*, 315 F.3d 533, 535 (5th Cir. 2003) (“We review for abuse of discretion the district court’s denial of leave to amend.”); *see also Alpek Polyester, S.A. de C.V. v. Polymetrix AG*, No. 2021-1706, 2021 U.S. App. LEXIS 37124, 2021 WL 5974163, at *8 (Fed. Cir. Dec. 16, 2021) (“We defer to the broad discretion of the district court to manage its own docket.”). Because the district court did not abuse its discretion in this regard, we affirm.

In October 2013, Click-to-Call selected eight patent claims for assertion against defendants at the district court. J.A. 1258. The Board shortly thereafter partially instituted IPR on the asserted patent. J.A. 1567-68. At that time, Click-to-Call did not request to amend its listing of selected claims at the district court.

Ingenio then moved to stay the district court case the following month. J.A. 1260; J.A. 39 (D.I. 144). The district court granted the stay. *Click-To-Call Techs. LP v. Ingenio, Inc.*, Case No. A-12-CA-465-SS, 2013 U.S. Dist. LEXIS 190317, 2013 WL 11311782 (W.D. Tex. Dec. 5, 2013). One rationale that the district court provided for granting the stay was that the IPR would “simplify the issues in th[e]

Appendix A

case” because “a[ll] but one of the claims to be asserted at trial in this case” were at issue in the IPR. 2013 U.S. Dist. LEXIS 190317, [WL] at *2. Clearly, the district court did not envision adding other claims to the case following the IPR. And Click-to-Call has not, on appeal, pointed us to any briefing or statements before the district court where it hinted at such an addition before the stay.

The case was stayed for more than six years while the Board appeals were resolved. During that time, the parties filed a number of status reports with the district court. At no time during the stay did Click-to-Call request leave to amend its asserted claims. Oral Arg. at 11:44-12:12, [https://oralarguments.cafc.uscourts.gov/default.aspx?fl=2 2-1016_06092022.mp3](https://oralarguments.cafc.uscourts.gov/default.aspx?fl=2%202-1016_06092022.mp3) (noting lack of communication with the court during the stay regarding which claims were being asserted).

The Board issued its final written decision in 2014, during the stay. Even though Click-to-Call was aware of the Board’s reasoning holding the asserted claims unpatentable over Dezonno since 2014, it did not request leave to amend its asserted claims until six years later, when it filed its response to Ingenio’s summary judgment motion in 2020. J.A. 1720-21. And even that request was cursory, with Click-to-Call arguing “[g]ood cause exists” to allow amendment merely because “only three claims [are] at issue, Click-to-Call promptly gave notice after the IPR was final that it would pursue all three claims without timely objection from defendants, and defendants are not prejudiced.” J.A. 1721. Click-to-Call provided no further justification for this request.

Appendix A

The district court addressed this terse request from Click-to-Call in an equally short denial, determining “Click-to-Call failed to provide good cause to amend its notice of claims selected for trial.” J.A. 5. The district court also adopted the magistrate judge’s recommendation, which reasoned that “[c]ourts generally refuse to reopen what has been decided previously” and recommended denying Click-to-Call’s request to amend. J.A. 14. Like the district court, the magistrate judge found “Click-to-Call has not provided good cause for leave to amend nearly eight years after its original selection of claims for trial.” *Id.* We see no abuse of discretion in this decision by the district court.

Click-to-Call makes two principal arguments on appeal: (1) the parties agreed that claims 24 and 28 were in the case after the stay was lifted and (2) the district court failed to properly analyze its request for amendment under the factors enumerated in *S&W Enterprises*. Appellant’s Br. 30-34. Neither argument is persuasive.

First, Click-to-Call argues that there was a “clear agreement” between it and Ingenio that claims 24 and 28 were in the case. Appellant’s Br. 30. We disagree. Upon restarting the district court case, Click-to-Call expressed that “it intends to proceed with litigation of the asserted claims not affected by the Inter Partes Review proceedings: specifically, claims 24, 27, and 28.” J.A. 1415. But, at that time, claims 24 and 28 were not among the “asserted claims” because Click-to-Call had not sought to amend.

Appendix A

Click-to-Call also points to Ingenio’s response at that time that it would seek invalidity of all three claims as some sort of an admission that claims 24 and 28 were in the case. Appellant’s Br. 30. But it is unsurprising that a defendant would assert invalidity of any claim a plaintiff purported to assert. This does not act as a waiver of Ingenio’s right to challenge whether these claims were properly part of the case and does not prohibit the district court from denying Click-to-Call’s subsequent request to amend.

Second, Click-to-Call argues the district court abused its discretion in denying Click-to-Call’s proposed amendment by failing to consider the factors enumerated in *S&W Enterprises*. Appellant’s Br. 31-34. But, as we described above, Click-to-Call’s request to amend consisted of a two-sentence paragraph that did not even cite *S&W Enterprises*, let alone analyze the factors therein. J.A. 1721. We will not fault the district court for failing to apply a case that Click-to-Call did not even present to the district court. And we refuse to find an abuse of discretion in the district court’s short analysis, considering the minimal effort Click-to-Call put into making its argument. *Cf. Novartis AG v. Torrent Pharms. Ltd.*, 853 F.3d 1316, 1328 (Fed. Cir. 2017) (refusing to fault the lower tribunal for “arguably limited treatment” of arguments that were only tersely made). Nor will we analyze those factors de novo in the first instance, as Click-to-Call would have us do. Appellant’s Br. 32-34 (analyzing the factors for the first time on appeal).

Appendix A

The district court did not abuse its discretion in refusing to allow Click-to-Call to amend its selection of claims for trial to add claims 24 and 28. Accordingly, we affirm that portion of the district court's decision.

CONCLUSION

We reverse the district court's determination that Ingenio is not estopped under 35 U.S.C. § 315(e)(2) from asserting invalidity of claim 27 based on anticipation by Dezonno and its summary judgment of invalidity. We thus remand for further proceedings regarding claim 27. We affirm the district court's denial of Click-to-Call's request to amend its asserted claims to include claims 24 and 28.

**REVERSED-IN-PART, AFFIRMED-IN-PART,
AND REMANDED**

COSTS

No costs.

20a

**APPENDIX B — ORDER OF THE UNITED
STATES DISTRICT COURT FOR THE WESTERN
DISTRICT OF TEXAS, AUSTIN DIVISION,
FILED AUGUST 30, 2021**

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

CAUSE NO. 1:12-CV-465-LY

CLICK-TO-CALL TECHNOLOGIES LP,

Plaintiff,

v.

INGENIO, INC., THRYV, INC., ETHER, A
DIVISION OF INGENIO, INC., AND INGENIO, INC.
D/B/A KEEN,

Defendants.

August 30, 2021, Decided
August 30, 2021, Filed

**ORDER ON REPORT AND RECOMMENDATION
OF THE UNITED STATES MAGISTRATE JUDGE**

Before the court is the above-styled and numbered patent-infringement action. The court referred to the United States Magistrate Judge, *inter alia*, Defendants' Motion for Summary Judgment filed October 20, 2020 (Doc. #194) and other related filings for report and

Appendix B

recommendation. *See* 28 U.S.C. § 636(b)(1). Before the court is the Report and Recommendation of the United States Magistrate Judge filed August 4, 2021 (Doc. #217). The magistrate judge recommends that the court grant the Defendants' Motion for Summary Judgment of Invalidity and render judgment for Defendants. Additionally, the magistrate judge recommends that in the event the court grants summary judgment in favor of Defendants, that Defendant Thryv, Inc.'s Motion to Exclude Certain Testimony and Opinions of Dr. Vijay K. Madiseti filed March 26, 2021 (Doc. #212) be dismissed as moot.

A party may serve and file specific written objections to the proposed findings and recommendations of a magistrate judge within fourteen days after being served with a copy of the report and recommendation and thereby secure *de novo* review by the district court. *See* 28 U.S.C. § 636(b); Fed. R. Civ. P. 72(b). A party's failure to timely file written objections to the proposed findings, conclusions, and recommendation in a report and recommendation bars that party, except upon grounds of plain error, from attacking on appeal the unobjected-to proposed factual findings and legal conclusions accepted by the district court. *See Douglass v. United Services Auto Ass'n*, 79 F.3d 1415 (5th Cir. 1996) (en banc).

The parties received the report and recommendation on August 4, 2021, and objections if any, were due to be filed on or before August 18, 2021. Plaintiff Click-To-Call Technologies and Defendant Thryv, Inc. each filed objections to the report and recommendation on August 18, 2021 (Docs. ##219 & 220). In light of the objections, the court has undertaken a *de novo* review of the entire case file.

Appendix B

At this juncture in this long-pending action, Click-to-Call asserts infringement by Defendants of claims 24, 27, and 28 of Click-to-Call's United States Patent No. 5,818,836, titled "Method and Apparatus for Anonymous Voice Communication Using an Online Data Service" ("the '836 Patent"). Defendants move for summary judgment, countering that there are not three claims at issue in this action, rather only one claim remains in issue—claim 27. Further, Defendants contend there are two independent grounds that support its invalidity contention: (1) claim 27 is invalid based on the doctrine of anticipation; and (2) claim 27 is invalid based on collateral estoppel. Click-to-Call rejoins that in the event the court determines only claim 27 is at issue, Click-to-Call requests leave to amend its Plaintiff's Notice of Claims Selected for Trial filed October 11, 2013 (Doc. #139).

Having considered the motions, responses, objections, the case file, and the applicable law, the court will overrule the objections and will accept and adopt the report and recommendation for substantially the reasons stated therein.

The court agrees with the magistrate judge's finding and conclusion that claim 27 is the sole remaining claim at issue in this action, and that Click-to-Call failed to provide good cause to amend its notice of claims selected for trial. Further, the court accepts and adopts the recommendation that Click-to-Call's request to amend its notice to add claims other than claim 27 in this action should be denied.

With regard to Defendants' contention that claim 27 is invalid, the court agrees with the magistrate judge's finding and conclusion that there is no genuine dispute

Appendix B

that prior art—United States Patent No. 5,991,394, titled Method and System For Establishing Voice Communications Using a Computer Network (“the Dezonno patent”)—anticipates claim 27 and, thus, claim 27 is invalid.

Although the magistrate’s report and recommendation makes no mention of Defendants’ other invalidity contention based on collateral estoppel, as the court determines the doctrine of anticipation applies and renders claim 27 invalid, the court also concludes it is unnecessary to address Defendants’ invalidity contention based on collateral-estoppel.

IT IS ORDERED that Plaintiff Click-To-Call Technologies and Defendant Thryv, Inc.’s objections to the report and recommendation filed on August 18, 2021 (Docs. ##219 & 220) are **OVERRULED**.

IT IS ORDERED that for substantially the reasons stated therein the Report and Recommendation of the United States Magistrate Judge filed August 4, 2021 (Doc. #217) is **ACCEPTED AND ADOPTED**.

IT IS FURTHER ORDERED that the only claim at issue in this action is claim 27, and Plaintiff Click-to-Call’s request to amend Plaintiff’s Notice of Claims Selected for Trial filed October 11, 2013 (Doc. #139) is **DENIED**.

IT IS FURTHER ORDERED that Defendants’ Motion for Summary Judgment of Invalidity filed October 20, 2020 (Doc. #194) is **GRANTED**.

Appendix B

IT IS FURTHER ORDERED that there is no genuine issue of disputed fact that claim 27 of the '836 Patent is invalid because claim 17 is anticipated by prior art-the Dezonno patent-and Plaintiff Click-to-Call **TAKES NOTHING** by its claims against Defendants.

IT IS FURTHER ORDERED that Defendant Thryv, Inc.'s Motion to Exclude Certain Testimony and Opinions of Dr. Vijay K. Madiseti filed March 26, 2021 (Doc. #212) is **DISMISSED**.

Counterclaims remain pending in this action.

SIGNED this 30th day of August, 2021.

/s/ Lee Yeakel
LEE YEAKEL
UNITED STATES DISTRICT
JUDGE

25a

**APPENDIX C — REPORT AND
RECOMMENDATION OF THE UNITED STATES
DISTRICT COURT FOR THE WESTERN
DISTRICT OF TEXAS, AUSTIN DIVISION,
FILED AUGUST 4, 2021**

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

Case No. 1:12-cv-00465-LY

CLICK-TO-CALL TECHNOLOGIES LP,

Plaintiff,

v.

INGENIO, INC.; THRYV, INC.; ETHER, A
DIVISION OF INGENIO, INC.; AND INGENIO, INC.
D/B/A KEEN,

Defendants.

August 4, 2021, Decided
August 4, 2021, Filed

**REPORT AND RECOMMENDATION OF THE
UNITED STATES MAGISTRATE JUDGE**

**TO: THE HONORABLE LEE YEAKEL
UNITED STATES DISTRICT JUDGE**

Appendix C

Before the Court are Defendants' Motion for Summary Judgment of Invalidity, filed October 20, 2020 (Dkt. 194); Plaintiff Click-to-Call's Response to Defendants' Motion for Summary Judgment, filed November 10, 2020 (Dkt. 195); Reply in Support of Defendants' Motion for Summary Judgment of Invalidity, filed November 24, 2020 (Dkt. 198); Plaintiff Click-to-Call's Sur-reply in Opposition to Defendants' Motion for Summary Judgment, filed December 4, 2020 (Dkt. 205); Defendant Thryv, Inc.'s Motion to Exclude Certain Testimony and Opinions of Dr. Vijay K. Madisetti and Brief in Support, filed March 26, 2021 (Dkt. 212); and Plaintiff Click-to-Call's Response to Defendants' Motion to Exclude Certain Testimony and Opinions of Dr. Vijay K. Madisetti, filed April 2, 2021 (Dkt. 214). On April 6, 2021, the District Court referred the motions to the undersigned Magistrate Judge for Report and Recommendation, pursuant to 28 U.S.C. § 636(b)(1) (B), Federal Rule of Civil Procedure 72, and Rule 1(d) of Appendix C of the Local Rules of the United States District Court for the Western District of Texas. Dkt. 215.

I. Introduction

Plaintiff Click-to-Call Technologies, LP (Click-to-Call) owns U.S. Patent No. 5,818,836 (the '836 patent), entitled "Method and Apparatus for Anonymous Voice Communication Using an Online Data Service." Dkt. 194-7 at 2. The patent covers a system and method for establishing anonymous telephone communications over the internet. *Id.*; Dkt. 194-3 at 4. On May 29, 2012, Click-to-Call filed three infringement suits against Defendants Ingenio, Inc.; Thryv, Inc. (Thryv); Ether, a division

Appendix C

of Ingenio, Inc.; Ingenio, Inc. d/b/a Keen (collectively, Defendants); and others.¹ Defendants assert invalidity as an affirmative defense. Dkt. 62 at 5.

Defendants now move for summary judgment under Federal Rule of Civil Procedure 56. Defendants also ask the Court to exclude the testimony of Plaintiff's expert Dr. Vijay Madiseti on the basis that his opinions are legal opinions that embrace ultimate issues of law.

II. Background

Click-to-Call's '836 Patent has a lengthy history before the U.S. Patent and Trademark Office (PTO) and this Court. In 2008, the PTO issued an Ex Parte Reexamination Certificate cancelling six of the patent's original claims, amending fifteen claims, and adding nine new claims. Dkt. 88-5 at 4; Dkt. 194-7 at 24-26.

In May 2013, Defendants, along with then co-defendant Oracle Corporation, petitioned the PTO's Patent Trial and Appeal Board (the PTAB or Board) to institute *inter partes* review (IPR) of certain claims of the '836 patent. Dkt. 194-1. Defendants asserted that the claims were invalid as anticipated by prior art, including U.S. Patent No. 5,991,394 (the Dezonno patent). *Id.* at 19; Dkt. 194-6.

1. While this action was stayed, mergers and a corporate name change altered the parties' names. Dkt. 188. The other two cases were dismissed with prejudice pursuant to stipulation. No. 1:12-cv-468-LY; No. 1:12-cv-469-SS.

Appendix C

In August 2013, the Court issued a Consolidated *Markman* Order construing the claim terms under the “ordinary-and-customary-meaning” standard. Dkt. 137. The Court then ordered Click-to-Call to narrow its case to eight claims. Dkt. 138 ¶ 1. On October 11, 2013, Click-to-Call selected claims 1, 2, 8, 12, 13, 16, 26, and 27 for trial. Dkt. 139. On October 30, 2013, the PTAB granted Thryv’s petition for IPR of seven of these claims - all but claim 27 - along with six others,² based on the “reasonable likelihood” that Thryv would prevail in establishing the claims as unpatentable. Dkt. 194-2 at 3. The Court then stayed this action pending the outcome of the IPR. Dkt. 147. The Court noted that only one claim – that is, claim 27 – would remain in the District Court action should Defendants be successful in the IPR. *Id.* at 4.

The PTAB conducted an IPR trial and issued its Final Written Decision based on the “broadest reasonable interpretation” standard. Dkt. 194-3 at 9. The PTAB held that claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 were invalid due to the Dezonno patent alone or in combination with other prior art. *Id.* at 27-28. Click-to-Call appealed the PTAB’s decision to the Federal Circuit, arguing that the IPR should not have been instituted because it was time-barred. *Click-to-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir. 2018). The Federal Circuit ordered the PTAB to dismiss the IPR. *Id.* at 1341-42. The United States Supreme Court granted certiorari, and on April 20, 2020, ruled that the PTAB’s decision to institute was not appealable. *Thryv, Inc. v. Click-to-Call*

2. The six additional claims are 15, 19, 22, 23, 29, and 30.

Appendix C

Techs., LP, 140 S. Ct. 1367, 1377, 206 L. Ed. 2d 554 (2020). The PTAB's Final Written Decision on the '836 patent therefore became final.

In a Joint Status Report filed July 24, 2020, Click-to-Call stated that it intended to litigate the asserted claims that it contends were not affected by the IPR proceeding: claims 24, 27, and 28. Dkt. 184 at 1. The District Court lifted the stay of this case on August 13, 2020. Dkt. 189.

III. Motion for Summary Judgment

A. Legal Standard

Summary judgment shall be rendered when the pleadings, the discovery and disclosure materials, and any affidavits on file show that there is no genuine dispute as to any material fact and that the moving party is entitled to judgment as a matter of law. FED. R. CIV. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-25, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986); *Washburn v. Harvey*, 504 F.3d 505, 508 (5th Cir. 2007). A dispute regarding a material fact is “genuine” if the evidence is such that a reasonable jury could return a verdict in favor of the nonmoving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986). When ruling on a motion for summary judgment, the court is required to view all inferences drawn from the factual record in the light most favorable to the nonmoving party. *Matsushita Elec. Indus. Co. v. Zenith Radio*, 475 U.S. 574, 587, 106 S. Ct. 1348, 89 L. Ed. 2d 538 (1986); *Washburn*, 504 F.3d at 508. A court “may not make credibility determinations

Appendix C

or weigh the evidence” in ruling on a motion for summary judgment. *Reeves v. Sanderson Plumbing Prods., Inc.*, 530 U.S. 133, 150, 120 S. Ct. 2097, 147 L. Ed. 2d 105 (2000); *see also Anderson*, 477 U.S. at 254-55.

Once the moving party has made an initial showing that there is no evidence to support the nonmoving party’s case, the party opposing the motion must come forward with competent summary judgment evidence of the existence of a genuine fact issue. *Matsushita*, 475 U.S. at 586. Mere conclusory allegations are not competent summary judgment evidence and thus are insufficient to defeat a motion for summary judgment. *Turner v. Baylor Richardson Med. Ctr.*, 476 F.3d 337, 343 (5th Cir. 2007). Unsubstantiated assertions, improbable inferences, and unsupported speculation also are not competent summary judgment evidence. *Id.* The party opposing summary judgment is required to identify specific evidence in the record and to articulate the precise manner in which that evidence supports its claim. *Adams v. Travelers Indem. Co. of Conn.*, 465 F.3d 156, 164 (5th Cir. 2006). If the nonmoving party fails to make a showing sufficient to establish the existence of an element essential to its case and on which it will bear the burden of proof at trial, summary judgment must be granted. *Celotex*, 477 U.S. at 322-23.

B. Summary Judgment Record

Defendants submitted the following summary judgment evidence:

Appendix C

1. Defendants' Petition for *Inter Partes* Review (Exh. A, Dkt. 194-1);
2. PTAB Institution of *Inter Partes* Review (Exh. B, Dkt. 194-2);
3. PTAB Final Written Decision (Exh. C, Dkt. 194-3);
4. Click-to-Call's Infringement Contentions as to Yellowpages.com (Exh. D, Dkt. 194-4);
5. Click-to-Call's Infringement Contentions as to Keen.com (Exh. E, Dkt. 194-5);
6. A copy of the Dezonno patent (Exh. F, Dkt. 194-6); and
7. A copy of the '836 patent (Exh. G, Dkt. 194-7).

Plaintiff submitted as summary judgment evidence the Declaration of Daniel J. Shih (Dkt. 196) and its attached exhibits, comprising IPR Declarations from five individuals:

1. Stephen C. DuVal (Exh. 1, Dkt. 196-1 through 196-5);
2. Robert Shinn (Exh. 2, Dkt. 196-6);
3. Simon Clement (Exh. 3, Dkt. 196-7);

Appendix C

4. Doug Martin (Exh. 4, Dkt. 196-8); and
5. Ben J. Yorks (Exh. 5, Dkts. 196-9 and 196-10).

C. Analysis

Defendants argue that the Court should grant summary judgment because (1) Click-to-Call is collaterally estopped from relitigating the PTAB's invalidity decision on the IPR claims, and (2) there is no genuine issue of material fact that Click-to-Call's sole remaining claim in this litigation, claim 27, is invalid as anticipated by the Dezonno patent. Click-to-Call disputes that the PTAB's invalidity decision has preclusive effect in this litigation. Click-to-Call also argues that Defendants are estopped from asserting the Dezonno patent against claim 27 as well as claims 24 and 28, which it contends also remain in this action.

1. Issue Preclusion Relating to IPR Proceeding

Defendants first argue that Click-to-Call is collaterally estopped from relitigating the PTAB's invalidity decision on the IPR claims. Click-to-Call responds that the different standards for claim construction applied by the PTAB and the district court prevents the Final Written Decision from having preclusive effect. Dkt. 195 at 11. Specifically, Click-to-Call contends that the PTAB's application of the "broadest reasonable interpretation" standard resulted in variations in claim construction that could affect the validity determination. Dkt. 195 at 10-15.

Appendix C

Issue preclusion “promotes the interests of judicial economy by treating specific issues of fact or law that are validly and necessarily determined between two parties as final and conclusive.” *United States v. Shanbaum*, 10 F.3d 305, 311 (5th Cir. 1994). Preclusion often applies where a single issue is before a court and an administrative agency. *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 148, 135 S. Ct. 1293, 191 L. Ed. 2d 222 (2015). The Federal Circuit has held that “an affirmance of an invalidity finding, whether from a district court or the Board, has a collateral estoppel effect on all pending or co-pending actions.” *XY, LLC v. Trans Ova Genetics*, 890 F.3d 1282, 1294 (Fed. Cir. 2018). “When a claim is invalidated at the PTAB, and that decision is made final, the cancellation of the claim carries preclusive effect in a co-pending litigation because the cause of action is extinguished.” *Papst Licensing GmbH & Co., KG v. Samsung Elecs. Co., Ltd.*, 403 F. Supp. 3d 572, 601-02 (E.D. Tex. 2019).

In patent infringement actions, the Federal Circuit applies the law of the regional circuit to procedural questions involving issue preclusion. *Sovereign Software LLC v. Victoria’s Secret Direct Brand Mgmt., LLC*, 778 F.3d 1311, 1314 (Fed. Cir. 2015). In the Fifth Circuit, issue preclusion applies if four conditions are met:

1. The issue under consideration in a subsequent action must be identical to the issue litigated in a prior action.
2. The issue must have been fully and vigorously litigated in the prior action.

Appendix C

3. The issue must have been necessary to support the judgment in the prior case.
4. There must be no special circumstance that would render preclusion inappropriate or unfair.

State Farm Mut. Auto. Ins. Co. v. LogistiCare Sols., LLC, 751 F.3d 684, 689 (5th Cir. 2014).

The conditions for issue preclusion are satisfied in this case. First, the validity of certain claims of the '836 patent was litigated in the IPR, which is identical to the issue before the Court. Second, the parties fully and vigorously litigated the validity of the claims in the IPR and subsequent appeals. The PTAB conducted a full IPR trial on the merits of the parties' contentions that resulted in a Final Written Decision. Dkt. 194-3. Click-to-Call then appealed the PTAB's decision to the Federal Circuit, which issued a decision that Defendants challenged before the Supreme Court. Third, the validity of the claims of the '836 patent was the sole inquiry in the IPR and therefore was necessary to support the PTAB's Final Written Decision.

Finally, Click-to-Call has not shown any special circumstance in this litigation that would render issue preclusion inappropriate or unfair. *See Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 721 F.3d 1330, 1344 (Fed. Cir. 2013) (stating that "there is no basis for distinguishing between the effects of a final, affirmed court decision determining invalidity and a final, affirmed PTO decision determining invalidity on a pending litigation"); *Cisco*

Appendix C

Sys., Inc. v. Capella Photonics, Inc., No. 20-cv-01858-EMC, 2020 U.S. Dist. LEXIS 152315, 2020 WL 4923697, at *4 (N.D. Cal. Aug. 21, 2020) (stating that “logic and precedent suggest that the PTAB determination should be given preclusive effect”); *Intellectual Ventures I, LLC v. Lenovo Grp. Ltd.*, 370 F. Supp. 3d 251, 257 (D. Mass. 2019) (finding that different claim construction standard in IPR did not prevent issue preclusion in a district court action because the patent holder may no longer assert a claim in any forum once the PTAB finds the claim unpatentable).

2. Remaining Claims

Having found that Click-to-Call is collaterally estopped from relitigating the PTAB’s invalidity determination on the IPR claims, the Court must determine what claims remain for trial. Click-to-Call asserts that claims 24, 27, and 28 were not part of the IPR and therefore may be asserted against Defendants. Defendants contend that only claim 27 remains.

Courts generally refuse to reopen what has been decided previously. *Coliseum Square Ass’n, Inc. v. Jackson*, 465 F.3d 215, 246 (5th Cir. 2006) (citing *Messenger v. Anderson*, 225 U.S. 436, 443, 32 S. Ct. 739, 56 L. Ed. 1152 (1912)). Pursuant to the Court’s order, Click-to-Call selected eight claims of the ’836 patent for trial. Dkt. 138 ¶ 1; Dkt. 139. Claim 27 is the only claim Click-to-Call selected for trial not invalidated during the IPR. *Id.*; Dkt. 194-2 at 2. Accordingly, claim 27 is the only claim still at issue in this action.

Appendix C

Click-to-Call requests leave to update its selections should the Court find that only claim 27 remains in this litigation. Dkt. 195 at 19. Because Click-to-Call has not provided good cause for leave to amend nearly eight years after its original selection of claims for trial, the undersigned recommends that Click-to-Call's request for leave to amend its Notice of Claims Selected for Trial be denied.

3. Validity

Next, Defendants argue that they are entitled to summary judgment because (1) there is no genuine dispute that the Dezonno patent anticipates claim 27, rendering it invalid, and (2) Click-to-Call is collaterally estopped from asserting the dependent claims of claims 1 and 12. Click-to-Call contends that Defendants are precluded from challenging the validity of claim 27 in this action because the PTAB did not institute IPR on that claim.

Patents are presumed to be valid. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 662 (Fed. Cir. 2000). The party challenging the validity of a patent bears the burden of proving the factual elements of invalidity by clear and convincing evidence. *Pfizer v. Apotex, Inc.*, 480 F.3d 1348, 1359 (Fed. Cir. 2007). Although the burden of showing validity never shifts to the patentee, a patentee “would be well advised to introduce evidence sufficient to rebut that of the challenger” once a prima facie case for invalidity is made. *Id.* at 1360 (citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1570 (Fed. Cir. 1986)).

Appendix C

Anticipation under § 102 is a two-step inquiry. *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003). The first step is claim construction. *Id.*; *see also Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (stating that “[a] claim must be construed before determining its validity just as it is first construed before deciding infringement”) (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 996 n.7 (Fed. Cir. 1995)). The second step is a comparison of the properly construed claim to the prior art. *Medichem*, 353 F.3d at 933.

To anticipate a claim, “a single prior art reference must expressly or inherently disclose each claim limitation.” *Finisar Corp. v. DirectTV Grp., Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2008). A claim limitation is inherently disclosed if it is necessarily present in the single anticipating reference. *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003). If a “claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention,” prior art anticipates the patent. 35 U.S.C. § 102(a)(1). Judgment as a matter of law is appropriate when no reasonable juror could dispute the clear text of a prior art reference. *Finisar*, 523 F.3d at 1338.

Claim 27 recites the “method of claim 1, wherein the second information comprises an advertisement.” Dkt. 194-7 at 26. Claim 1 recites, in part,

Appendix C

A method for creating a voice connection over a circuit switched network between a first party and a second party using an on-line data service to initiate the connection, comprising the steps of:

(a) establishing an electronic connection between the first party and the second party through the online data service between the first party and the second party . . . wherein the information publically [sic] accessible over the Internet is suitable for presentation within a graphical user interface of the data terminal of the first party, wherein the information publicly accessible over the internet includes:

(1) first information characterizing the second party,

(2) second information representing a communication from the second party

Id. at 25. Because claim 27 depends on claim 1, it includes the limitations of claim 1. *In re Lange*, 644 F.2d 856, 862 n.9 (C.C.P.A. 1981) (stating that “every dependent claim includes all limitations of the independent claim”). As discussed above, the PTAB found claim 1 invalid as anticipated by the Dezonno patent. Dkt. 194-3 at 27.

*Appendix C***a. Claim Construction**

In its Consolidated *Markman* Order, the Court construed “second information representing a communication from a second party” in claim 1 to mean “a communication from a second party.” Dkt. 137 at 8. Because “advertisement” is not a construed term, it is given its ordinary and customary meaning. *Ruckus Wireless v. Innovative Wireless Sols., LLC*, 824 F.3d 999, 1002 (Fed. Cir. 2016). Claim 27 therefore requires a communication from a second party that is an advertisement.

Click-to-Call argues that “Dezonno uses the word ‘advertisement’ in a commercial sense, not in the sense that the ’836 Patent uses.” Dkt. 195 at 14. Click-to-Call fails to explain why the term “advertisement” should not be given its ordinary meaning. “To act as its own lexicographer, a patentee must clearly set forth a definition of the disputed claim term other than its plain and ordinary meaning.” *Aventis Pharma, S.A. v. Hospira, Inc.*, 675 F.3d 1324, 1330 (Fed. Cir. 2012) (citations omitted). Click-to-Call did not include “advertisement” in the claim terms to be construed by the Court. Dkt. 137. Nor do Click-to-Call’s infringement contentions contain a narrowed definition of “advertisement” excluding commercial ventures. *See* Dkt. 194-4 at 27; Dkt. 194-5 at 30. Consequently, there is no support for Click-to-Call’s argument that the Court should apply a narrowed definition of “advertisement” different from its ordinary meaning. *See Aventis*, 675 F.3d at 1330 (stating that a patentee must clearly express an intent to redefine a term’s plain and ordinary meaning); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed.

Appendix C

Cir. 2003) (“It is axiomatic that claims are construed the same way for both invalidity and infringement.”).

b. Comparison to Prior Art

Figure 2 of the Dezonno patent teaches “an exemplary home page used for advertising by, for example, a business on the Internet.” Dkt. 194-6 at 6. The abstract states that “the computer user views advertisements of the business’ products or services on the Internet via customized home pages. When the user wishes to order a product or ask additional questions about a product, the user activates a ‘call me’ button.” *Id.* at 2. Dezonno’s specification also teaches advertisements:

- “Computer users are therefore able to quickly and easily review a multitude of products and services which are offered by businesses advertising on the Internet.” *Id.* at 5.
- “[T]he success of direct response advertising depends greatly upon which the ease in which a potential customer can contact those selling the products or services.” *Id.*
- “It is a feature of the present invention to provide a method for a computer user to easily and conveniently have a business advertising on a computer network, such as the Internet, call the computer user back over the telephone.” *Id.* at 6.

Appendix C

- “Businesses on the Internet advertise on the World Wide Web using home pages. As is well known, home pages may include pictures of a product, descriptions of the product and a listing of a telephone number to call to ask questions or to order the product.” *Id.*

Defendants have shown that Dezonno clearly anticipates claim 27’s advertisement limitation.

To avoid the Dezonno patent as prior art, Click-to-Call attempts re-litigate the PTAB’s final decision that independent claims 1 and 12 were invalid. Dkt. 195 at 5-13. As discussed above, however, Click-to-Call is estopped from challenging the PTAB’s Final Written Decision on the IPR claims.

Click-to-Call also argues that Defendants are estopped from asserting the Dezonno patent as prior art against claim 27 due to the PTAB’s refusal to institute IPR on that claim. *Id.* at 15-18. Click-to-Call misapplies the conditions for issue preclusion. Because the PTAB did not grant *inter partes* review to claim 27, the issue was not litigated in the IPR, and Defendants are free to assert that the Dezonno patent anticipates claim 27 in this litigation. *Shanbaum*, 10 F. 3d at 311.

Considering the totality of the evidence, the Magistrate Court finds that no reasonable juror could find that the Dezonno patent does not anticipate claim 27 of the ’836 patent. Consequently, there is no triable issue of fact regarding the Dezonno patent’s anticipation of claim

Appendix C

27, and the Court recommends that Defendants' Motion for Summary Judgment on Invalidity as to claim 27 be granted.

IV. Motion to Exclude Expert Testimony

Because the Court recommends a grant of summary judgment to Defendants, the Court further recommends that the District Court dismiss as moot Defendant Thryv, Inc.'s Motion to Exclude Certain Testimony and Opinions of Dr. Vijay K. Madisetti (Dkt. 212).

V. Recommendation

Based on the foregoing, the undersigned Magistrate Judge **RECOMMENDS** that the District Court **GRANT** Defendants' Motion for Summary Judgment of Invalidity (Dkt. 194) and enter judgment for Defendants.

The undersigned **FURTHER RECOMMENDS** that Defendant Thryv, Inc.'s Motion to Exclude Certain Testimony and Opinions of Dr. Vijay Madisetti and Brief in Support (Dkt. 212) be **DISMISSED AS MOOT**.

IT IS FURTHER ORDERED that this case be removed from the Magistrate Court's docket and returned to the docket of the Honorable Lee Yeakel.

*Appendix C***VI. Warnings**

The parties may file objections to this Report and Recommendation. A party filing objections must specifically identify those findings or recommendations to which objections are being made. The District Court need not consider frivolous, conclusive, or general objections. *See Battle v. United States Parole Comm'n*, 834 F.2d 419, 421 (5th Cir. 1987). A party's failure to file written objections to the proposed findings and recommendations contained in this Report within fourteen (14) days after the party is served with a copy of the Report shall bar that party from de novo review by the District Court of the proposed findings and recommendations in the Report and, except on grounds of plain error, shall bar the party from appellate review of unobjected-to proposed factual findings and legal conclusions accepted by the District Court. *See* 28 U.S.C. § 636(b)(1)(C); *Thomas v. Arn*, 474 U.S. 140, 150-53, 106 S. Ct. 466, 88 L. Ed. 2d 435 (1985); *Douglass v. United Servs. Auto. Ass'n*, 79 F.3d 1415, 1428-29 (5th Cir. 1996) (en banc).

SIGNED on August 4, 2021.

/s/ Susan Hightower
SUSAN HIGHTOWER
UNITED STATES MAGISTRATE
JUDGE

44a

**APPENDIX D — DECISION OF THE UNITED
STATES PATENT AND TRADEMARK OFFICE,
PATENT TRIAL AND APPEAL BOARD,
DATED OCTOBER 28, 2014**

UNITED STATES PATENT
AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL
AND APPEAL BOARD

ORACLE CORPORATION, ORACLE OTC
SUBSIDIARY LLC, YP INTERACTIVE LLC,
AND YELLOWPAGES.COM LLC,

Petitioners,

v.

CLICK-TO-CALL TECHNOLOGIES LP,

Patent Owner.

Case IPR2013-00312
Patent 5,818,836

Before MICHAEL R. ZECHER, THOMAS L.
GIANNETTI, and TRENTON A. WARD, *Administrative
Patent Judges.*

ZECHER, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

*Appendix D***I. BACKGROUND**

Oracle Corporation, Oracle OTC Subsidiary LLC, YP Interactive LLC,¹ and Yellowpages.com LLC (collectively, “Oracle”) filed a Petition requesting an *inter partes* review of claims 1, 2, 8, 12, 13, 15, 16, 18, 19, 22–24, and 26–30 of U.S. Patent No. 5,818,836 (Ex. 1001, “the ’836 patent”). Paper 1 (“Pet.”). Click-to-Call Technologies LP (“CTC”) timely filed a Preliminary Response. Paper 14 (“Prelim. Resp.”). Taking into account the information presented in Oracle’s Petition, as well as the arguments presented in CTC’s Preliminary Response, the Board determined that the information presented in the Petition demonstrated only that there was a reasonable likelihood that Oracle would prevail in challenging claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 as unpatentable under 35 U.S.C. §§ 102(e) and 103(a). Pursuant to 35 U.S.C. § 314, the Board instituted this proceeding on October 30, 2013, only as to these claims of the ’836 patent. Paper 26 (“Dec.”).

During this proceeding, CTC timely filed a Patent Owner Response (Paper 41, “PO Resp.”), and Oracle timely filed a Reply to the Patent Owner Response (Paper 43, “Pet. Reply”). An oral hearing was held on June 26, 2014. Paper 51 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This decision is a final written decision under 35 U.S.C.

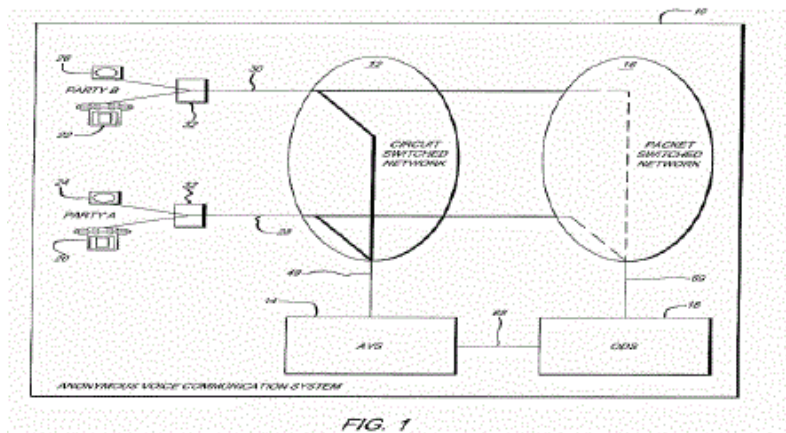
1. During trial, Petitioners filed an updated mandatory notice indicating that Ingenio LLC, one of the original Petitioners in this proceeding, changed its name to YP Interactive LLC. Paper 49, 1; Ex. 1026.

Appendix D

§ 318(a) as to the patentability of claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the '836 patent. For the reasons discussed below, Oracle has demonstrated by a preponderance of the evidence that these claims are unpatentable.

A. The '836 Patent

The '836 patent generally relates to a method and system for establishing anonymous telephone communications. Ex. 1001, 1:8–9. Figure 1 of the '836 patent, reproduced below, illustrates an anonymous voice communication system. *Id.* at 4:35, 54–56.



As shown in Figure 1 of the '836 patent, anonymous voice communication system 10 uses circuit switched network (“CSN”) 12 and anonymous voice system (“AVS”) 14 to establish an anonymous voice communication between party A and party B. Ex. 1001, 4:56–59. In another embodiment, system 10 uses packet switched network

Appendix D

(“PSN”) 16 and on-line data system (“ODS”) 18 to initiate an anonymous voice communication between party A and party B. *Id.* at 4:59–63.

The ’836 patent discloses that each party has telephone station 20 or 22 associated therewith that is connected to CSN 12. Ex. 1001, 4:64–65. Telephone stations 20 and 22 may be ordinary telephones, integrated services digital network telephones, or any device that can terminate an access line, play an audio signal, and transmit a received audio signal. *Id.* at 5:24–27. System 10 uses CSN 12 to establish a voice connection between telephone stations 20 and 22, as well as AVS 14. *Id.* at 4:65–67.

The ’836 patent further discloses that each party has data terminal 24 or 26 associated therewith that is connected to ODS 18 via CDS 12 and PSN 16. Ex. 1001, 5:5–8. Data terminals 24 and 26 may be a personal computer with the ability to process and store data, display information, accept input via a keyboard, microphone, or writing tablet, and communicate with other devices via a serial port, modem, or local area network. *Id.* at 5:28–32. Each party may use its respective data terminals 24 or 26 to exchange messages through ODS 18 to request an anonymous voice connection, which, in turn, causes ODS 18 to generate a command that prompts AVS 14 to establish a telephone connection between the parties. *Id.* at 5:8–13.

The ’836 patent discloses at least three different methods of creating an anonymous voice communication using system 10 illustrated in Figure 1: (1) standalone; (2) on-line; and (3) single party initiated. Ex. 1001, 9:45–47.

Appendix D

With respect to the on-line method of establishing an anonymous voice communication, the parties initiate an anonymous voice call using ODS 18. *Id.* at 16:54–55. Each party may use its data terminal 24 or 26 to log on to ODS 18. *Id.* at 16:55–57. The parties may contact each other via ODS 18 using public chat, private chat, electronic mail, or newsgroups. Ex. 1001, 16:57–59. The parties can communicate via ODS 18 without revealing their identity to each other, i.e., they are identified by screen names, handles, or subscriber identifications, which only the operator of ODS 18 can translate into the subscriber's identification. *Id.* at 16:59–64. According to the '836 patent, either party A or party B may initiate an anonymous voice communication using the on-line method. *Id.* at 16:65.

B. Illustrative Claim

Of the challenged claims, claims 1 and 12 are independent claims. Claims 2, 8, 22, 23, and 26 directly or indirectly depend from independent claim 1, and claims 13, 15, 16, 19, 29, and 30 directly or indirectly depend from independent claim 12. Independent claim 1 is illustrative of the '836 patent and is reproduced below:

1. A method for creating a voice connection over a circuit switched network between a first party and a second party using an on-line data service to initiate the connection, comprising the steps of:
 - a) establishing an electronic communication between the first party and the second party

Appendix D

through the on-line data service between the first party and the second party, wherein the first party is anonymous to the second party prior to establishing a first electronic communication between the first party and the second party, wherein the establishing includes providing over the Internet, to a data terminal of the first party coupled to the Internet, information publicly accessible over the Internet, wherein the information publically accessible over the Internet is suitable for presentation within a graphical user interface of the data terminal of the first party, wherein the information publicly accessible over the Internet includes:

- (1) first information characterizing a second party,
- (2) second information representing a communication from the second party, and
- (3) third information specifying a user-selectable element for display within the graphical user interface of the data terminal of the first party, wherein the user-selectable element is visually associated, within the graphical user interface of the data terminal of the first party, with the first information and the

Appendix D

second information, when the first information, second information and user-selectable element are presented within the graphical user interface of the data terminal of the first party; and

(b) following the establishment of an electronic communication between the first party and the second party through the on-line data service between the first party and the second party, and in response to receiving an indication of selection of the user-selectable element displayed within the graphical user interface of the data terminal of the first party, performing the steps of:

(1) requesting a voice communication between the first party and the second party through the on-line data service;

(2) transmitting a message from the on-line data service to a voice system requesting the voice connection between said first party and said second party;

(3) establishing a first telephone call for the first party;

(4) establishing a second telephone call for the second party; and

Appendix D

(5) connecting said first telephone call with said second telephone call.

Ex. 2001², 1:26–2:8 (brackets and emphases omitted).

C. Related Proceedings

Both parties indicate that the '836 patent was asserted in the following civil actions, each of which was filed in the United States District Court for the Western District of Texas: (1) *Click to Call Technologies LP v. Oracle Corporation*, No. 1:12-cv-00468-SS, filed on May 29, 2012; (2) *Click to Call Technologies LP v. eHarmony, Inc.*, No. 1:12-cv-00469-SS, filed on May 30, 2012; and (3) *Click to Call Technologies LP v. AT&T, Inc.*, No. 1:12-cv-00465-SS, filed on May 29, 2012. Pet. 1–2; Paper 7, 2–3.

D. Prior Art Relied Upon

Oracle relies upon the following prior art references:

Dezonno US 5,991,394 Nov. 23, 1999 Ex. 1002
(effectively filed Apr. 21, 1995)

DALE DOUGHERTY & RICHARD KOMAN, THE MOSAIC HANDBOOK FOR MICROSOFT WINDOWS 17–39 (1994) (Ex. 1004) (“Mosaic Handbook”).

2. This citation is to Ex Parte Reexamination Certificate No. US 5,818,836 C1, which issued on December 30, 2008.

*Appendix D***E. Instituted Grounds of Unpatentability**

We instituted this proceeding based on the asserted grounds of unpatentability set forth in the table below.

Challenged Claims	Basis	Reference(s)³
1, 2, 12, 13, 19, 22, 23, 26, 29, and 30	§ 102(e)	Dezonno
1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30	§ 103(a)	Dezonno
22 and 29	§ 103(a)	Dezonno and Mosaic Handbook

3. For the grounds of unpatentability based solely on Dezonno, although Oracle includes dependent claims 18 and 24 in the statement of the grounds of unpatentability (Pet. 21), Oracle nonetheless does not include dependent claims 18 and 24 in the corresponding analysis (*see id.* at 21–31). Conversely, although Oracle omits dependent claims 22 and 29 in the statement of the grounds of unpatentability (*id.* at 21), Oracle nonetheless includes dependent claims 22 and 29 in the corresponding analysis (*id.* at 29, 31). We will treat the incorrect statement of the grounds of unpatentability as a typographical error and presume Oracle intended to assert that claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 are anticipated under 35 U.S.C. § 102(e) by Dezonno, whereas claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are unpatentable under 35 U.S.C. § 103(a) over Dezonno.

*Appendix D***II. ANALYSIS****A. Claim Construction**

In an *inter partes* review, we construe a claim by applying the broadest reasonable interpretation in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012).

1. Claim Terms or Phrases Construed by Oracle

In its Petition, Oracle provides claim constructions for a number of claim terms or phrases recited in the '836 patent. Pet. 8–11 (citing Ex. 1009; Ex. 1010). CTC does not propose alternative claim constructions for these claim terms or phrases in either its Preliminary Response or Patent Owner Response. We adopted the claim constructions proposed by Oracle in our Decision to Institute (Dec. 10–13) and we discern no reason to alter those claim constructions for this Final Written Decision. For convenience, the claims constructions proposed by Oracle are reproduced in the table below.

Claim(s)	Claim Term or Phrase	Claim Construction
1 and 12	“party”	A person or group participating in an action.
1 and 12	“anonymous”	Identity is not revealed.

Appendix D

Claim(s)	Claim Term or Phrase	Claim Construction
1 and 12	“voice system”	A system that can connect voice calls.
1 and 12	“data terminal”	A computing device capable of sending and/or receiving data.
1	“on-line data service”	A service provided by an on-line data system, such as electronic mail, chat, newsgroups, or access to information.
12	“on-line data system”	A computing device or distributed computing system with storage and communications capability that provides services on-line, such as electronic mail, chat, newsgroups, or access to information.
1 and 12	“information publicly accessible”	Information that is widely available and subject to minimal constraints, such as subscription, registration, or ability to access the on-line data service or system.

Appendix D

Claim(s)	Claim Term or Phrase	Claim Construction
1	“establishing [or establishment of] an electronic communication between the first party and the second party”	Transferring information electronically from one party to another party.
1 and 12	“second information representing a communication from the second party”	Information representing information transferred from the second party.
1	“requesting a voice communication between the first party and the second party through the on-line data service”	Requesting a voice communication using the on-line data service.
12	“connect command”	A command that directs the voice system to connect a first telephone call with a second telephone call.

Appendix D

Claim(s)	Claim Term or Phrase	Claim Construction
1 and 12	“indication [or indicative] of selection of the user-selectable element”	Information indicating that the user-selectable element was selected.
12	“on-line data system that is coupled to the data terminal of each party”	A computing device or distributed computing system with storage and communications capability that provides services on-line, such as electronic mail, chat, newsgroup, or access to information, and is coupled to the data terminal of each party.
1	“on-line data service between the first and the second party”	A service provided by an on-line data system, such as electronic mail, chat, newsgroup, or access to information.

**2. “First Information” and “Second Information”
(Claims 1 and 12)**

In its Petition, Oracle contends that the claim terms “first information” and “second information” recited in independent claims 1 and 12 are not entitled to patentable weight because each claim term amounts to nonfunctional descriptive material that has no functional relationship

Appendix D

to any substrate or other portions of the claims. Pet. 60. In its Preliminary Response, CTC contends that the “first information” and “second information” recited in independent claim 1 are entitled to patentable weight because they have a direct functional relationship to the claimed “establishing” step (a), as well as the claimed “performing” steps (b)(1)–(5). Prelim. Resp. 21–23. Similarly, CTC contends that “first information” and “second information” recited in independent claim 12 are entitled to patentable weight because they have a direct functional relationship to “the provision of the information publicly accessible,” which is structured through the claimed visual association of a user-selectable element with the first and second information. *Id.* at 23.

In the Decision to Institute, we determined that, because the claim terms “first information” and the “second information” have a functional relationship with other claimed features recited in independent claims 1 and 12, these claim terms limit the claimed invention functionally and, as a result, are entitled to patentable weight. Dec. 13–14. During trial, neither Oracle nor CTC dispute our determination in that regard. We discern no reason to alter our claim construction of these claim terms for this Final Written Decision.

**B. YP Interactive LLC Is Not Barred Under
35 U.S.C § 315(b) From Pursuing an *Inter
Partes* Review of the '836 Patent**

In the Decision to Institute, as well as a subsequent Decision on CTC’s Request for Rehearing (Paper 40), we determined that one of the original Petitioners—namely,

Appendix D

Ingenio LLC, which has since changed its name to YP Interactive LLC—is not barred from pursuing an *inter partes* review under 35 U.S.C. § 315(b). Dec. 15–18; Paper 40, 3–5. In its Patent Owner Response, CTC renews its argument that we erroneously interpreted § 315(b) because the legislative history associated with this statute dictates that the plain meaning of “served with a complaint alleging infringement of [a] patent” is conclusive and, therefore, our analysis of the issue in both the Decision to Institute and the Decision on CTC’s Request for Rehearing erred in looking beyond the statutory language. PO Resp. 53–56. In its Reply, Oracle reiterates the position we took in both the Decision to Institute and the Decision on CTC’s Request for Rehearing that there is no statutory bar against YP Interactive LLC because a voluntarily dismissal of a complaint without prejudice does not trigger a bar under § 315(b). Pet. Reply 15.

As stated in the Decision to Institute and the Decision on CTC’s Request for Rehearing, both the Federal Rules of Civil Procedure and Federal Circuit precedent treat a dismissal without prejudice as something that, *de jure*, never existed. Dec. 16–17; Paper 40, 4. It is undisputed that the patent infringement suit filed by Inforocket against Keen—now YP Interactive LLC—on June 8, 2001, was dismissed without prejudice on March 21, 2003. Ex. 1019, 1; Ex. 1017, 4; Ex. 1018, 8. We have determined that, because this patent infringement suit was dismissed without prejudice, Federal Circuit precedent interprets such a dismissal as leaving the parties in the same legal position as if the underlying complaint had never been served. *See Graves v. Principi*, 294 F.3d 1350, 1356 (Fed.

Appendix D

Cir. 2002); *Bonneville Assoc., Ltd. P'ship v. Baram*, 165 F.3d 1360, 1364 (Fed. Cir. 1999). *Accord* 9 WRIGHT, MILLER, KANE, and MARCUS, FEDERAL PRAC. & PROC. CIV. § 2367 (3d. ed.). As a consequence, YP Interactive LLC is not barred from pursuing an *inter partes* review of the '836 patent under § 315(b).

**C. Grounds of Unpatentability Based,
in Whole or in Part, on Dezonno**

In its Petition, Oracle presents the following grounds of unpatentability: (1) claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 are anticipated under 35 U.S.C. § 102(e) by Dezonno; (2) claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are unpatentable under 35 U.S.C. § 103(a) over Dezonno; and (3) claims 22 and 29 are unpatentable under 35 U.S.C. § 103(a) over the combination of Dezonno and Mosaic Handbook. Pet. 15–33. In support of these asserted grounds of unpatentability, Oracle relies upon claim charts to explain how Dezonno, either standing alone or in combination with Mosaic Handbook, discloses the claimed subject matter recited in each of these claims. *Id.* Oracle also presents the Declaration of Dr. Robert L. Stevenson (Ex. 1007 ¶¶ 11–17) to support its positions. *Id.*

In its Patent Owner Response, CTC does not challenge the contentions and supporting evidence presented by Oracle in its Petition, but instead attempts to antedate Dezonno. In particular, CTC contends that the invention embodied in these claims (“the claimed invention”) was conceived prior to the earliest effective filing date of Dezonno—namely, April 21, 1995 (Ex. 1002, at [63]).

Appendix D

PO Resp. 1–2. CTC further contends that the claimed invention was constructively reduced to practice on August 9, 1995, the filing date of the patent application that led to the '836 patent, as well as actually reduced to practice on August 15, 1995, the day before the ONE BBSCON conference. *Id.* at 2–3. According to CTC, the ONE BBSCON conference was a major industry conference where Mr. Stephen C. DuVal, the named inventor of the '836 patent (Ex. 1001, at [76]), planned to announce his purported invention. PO Resp. 1. In addition, CTC asserts that Mr. DuVal continually exercised reasonable diligence from April 20, 1995, through August 9, 1995 (“the critical period”). *Id.* at 5–8. As a consequence, CTC argues that Dezonno does not qualify as prior art under 35 U.S.C. § 102(e). *Id.* at 8

We begin our analysis with the principles of law that generally apply to antedating a reference, followed by a brief discussion of the parties contentions regarding conception, and then we turn to the parties contentions regarding whether there is sufficient evidence on this record to provide independent corroboration of Mr. DuVal’s testimony that he continually exercised reasonable diligence during the entire critical period.

1. Principles of Law

An inventor may antedate a reference if he was the first to conceive of a patentable invention, and then connects the conception of his invention with its reduction to practice by reasonable diligence on his part, such that conception and diligence are substantially one continuous

Appendix D

act. *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996). An inventor's testimony, standing alone, is insufficient to prove conception and diligence, as some form of corroboration is required. *Mahurkar*, 79 F.3d at 1577; *Price v. Symsek*, 988 F.2d 1187, 1194 (Fed. Cir. 1993). A rule of reason applies to determine whether the inventor's testimony has been corroborated. *Price*, 988 F.2d at 1194.

During the period in which reasonable diligence must be shown, there must be continuous exercise of reasonable diligence. *In re McIntosh*, 230 F.2d 615, 619 (CCPA 1956); see also *Burns v. Curtis*, 172 F.2d 588, 591 (CCPA 1949) (referring to "reasonably continuous activity"). A party alleging diligence must account for the entire critical period. *Griffith v. Kanamuru*, 816 F.2d 624, 626 (Fed. Cir. 1987); *Gould v. Schawlow*, 363 F.2d 908, 919 (CCPA 1966). Even a short period of unexplained inactivity is sufficient to defeat a claim of diligence. *Morway v. Bondi*, 203 F.2d 742, 749 (CCPA 1953); *Ireland v. Smith*, 97 F.2d 95, 99–100 (CCPA 1938). In *In re Mulder*, 716 F.2d 1542, 1542–46 (Fed. Cir. 1983), for example, the Federal Circuit affirmed a determination of lack of reasonable diligence, where the evidence of record was lacking for a two-day critical period. Likewise, in *Rieser v. Williams*, 255 F.2d 419, 424 (CCPA 1958), there was no showing of diligence where no activity was shown during the first thirteen days of the critical period.

A party alleging diligence must provide corroboration with evidence that is specific both as to facts and dates. *Gould*, 363 F.2d at 920; *Kendall v. Searles*, 173 F.2d 986,

Appendix D

993 (CCPA 1949). The rule of reason does not dispense with the need for corroboration of diligence that is specific as to dates and facts. *Gould*, 363 F.2d at 920; *Kendall*, 173 F.2d at 993; *see also Coleman v. Dines*, 754 F.2d 353, 360 (Fed. Cir. 1985) (“The rule of reason . . . does not dispense with the requirement for some evidence of independent corroboration.”).

2. Conception

In its Patent Owner Response, CTC contends that the following documents collectively demonstrate that Mr. DuVal conceived of the claimed invention of the '836 patent before the earliest effective filing date of Dezonno—namely, April 21, 1995: (1) the October 1994 invention disclosure document filed with the Office (Ex. 2017, Attachment A); (2) the February 1995 PrivTel⁴ Business Plan produced by Mr. DuVal at the request of Mr. Brian Forrest (Ex. 2017, Attachment C); (3) the March 1995 invention disclosure document filed with the Office (Ex. 2017, Attachment B); and (4) the March 1995 letter Mr. DuVal sent to the law firm of Blakely, Sokoloff, Taylor, and Zafman LLP instructing them to prepare and file a patent application (Ex. 2017, Attachment O). PO Resp. 10–36. CTC further contends that these documents independently corroborate Mr. DuVal’s testimony that he conceived of the claimed invention of the '836 patent prior to April 21, 1995. *Id.*

4. Mr. DuVal testifies that he formed PrivTel on December 12, 1994, to demonstrate, produce, commercialize, and sell his claimed inventions. Ex. 2017 ¶ 7(C).

Appendix D

In its Reply, Oracle contends that CTC has not established that Mr. DuVal conceived of the claimed invention of the '836 patent before April 21, 1995, because CTC does not demonstrate that distributing client software over the Internet, as required by independent claims 1 and 12, was either inherent or obvious in light of the March 1995 invention disclosure document. Pet. Reply 14. Oracle further argues that independent claims 1 and 12 both require that the claimed user-selectable element, first information, and second information must be displayed at the same time. *Id.* at 15. Oracle asserts that, because the claimed user-selectable element is part of the client software, it is displayed when the software begins to run, i.e., before display of the claimed second information. *Id.*

Even if we were to agree with CTC that there is sufficient evidence to corroborate Mr. DuVal's testimony that he conceived of the claimed invention of the '836 patent prior to April 21, 1995, as we will discuss below, CTC does not provide sufficient evidence to corroborate Mr. DuVal's testimony that there was a continuous exercise of reasonable diligence during the entire critical period. Consequently, we need not reach and, therefore, do not address conception.

3. Diligence

To demonstrate diligence during the entire critical period, CTC relies upon the declarations of the following individuals: (1) Mr. DuVal (Ex. 2017); (2) Mr. Forrest (Ex. 2019); (3) Mr. Ben Yorks (Ex. 2021), a former partner at

Appendix D

Blakely, Sokoloff, Taylor, and Zafman LLP who was hired by Mr. DuVal to draft and file the patent application that led to the '836 patent; (4) Mr. Bob Shinn (Ex. 2022), the former president and owner of SofTel, Inc. (“SofTel”); (5) Mr. Simon Clement (Ex. 2023), the former president of ProDesign, Inc. (“ProDesign”); and (6) Mr. Doug Martin (Ex. 2025), the former Chief Technology Officer and co-owner of Interactive Communication Services (“ICS”). PO Resp. 36–48. Of particular importance is the testimony of Mr. Yorks regarding his preparation in drafting and filing the patent application that led to the '836 patent, as well as the testimony of Mr. Shinn, Mr. Clement, and Mr. Martin, each of whom represents one of the three software developers—namely, SofTel, ProDesign, and ICS—hired by Mr. DuVal to implement the claimed invention. *Id.* at 39–40. In its Reply, Oracle contends that CTC does not provide sufficient evidence to corroborate Mr. DuVal’s testimony that he was reasonably diligent during the entire critical period with respect to both constructively reducing the claimed invention to practice and actually reducing the claimed invention to practice. Pet. Reply. 5–13.

In our analysis below, we will explain how the aforementioned supporting evidence, taken as a whole, does not support CTC’s contention that there was a continuous exercise of reasonable diligence during the entire critical period. In particular, we will address how this evidence does not demonstrate that Mr. DuVal was diligent with respect to constructive reduction to practice, and then turn to how this evidence does not demonstrate that he was diligent with respect to actual reduction to practice.

*Appendix D***a. CTC Does Not Demonstrate a Continuous Exercise of Reasonable Diligence With Respect to Constructive Reduction to Practice**

As we explained previously, Mr. DuVal constructively reduced the claimed invention to practice when he filed the patent application that led to the '836 patent on August 9, 1995. The earliest effective filing date of Dezonno is April 21, 1995. Ex. 1002, at [63]. To show diligence with respect to constructive reduction to practice during the entire critical period, CTC primarily relies upon the testimony of Mr. DuVal and Mr. Yorks.

Mr. DuVal testifies that, after Mr. Yorks prepared an initial draft of the patent application that led to the '836 patent just prior to April 21, 1995, until at least May 2, 1995, he personally reviewed and revised the initial draft between May 2, 1995, and May 9, 1995. Ex. 2017 ¶ 8(D)(1)–(2); *see also* Ex. 2024 ¶ 7 (William W. Schaal, a current partner at Blakely, Sokoloff, Taylor, and Zafman LLP, testifies that, at the direction of Mr. DuVal, he obtained an advisor letter and a draft patent application that was sent from his law firm to Mr. DuVal on May 2, 1995.). Mr. DuVal then testifies that “[f]rom at least May 9, 1995 until July 17, 1995, Mr. Yorks and I continued to make progress on the preparation of my patent application.” Ex. 2017 ¶ 8(D)(3). Mr. Yorks’s testimony regarding the preparation and review of the initial draft of the patent application that led to the '836 patent is consistent with the timeline provided by Mr. DuVal. *Compare* Ex. 2021 ¶ 6 (H)–(J), *with* Ex. 2017 ¶ 8(D)(1)–(3).

Appendix D

The testimony offered by Mr. DuVal and Mr. Yorks concerning the preparation and review of the draft patent application, however, is not specific as to facts and dates for the entire critical period during which diligence is required. *See Gould*, 363 F.2d at 920; *Kendall*, 173 F.2d at 993. Mr. DuVal and Mr. Yorks do not provide sufficient evidence to corroborate the work actually performed on the draft patent application that led to the '836 patent between May 9, 1995, and July 17, 1995. Given the absence of specific details concerning the work that was done on the draft patent application, the testimony from Mr. DuVal and Mr. Yorks amounts to mere pleadings and is insufficient to establish diligence with respect to constructive reduction to practice during this time period. *See In re Harry*, 333 F.2d 920, 923 (CCPA 1964) (Statements that are unsupported by evidence or a showing of facts essentially amount to mere pleadings.). Moreover, during oral argument, counsel for CTC conceded that, if we were to focus exclusively on the activities either Mr. DuVal or Mr. Yorks engaged in to constructively reduce the claimed invention to practice, that, by itself, would be insufficient to establish diligence during the entire critical period. Tr. 35:17–36:9.

Based on the record before us, the testimony from Mr. DuVal and Mr. Yorks regarding constructive reduction to practice is not specific as to facts and dates for at least the time period between May 9, 1995, and July 17, 1995, and, as result, does not establish that Mr. DuVal was diligent during the entire critical period.

*Appendix D***b. CTC Does Not Demonstrate a Continuous Exercise of Reasonable Diligence With Respect to Actual Reduction to Practice**

As we explained previously, CTC contends that Mr. DuVal actually reduced the claimed invention to practice on August 15, 1995, the day before the ONE BBSCON conference was scheduled to begin in Tampa, Florida. The earliest effective filing date of Dezonno is April 21, 1995. Ex. 1002, at [63]. To show diligence during the entire critical period leading to this actual reduction to practice, CTC primarily relies upon the testimony of Mr. DuVal, as well as the testimony of Mr. Shinn, Mr. Clement, and Mr. Martin, regarding the work performed by the three software developers hired by Mr. DuVal to implement the claimed invention.

Mr. DuVal testifies that “[f]rom at least prior to April 21, 1995 until at least August 20, 1995, I was working full-time, approximately twelve hours a day, seven days a week, to execute on my company’s business plan, and particularly to meet my Diligence Goals.” Ex. 2017 ¶ 8(C). This testimony from Mr. DuVal regarding the work he performed to implement the claimed invention is not specific as to facts and dates for the entire critical period during which diligence is required. *See Gould*, 363 F.2d at 920; *Kendall*, 173 F.2d at 993. Once again, Mr. DuVal’s statement amounts to a mere conclusion and lacks sufficient detail to establish diligence with respect to actual reduction to practice during the entire critical period. *See Harry*, 333 F.2d at 923.

Appendix D

With respect to the three software developers hired by Mr. DuVal to implement the claimed invention, Mr. DuVal testifies that “[a]t a minimum, each . . . [of] ICS, SofTel and ProDesign, committed at least one full-time engineer to PrivTel’s development efforts to complete a working prototype of [the claimed invention] . . . in time for [the] ONE BBSCON [conference] on August 16–20, 1995.” Ex. 2017 ¶ 8(F) (citing Ex. 2022 ¶¶ 11–18; Ex. 2023 ¶ 18; Ex. 2025 ¶ 10). CTC, however, does not provide sufficient evidence to corroborate the testimony of Mr. DuVal regarding the work performed by the engineers employed by SofTel, ProDesign, and ICS to implement the claimed invention.

For instance, CTC does not provide test results, billing records, or other documentary evidence indicating that these engineers engaged in a continuous exercise of reasonable diligence during the entire critical period to implement the claimed invention. Absent such corroborating evidence, we are left to speculate whether the work performed by these engineers took several weeks or just a couple of days to complete. Even if we were to assume that the work took several weeks to complete, we cannot assess whether there are any diligence gaps during the critical period without sufficient evidence establishing what activities took place on particular dates. Conversely, if we were to assume that the work performed by these engineers only took a few days to complete, then there necessarily would be one or more large gaps in diligence during the critical period that are unaccounted for. Put simply, without sufficient evidence to substantiate details of the work performed by the engineers employed by

Appendix D

SofTel, ProDesign, and ICS to implement the claimed invention, CTC has failed to corroborate Mr. DuVal's testimony that these engineers performed reasonably continuous activities to reduce the claimed invention to practice.

In its Patent Owner Response, CTC focuses on certain activities performed by each software developer to implement the claimed invention and the respective payments made by PrivTel to each software developer for their services. PO Resp. 41–47. The analysis that follows focuses on the activities of each software developer and the corresponding payments received from PrivTel, particularly during the time period between May 15, 1995, and June 15, 1995.

i. ICS

Mr. DuVal testifies that he worked with ICS to develop a software development services agreement to build the claimed invention, which, in turn, was executed on or around May 15, 1995. Ex. 2017 ¶ 8(J)(2). Mr. DuVal further testifies that PrivTel made an initial payment of \$2,000 to ICS on May 15, 1995, after which ICS worked diligently to design the claimed invention, including the system architecture, communication protocols, and overall system design work. Ex. 2017 ¶ 8(J)(3). After ICS completed its design of the claimed invention, Mr. DuVal testified that PrivTel made another payment of \$6,400 to ICS on July 1, 1995. *Id.* Mr. Martin's testimony regarding the design of the claimed invention by ICS and corresponding payments for its services is consistent with the timeline provided

Appendix D

by Mr. DuVal. *Compare* Ex. 2025 ¶ 10–15, *with* Ex. 2017 ¶ 8(J)(2)–(3).

In its Reply, Oracle contends that neither Mr. DuVal nor Mr. Martin identify the tasks or activities performed by ICS on a particular date between May 15, 1995, and July 1, 1995, nor do they provide documentary evidence that provides such information. Pet. Reply 9. Oracle further argues that there is no evidence of record indicating that ICS actually created a design of the claimed invention during this period, nor that ProDesign and SofTel waited for, or even subsequently used, the design allegedly created by ICS. *Id.* at 11.

The testimony that CTC relies upon to explain the activities performed by ICS to implement the claimed invention is not specific as to facts and dates for the entire critical period during which diligence is required, particularly during the time period between May 15, 1995, and July 1, 1995. First, Mr. DuVal does not indicate that he has personal knowledge about the work performed by ICS during this time period. Therefore, his testimony is entitled to little weight. Second, Mr. Martin does not indicate whether it took ICS several weeks or just a few days to complete the design of the claimed invention. Third, CTC does not provide evidence that the design of the claimed invention allegedly created by ICS during this time period actually exists. Nor does CTC indicate that this alleged design was necessary for ProDesign and SofTel to complete the work they were hired to perform to implement the claimed invention. *See e.g.*, Ex. 2023, Attachment A; Ex. 2022, Attachment C. Absent

Appendix D

underlying evidence to support the testimony from Mr. DuVal and Mr. Martin that ICS worked diligently to implement the claimed invention between May 15, 1995, and July 1, 1995, we are not persuaded that ICS performed reasonably continuous activities to reduce the claimed invention to practice during this time period.

ii. ProDesign

Mr. DuVal testifies that on June 15, 1995, PrivTel paid ProDesign \$5,000 to begin its first design phase of the claimed invention. Ex. 2017 ¶ 8(N)(4). Mr. Clement, however, testifies that ProDesign did not enter into a contract with PrivTel to develop software for the claimed invention until June 26, 1995. Ex. 2023 ¶ 4. Mr. Clement further testifies that, “[e]ven before the contract was signed, [he] began working diligently on the software for [the claimed invention] because of the relatively short amount of time before Mr. DuVal planned to demonstrated [the claimed invention] at the upcoming ONE BBSCON conference in August.” *Id.* ¶ 11.

In its Reply, Oracle contends that Mr. Clements never corroborates that ProDesign actually performed work on the claimed invention between May 15, 1995, and June 15, 1995. Pet. Reply 8. Oracle also asserts that, in light of Mr. DuVal’s testimony, ProDesign began its work to implement the claimed invention no earlier than June 15, 1995, because that was the date PrivTel made its initial payment of \$5,000 to ProDesign. *Id.*

Appendix D

The testimony that CTC relies upon to explain the activities performed by ProDesign to implement the claimed invention is not specific as to facts and dates for the entire critical period during which diligence is required, particularly during the time period between May 15, 1995, and June 15, 1995. Although Mr. Clements testifies that he began working diligently on the software for the claimed invention prior to entering into a contract with PrivTel on June 26, 1995, he does not explain adequately the activities he performed on particular dates. Even if we were to assume that Mr. Clements began working diligently to implement the software for the claimed invention on June 15, 1995, the date PrivTel made its initial payment of \$5,000 to ProDesign, the time period between May 15, 1995, and June 15, 1995, still remains unaccounted for. Without some evidence that explains, in detail, the work performed by Mr. Clements on the software of the claimed invention between May 15, 1995, and June 15, 1995, we are not persuaded that ProDesign performed reasonably continuous activities to reduce the claimed invention to practice during this time period.

iii. SofTel

CTC indicates that, because SofTel was hired to develop a control system for the claimed invention that depends on some other subsystems, presumably developed by ICS and ProDesign, SofTel did not begin its work in earnest until July 1, 1995. PO Resp. 45 (citing Ex. 2017 ¶ 8(L)(1); Ex. 2022 ¶¶ 7–16). This is consistent with Mr. DuVal's testimony that PrivTel paid SofTel \$3,000 on July 1, 1995, to begin designing the control system of the claimed invention. Ex. 2017 ¶ 8(L)(3).

Appendix D

In its Reply, Oracle contends that CTC admits in its Patent Owner Response that SofTel did not begin working to implement the claimed invention until July 1, 1995, and its admission in that regard is consistent with the testimony proffered by Mr. DuVal. Pet. Reply 8 (citing Ex. 2017 ¶ 8(L)(1)–(3)).

The testimony that CTC relies upon to explain the activities performed by SofTel to implement the claimed invention is not specific as to facts and dates for the entire critical period during which diligence is required, particularly during the time period between May 15, 1995, and July 1, 1995. Indeed, Mr. DuVal’s testimony that SofTel was awaiting the overall system architecture designed by ICS before it began its work in earnest on July 1, 1995 (Ex. 2017 ¶ 8(L)(1); *see* Tr. 28:4–29:12) constitutes persuasive evidence that SofTel did not perform reasonably continuous activities to reduce the claimed invention to practice between May 15, 1995, and July 1, 1995.

Based on the record before us, the testimony from Mr. DuVal regarding actual reduction to practice, as well as the testimony of Mr. Shinn, Mr. Clement, and Mr. Martin regarding the work performed by the three software developers hired by Mr. DuVal to implement the claimed invention, is not sufficiently specific as to facts and dates for at least the time period between May 15, 1995, and June 15, 1995, to demonstrate that Mr. DuVal was diligent during the entire critical period.

*Appendix D***4. Summary**

Applying the rule of reason, the evidence relied upon by CTC to corroborate Mr. DuVal's testimony does not demonstrate a continuous exercise of reasonable diligence during the entire critical period with respect to either constructive reduction to practice or actual reduction to practice, particularly during the time period between May 15, 1995, and June 15, 1995. As a result, CTC has not antedated Dezonno, which, in turn, qualifies as prior art to the '836 patent under 35 U.S.C. § 102(e).

Upon reviewing the unchallenged contentions and supporting evidence presented by Oracle in its Petition for the grounds of unpatentability based, in whole or in part, on Dezonno (Pet. 15–33; Ex. 1007 ¶¶ 11–17), we are persuaded that Oracle presents sufficient evidence to support a finding that Dezonno, either standing alone or in combination with Mosaic Handbook, discloses the claimed subject matter recited in claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30. We also are persuaded that Oracle provides an articulated reason with a rational underpinning to combine the teachings of Dezonno and Mosaic Handbook. Pet. 32–33; Ex. 1007 ¶ 17. Therefore, based on the record before us, we conclude that Oracle has demonstrated by a preponderance of the evidence that: (1) claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 are anticipated by Dezonno; (2) claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are obvious over Dezonno; and (3) claims 22 and 29 are obvious over the combination of Dezonno and Mosaic Handbook.

*Appendix D***III. CONCLUSION**

Oracle has demonstrated by a preponderance of the evidence that claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the '836 patent are unpatentable based on the grounds of unpatentability set forth in the table below.

Challenged Claims	Basis	Reference(s)
1, 2, 12, 13, 19, 22, 23, 26, 29, and 30	§ 102(e)	Dezonno
1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30	§ 103(a)	Dezonno
22 and 29	§ 103(a)	Dezonno and Mosaic Handbook

IV. ORDER

In consideration of the foregoing, it is

ORDERED that Oracle has shown by a preponderance of the evidence that claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the '836 patent are unpatentable; and

FURTHER ORDERED that, because this is a final written decision, parties to this proceeding seeking judicial review of our decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

**APPENDIX E — DENIAL OF REHEARING
OF THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT,
DATED NOVEMBER 9, 2022**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CLICK-TO-CALL TECHNOLOGIES LP,

Plaintiff-Appellant,

v.

INGENIO, INC., DBA KEEN, ETHER, THRYV, INC.,

Defendants-Appellees.

2022-1016

Appeal from the United States District Court
for the Western District of Texas in
No. 1:12-cv-00465-LY, Judge Lee Yeakel.

**ON PETITION FOR PANEL REHEARING
AND REHEARING EN BANC**

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

1. Circuit Judge Schall participated only in the decision on the petition for panel rehearing.

77a

Appendix E

PER CURIAM.

ORDER

Ingenio, Inc., Ether, Thryv, Inc. filed a combined petition for panel rehearing and rehearing en banc. A response to the petition was invited by the court and filed by Click-to-Call Technologies LP. The petition was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue November 16, 2022.

November 9, 2022

Date

FOR THE COURT

/s/ Peter R. Marksteiner

Peter R. Marksteiner

Clerk of Court