

No. 22-873

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

BRIEF IN OPPOSITION

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QUESTION PRESENTED

35 U.S.C. § 315(e)(2) estops a “petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision” from asserting in a civil action that “the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review” before the U.S. Patent and Trademark Office (“PTO”). In *SAS Inst., Inc. v. Iancu*, this Court confirmed that the “scope” of the inter partes review (“IPR”) and resulting final written decision is defined by the petition: “the petitioner’s contentions, not the [PTO’s] discretion, define the scope of the [IPR] litigation all the way from institution through to conclusion.” 138 S. Ct. 1348, 1357 (2018).

The question presented is: Does § 315(e)(2) estop a petitioner from asserting in a civil action that a claim is invalid on a ground that it knew about but chose not to assert in the IPR, where the claim was part of the IPR, the IPR resulted in a final written decision, and the petitioner avoided seeking correction of the final written decision to address all claims asserted in the IPR petition?

CORPORATE DISCLOSURE STATEMENT

Respondent Click-to-Call Technologies, LP, is a limited partnership organized under the laws of the State of Texas. It has no parent corporation, and no publicly held corporation owns 10% or more of its stock.

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INTRODUCTION

The inter partes review (“IPR”) system by design comes with risks and benefits. It provides parties sued for patent infringement an avenue to challenge the validity of patent claims before the PTO (specifically, the Patent Trial and Appeal Board or “Board”). 35 U.S.C. § 311; *SAS*, 138 S. Ct. at 1353. In exchange, the system requires those petitioners to make their challenges efficiently and not burden the PTO, patent owners, and the federal courts with repeated attempts to invalidate the same claim. 35 U.S.C. § 315(e). To that end, the IPR estoppel statute bars a petitioner from raising in a civil action any “ground” for invalidating a patent claim which the petitioner “reasonably could have raised during” the IPR. *Id.* § 315(e)(2).

The Federal Circuit below correctly recognized this. It also correctly recognized that Petitioner Thryv¹ is attempting to escape the straightforward estoppel effects here through a (legally foreclosed) loophole of its own making. In 2013, Thryv initiated an IPR, asserting that a claim (Claim 27) in Respondent’s patent was invalid on one prior-art ground (Freeman) but not on another (Dezonno). App. 6a-7a. This was in spite of the fact that Thryv challenged *thirteen other claims of the same patent in the same IPR* under Dezonno. *Id.*

This choice—whether based on the relative weakness of Dezonno for invalidating Claim 27 or otherwise—had implications for Thryv. In 2014, the

¹ For ease, this response refers to Petitioners in the singular as “Petitioner” or “Thryv.”

Board concluded that Thryv’s sole challenge of Claim 27 under Freeman was not reasonably likely to succeed and would not advance past the “institution” stage. App. 9a. At institution, the Board determines whether at least one claim challenged in a petition has a “reasonable likelihood” of invalidation. 35 U.S.C. § 314(a). If the IPR passes this stage, it proceeds onward to discovery, briefing, and a trial. 37 C.F.R. §§ 42.4, 42.51. In Thryv’s IPR, the Board “instituted” further review on just the Dezonno grounds. It ultimately invalidated the thirteen claims challenged under Dezonno in a final written decision without addressing Thryv’s challenges to claims under Freeman. Pet. App. 45a–46a.

While that decision was on appeal, this Court in *SAS* decided that what the Board had done in another IPR—instituting and disposing only some claims challenged in the petition in a final written decision—was unauthorized. 138 S. Ct. 1348. Rather, as this Court explained, if a petitioner challenges a claim in its petition and the IPR is instituted, then any final written decision must address that claim and all grounds raised against it. *Id.* at 1354–55.

As Thryv admitted at oral argument below, it had the opportunity to ask the Board to fix this error in its IPR after *SAS*. Pet. App. 11a (citing Oral Arg. at 18:30–19:10).² Thryv chose not to because, as it told the Federal Circuit, it did not want to reopen and jeopardize the favorable final written decision it had in hand. *Id.* What Thryv left unspoken, but the record plainly evinces, is that Thryv knew any effort to

² Available at https://oralarguments.cafc.uscourts.gov/default.aspx?fl=22-1016_06092022.mp3

harmonize its IPR with *SAS* would not be helpful: The Board had already found that Thryv's sole challenge of Claim 27 under Freeman was not reasonably likely to succeed. App. 9a. The prospect of having that determination ensconced in a final written decision would further undermine Thryv's position.

Now, in the patent infringement suit between the parties, Thryv is attempting to do exactly what § 315(e)(2) forbids: argue that Claim 27 is invalid under Dezonno. To resist estoppel, Thryv consistently argued to the district court and Federal Circuit below that estoppel does not apply because the final written decision (improperly) omits Claim 27. *Infra* at 11-14. Thryv implies this omission suggests Claim 27 was never part of the IPR. But this is exactly backward under *SAS*: What a petitioner challenges in the petition *is* in the IPR and must be addressed in a final written decision. 138 S. Ct. at 1354-55.

The petition for certiorari should be denied.

First, there is no legal error in the Federal Circuit's reasoning. Under the plain language of § 315(e)(2), estoppel applies to any claim that was part of an IPR so long as the IPR itself "results in a final written decision." 35 U.S.C. § 315(e)(2). That is, a petitioner cannot escape estoppel for a claim that was part of an IPR just because the final written decision improperly omitted it (as Thryv argues in its first question presented). Pet. at i-ii. Here, as *SAS* makes clear, Claim 27 was part of the IPR because Thryv challenged it, 138 S. Ct. at 1357, and the IPR resulted in a final written decision.

Thryv's argument (in its second question presented) that it could not have "reasonably . . .

raised” Dezonno against Claim 27 “during [the] inter partes review” just by asserting this ground in its petition—because the petition is not filed “during [an] inter partes review,” which begins after institution—is plainly wrong under *SAS*. Pet. at ii. The petition is the necessary and sufficient means for raising any ground against a claim during an IPR. Not only does *SAS* confirm the petition is part of the IPR, but it also confirms a petitioner ensures a ground is “raised . . . during” the IPR by including the ground in its petition. *See id.* at 1355, 1357. Furthermore, this argument ignores the superseding reason why a challenge to Claim 27 under Dezonno was never in the IPR: Thryv *never* raised this ground with respect to Claim 27 in its petition, so this challenge was not and could not be before the Board.

Second, this case presents no important legal issues for review and is a poor vehicle for the review of § 315(e)(2). Thryv’s first question presented does not address a live legal issue after *SAS*, and Thryv may be unique in having an interest in it.³ Thryv asks whether, under § 315(e)(2), it must face estoppel for a claim that it challenged but that was omitted in the final written decision. *SAS* has entirely mooted this question because any final written decision must address all claims and grounds challenged in the petition. 138 S. Ct. at 1355, 1357. Even though *SAS* provided this guidance *five years ago*, Thryv is still

³ In *California Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022), *cert denied*, No. 22-203 (“*Caltech*”), the estopped claim was addressed in the final written decision, so the only issue concerned grounds for invalidity of that claim that were not addressed in the final written decision.

making this argument now, only because it never sought to correct its IPR under *SAS*.

Nor is Thryv's second question presented suitable for review. Thryv forfeited the argument in this second question. In the district court, Thryv argued estoppel did not apply solely because the final written decision omitted Claim 27. App. 15a–16a. It repeated this argument in the Federal Circuit. App. 27a–28a. Thryv now does not have a real stake in the position it is arguing: whether § 315(e)(2) requires a claim (and the ground(s) against it) to be instituted before a petitioner can “reasonably . . . raise[] [the] ground [against the claim] during that inter partes review.” Here, Thryv never attempted to challenge Claim 27 under *Dezonno*. Its argument that the Board would need to institute Thryv's challenge to Claim 27 *under Freeman* before Thryv could be expected to raise *Dezonno* against Claim 27 is nonsensical. Thryv admits that it appends this second question to its petition in an attempt to yoke its petition to that in *Apple Inc. v. California Institute of Technology*, No. 22-203. But that petition was already denied⁴ and the Court need not consider this inapplicable issue here.

⁴ See Jun. 26, 2023 Order List, No. 22-203, available at https://www.supremecourt.gov/orders/courtorders/062623zor_7m58.pdf.

STATEMENT

A. Inter Partes Review and Estoppel

In 2011, Congress enacted the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, under which it established inter partes review.

An IPR is an administrative process whereby a party petitions the PTO to review the validity of patent claims post-grant. *SAS*, 138 S. Ct. at 1353. IPRs provide an alternative to the civil court process for assessing validity of patent claims. *See id.*

To ensure the efficiency of IPRs and civil actions working in parallel, IPRs have estoppel effect. As explained by then-PTO Director Kappos during legislative hearings on IPR estoppel:

I believe there are significant advantages for patentees who successfully go through the post-grant system—in this case, inter partes review—because of those estoppel provisions. Those estoppel provisions mean that your patent is largely unchallengeable by the same party.

America Invents Act: Hearing on H.R. 1249 Before the House Comm. on the Judiciary, 112th Cong. 52–53 (2011).

By design, IPR estoppel is *broader* than common-law issue preclusion, which requires that an issue be “actually litigated” before estoppel can apply. *See Taylor v. Sturgell*, 553 U.S. 880, 892 (2008). By contrast, IPR estoppel precludes a petitioner from raising in a civil action (i) grounds actually “raised” in the IPR against the claim *and* (ii) grounds that a

petitioner “reasonably could have raised during that inter partes review.” 35 U.S.C. § 315(e)(2).

The IPR estoppel provision states:

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.**

Id. (emphases added).

An IPR begins when the petitioner files a petition, which must identify “each claim challenged,” “the grounds on which the challenge to each claim is based,” and the “evidence that supports the grounds for the challenge to each claim.” *Id.* § 312(a)(3). The patent owner may respond and the parties may exchange some early discovery. *Id.* § 313; 35 CFR § 42.51(a)(1)(i).

The petition is integral to the IPR. As SAS explains, it defines the “scope” of the IPR, just as how a complaint defines the scope of an entire case: “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.” 138 S. Ct. at 1355.

The IPR comprises all claims and grounds raised in the petition, as this Court recognized in *SAS* when presented with the PTO’s then-contrary view:

In the [PTO] Director’s view, he retains discretion to decide which claims make it into an inter partes review and which don’t. The trouble is, nothing in the statute says anything like that [The statute] doesn’t authorize the Director to start proceedings on his own initiative. Nor does it contemplate a petition that asks the Director to initiate whatever kind of inter partes review he might choose. Instead, the statute envisions that a petitioner will seek an inter partes review of a particular kind—one guided by a petition describing “each claim challenged” and “the grounds on which the challenge to each claim is based.” § 312(a)(3). From the outset, we see that Congress chose to structure a process in which it’s the petitioner, not the Director, who gets to define the contours of the proceeding. And just as Congress’ choice of words is presumed to be deliberate and deserving of judicial respect, so too are its structural choices.

Id. at 1355–56 (internal citation omitted).

At the institution stage, the Board reviews the petition, its attached evidence, and any response, and decides whether to “institute” further review—that is, move the IPR forward toward further discovery and trial. 35 U.S.C. § 314; 37 CFR § 42.51(a)(1); *SAS*, 138

S. Ct. at 1354-55. As *Thryv* itself described the function of institution in its petition: “Petitioner requests that *Trial be instituted* and claims 1, 2, 8, 12-13, 15-16, 18-19, 22-24 and 26-30 be cancelled.” App. 7a (emphasis added).

The prerequisite for institution is the Board’s determination that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Where the Board proceeds with institution, it must institute on all claims and grounds in the petition and must decide them *all* in a final written decision. *SAS*, 138 S. Ct. at 1354–55.

Prior to *SAS*, the Board erroneously employed a practice called “partial institution,” under a rescinded version of 37 C.F.R. § 42.108(a) (2017). Through partial institution, the Board would select only a subset of claims or grounds in the petition to institute for trial. *SAS*, 138 S. Ct. at 1355. But in *SAS*, this Court made clear that partial institution is disallowed and inconsistent with the primacy of the petition in setting the scope of the IPR. *Id.* at 1355–56.

At the conclusion of the IPR, the Board issues a final written decision. 35 U.S.C § 318(a). The decision must dispose of all claims and grounds in the petition. *SAS*, 138 S. Ct. at 1354–55. The unsuccessful party may appeal the final written decision to the Federal Circuit. 35 U.S.C § 319.

B. Procedural History

i. The ’836 Infringement Suit

Respondent (“Click-to-Call”) is the owner of U.S. Patent No. 5,818,836 (the ’836 patent), which sets out

a method and apparatus relating to connecting telephone calls over the internet. Pet. App. 46a–47a.

In 2012, Click-to-Call sued Thryv’s predecessors-in-interest for infringement of the ’836 patent in the District Court for the Western District of Texas. *See Click-to-Call Techs. LP v. Ingenio, Inc.*, 45 F.4th 1363, 1366 (Fed. Cir. 2022) (“*CTC*”).

ii. *2013-2020: Thryv’s IPR*

In 2013, Thryv initiated an IPR, challenging in its petition seventeen claims of the ’836 patent, including Claim 27. Pet. App. 45a; App. 1a-7a. The infringement suit was stayed during the pendency of the IPR. *CTC*, 45 F.4th at 1366.

In its petition, Thryv did *not* challenge Claim 27 under the Dezonno reference. App. 6a. It only challenged Claim 27 under the Freeman reference. *Id.* Of course, Thryv was fully aware of the Dezonno ground, having challenged thirteen of the seventeen total claims in the petition under Dezonno, but not Claim 27. *Id.* 4a, 6a.

The Board instituted further review and trial on just the thirteen claims challenged under Dezonno, and not on any Freeman-based ground, like Claim 27. *CTC*, 45 F.4th at 1366. In a written decision on partial institution, referring to the standard in 35 U.S.C. § 314(a), the Board “conclude[d] that the information presented in the petition does not establish that there is a reasonable likelihood that [Thryv] will prevail in challenging claim[] . . . 27 . . . as unpatentable.” App. 9a.

In 2014, the Board issued the final written decision, invalidating the 13 claims challenged under

Dezanno. Pet. App. 45a–46a. For the next six years, from 2014 until 2020, this decision was on appeal. *See Thryv, Inc v. Click-To-Call Techs., LP*, 140 S. Ct. 1367 (2020). *SAS* was decided in 2018 before the final written decision became final after the appeal. *See id.*; *SAS*, 138 S. Ct. 1348.

Thryv acknowledged that, after *SAS*, it could have requested the Board to redress the partial-institution error in its IPR and consider Claim 27. Its counsel admitted at oral argument below that it had this opportunity but strategically decided against it:

Court: Why didn't you go back to the PTO and say, "Hey, *SAS* says that you need to institute on all grounds. You should institute on all grounds." Why didn't you take the option when it was open to you?"

Counsel: Well, frankly, because we had won at the IPR. We didn't want them to reopen and reconsider anything. And additionally, that's not required.

Court: You could have had Claim 27 considered?

Counsel: ***We could have.***

Pet. App. 11a (Oral Arg. at 18:30–19:10).⁵

iii. *2020-2021: Summary judgment*

When the IPR appeal concluded in 2020, the stay in the district court patent infringement litigation

⁵ Available at https://oralarguments.cafc.uscourts.gov/default.aspx?fl=22-1016_06092022.mp3

was lifted. *CTC*, 45 F.4th at 1365. Thryv moved for summary judgment on the infringement claim based on Claim 27. *Id.*

Despite *never* having challenged the validity of Claim 27 under Dezonno in the IPR, Thryv newly made this argument at summary judgment. *Id.* On IPR estoppel, it argued “[t]here is no dispute that claim 27 was not a part of the FWD [final written decision]. . . . Because claim 27 . . . [was] not part of the FWD, Thryv is not estopped from asserting [it is] invalid as anticipated by Dezonno.” App. 16a.

Click-to-Call opposed both these arguments. In Thryv’s reply, it again argued IPR estoppel should not apply, solely because Claim 27 was excluded from the final written decision: “If the claim was not finally adjudicated—i.e., was not part of the final written decision—no estoppel ever attaches.” App. 20a.

In its summary judgment briefing, Thryv did not parse the language of “reasonably could have raised during that inter partes review” under § 315(e). App. 15a–16a, 20a–21a. Tellingly, it did not respond to Click-to-Call’s argument about this language either and instead just refocused on the final written decision: “CTC argues that the ‘reasonably could have been raised’ language somehow salvages its position, but preclusion of those bases (grounds) again only attaches if the claims at issue were subject to a final written decision.” App. 20a.

The district court adopted the magistrate judge’s report and recommendation that recommended granting summary judgment. Pet. App. 22a. The magistrate judge had found that no IPR estoppel applied, but under a common-law “issue preclusion”

rubric (requiring a ground be actually litigated) and not under the statutory standard of § 315(e). *Id.* at 41a. The district court held that Claim 27 was invalid under Dezonno. *Id.* at 23a.

iv. *2021-2022: Federal Circuit Appeal*

On appeal to the Federal Circuit, Click-to-Call challenged the summary judgment rulings on IPR estoppel and the validity of Claim 27.

Click-to-Call argued that the district court had erred in failing to recognize the distinction between common-law issue preclusion and IPR estoppel. *CTC*, 45 F.4th at 1365, 1368. The latter, Click-to-Call argued, is broader and captures within its scope not just the “grounds” actually “raised” in the IPR but any that the petitioner did not raise but “reasonably could have raised in an inter partes review.” *See id.*; 35 U.S.C. § 315(e)(2).

In response, just as in the district court, Thryv focused on the fact that Claim 27 was excluded from the Board’s final written decision. App. 27a–30a. The heading for Thryv’s argument against IPR estoppel in its Federal Circuit opposition brief was: “The district court correctly found that IPR estoppel did not apply to Claim 27, *as it was not part of the PTAB’s Final Written Decision.*” *Id.* 27a (emphasis added).

In the next three and a half pages of argument against IPR estoppel, Thryv responded—for the first time in just one paragraph—to *Click-to-Call’s argument* that Thryv “reasonably could have raised [that Claim 27 was invalid under Dezonno] during that inter partes review.” 35 U.S.C. § 315(e)(2); App. 28a–29a. Quoting and paraphrasing *Shaw Indus. Grp., Inc. v. Automated Creel Sys., Inc.*, 817 F.3d 1293

(Fed. Cir. 2016), *overruled by California Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022), *cert denied*, No. 22-203 (“*Caltech*”), Thryv argued that *Shaw* required a claim be instituted before a party can raise any ground against the claim “during [an] inter partes review.” App. 28a–29a. (Subsequently, *Caltech* overruled *Shaw* as incompatible with *SAS*. See *Caltech*, 25 F.4th at 990–91; *CTC*, 45 F.4th at 1370–71.)

Once again, Thryv summed up its argument for why IPR estoppel did not apply by focusing on the final written decision: “on the actual facts, Claim 27 was *not* part of the IPR or the final written decision and therefore Thryv is *not* estopped under the statute.” App. 30a.

On August 17, 2022, the Federal Circuit rendered its decision, reversing in part, affirming in part, and remanding the case to the district court. *CTC*, 45 F.4th 1363. It held that IPR estoppel precluded Thryv from arguing that Claim 27 is invalid under Dezonno. It thus reversed the district court’s ruling of invalidity under Dezonno. *Id.* at 1366.

On November 9, 2022, the Federal Circuit denied Thryv’s request for a panel rehearing and for a rehearing *en banc* without any dissent. Pet. App. 77a. Notably, among those active judges who voted in favor of this result was Chief Judge Moore, who had penned *Shaw*. *Id.* 76a; see *Shaw*, 817 F.3d 1293.

The instant petition followed.

C. The Federal Circuit Decision

In the decision below, the Federal Circuit held that the conditions for IPR estoppel were met under § 315(e)(2).

First, the Federal Circuit determined that the district court was wrong to reject estoppel by importing into the analysis the “‘actually litigated’ prong of [common-law] issue preclusion.” *CTC*, 45 F.4th at 1368. It reasoned that, under § 315(e)(2), estoppel extends not just to grounds raised, but that “‘reasonably could have [been] raised during that inter partes review.’” *Id.* Because Thryv knew about the Dezonno ground, it “‘reasonably could have raised’” it as to Claim 27 in its petition under § 315(e)(2). *Id.*

Second, the Federal Circuit rejected Thryv’s objection that estoppel could not apply because the final written decision erroneously omitted Claim 27. *Id.* at 1368–69. The court held that § 315(e)(2)’s requirement of an “inter partes review of a claim . . . that results in a final written decision” was met here. Claim 27 was part of the IPR because Thryv “included claim 27 in its petition, and the IPR did result in a final written decision.” *Id.* at 1369. Applying *SAS*, the court reasoned that “the scope of the IPR as defined in the petition included claim 27.” *Id.* That the final written decision excluded Claim 27 erroneously was not “dispositive.” *Id.* Solely due to “a legal error [of the Board] corrected by *SAS*,” the Board excluded discussion of the claim (and Thryv’s sole challenge to the claim under *Freeman*) in the final written decision. *See id.*

The court was careful to cabin this result to the “unusual procedural posture” and “rather unusual set

of facts,” which are unlikely to recur. *Id.* at 1365, 1369. It noted that, although “[t]he Board . . . pre-SAS . . . did not institute on all grounds . . . when given the opportunity to do so post-SAS, [Thryv] did not seek remand for institution on the non-instituted grounds” to bring the IPR into harmony with SAS. *Id.* at 1365-66.

REASONS FOR DENYING THE PETITION

I. THE DECISION BELOW IS PLAINLY CORRECT.

A. The Decision Correctly Reasoned That Whether the Final Written Decision Addresses Claim 27 Is Not Dispositive.

Under § 315(e)(2), IPR estoppel applies after “an inter partes review of a claim in a patent . . . that results in a final written decision.” 35 U.S.C. § 315(e)(2). There is no exclusion for claims that, for whatever reason, were challenged in the IPR but are not addressed in the final written decision. The Federal Circuit correctly held that the plain text of this condition was satisfied.

i. “Inter partes review of” Claim 27

First, as the Federal Circuit reasoned, there was an “inter partes review of” Claim 27. Because Claim 27 was challenged in the petition, it necessarily is part of the inter partes review in light of SAS. SAS, 138 S. Ct. at 1355, 1357. Thus, there was an “inter partes review of” Claim 27.

The IPR statute and SAS make clear an inter partes review begins upon filing of the petition. *See id.* For instance, in describing what a petitioner must assert in its petition, § 314(b) directs that the “petitioner in an inter partes review may request to

cancel as unpatentable 1 or more claims of a patent.” 35 U.S.C. § 314(b). In other words, when the petitioner makes its “request to cancel” a claim in its petition, it is already a “petitioner *in* an inter partes review” and thus the request occurs “*in* an inter partes review.”

Section § 316 on the “Conduct of inter partes review” reinforces this. 35 U.S.C. § 316. It directs the PTO to “prescribe regulations to make public the file of any proceeding under this chapter . . . , except [for] *any petition* or document filed with the intent that it shall be sealed.” *Id.* § 316(a)(1) (emphasis added). This provision characterizes the petition as a “file of [the] proceeding under this chapter,” entitled “Inter Partes Review.” 35 U.S.C. Ch. 31.

Thryv confuses the start of an inter partes review with institution. It suggests there is no inter partes review of Claim 27 unless and until there is institution. But 35 U.S.C. § 315(e)(2) has no specification that it applies only to an “inter partes review of a claim” *after* institution. When the IPR statute is discussing the post-institution period, it specifies so. For instance, § 316 assigns the Board to “conduct each inter partes review *instituted* under this chapter.” *Id.* § 316(c). It further provides that “[d]uring an inter partes review *instituted* under this chapter, the patent owner may” move to amend the patent once. *Id.* § 316(d)(1). If inter partes review begins only at institution, these provisions need not specify that they are referring only to an “instituted” inter partes review.

As a matter of common usage, an IPR is analogous to a term like “case,” which *SAS* reinforces. *See, e.g.*, USPTO.gov, Inter Partes Review (“[I]nter partes review process begins with a third party (a person who

is not the owner of the patent) filing a petition”).⁶ There is a “civil case” as soon as the complaint is filed, just as there is an “inter partes review of a claim” once the petition is filed. *SAS* explained that an IPR petition and civil complaint are comparable in that they both initiate, are part of, and define the scope of the ensuing IPR or case, respectively. *See* 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.”).

- ii. *Thryv’s IPR “result[ed] in a final written decision.”*

The Federal Circuit also correctly reasoned that, in satisfaction of § 315(e)(2), the IPR here did “result[] in a final written decision.” 35 U.S.C. § 315(e)(2). *Thryv* argues this condition was not met because the “final written decision” excluded Claim 27.

This misreads the statutory text. The provision states there must be “an inter partes review of a claim in a patent . . . *that results in* a final written decision.” *Id.* The object that must “result in a final written decision” is the “inter partes review.” The phrase “of a claim” modifies “an inter partes review” and not “a final written decision.”

Put together, these terms mean that the IPR, which must include the claim at issue, ends in a final written decision. The provision does not turn on whether the claim at issue is discussed in the final

⁶ Available at <https://www.uspto.gov/patents/ptab/trials/inter-partes-review>.

written decision. *See Caltech*, 25 F.4th at 989 (“When *IPR proceedings result in a final written decision*, 35 U.S.C. § 315(e)(2)” applies) (emphasis added).

iii. *The Federal Circuit Correctly Recognized That Thryv’s Position Eviscerates the IPR Statutory Scheme.*

Thryv’s contrary reading is at odds with the IPR statutory scheme and *SAS*. By arguing it should escape estoppel *because* the final written decision does not address Claim 27 even though Thryv challenged it—due to the Board’s own error which Thryv deliberately preserved for its benefit—Thryv in effect is trying to create a loophole based on these errors under 35 U.S.C. §§ 314 & 318. *See id.* § 318 (requiring the “final written decision” address “any patent claim challenged by the petitioner” in the instituted petition).

This is improper. A ruling that limits (and pegs) estoppel to the *erroneous* scope of a final written decision undermines the principle in Section 314, Section 318, and *SAS* that petitioner should be held to its own contentions in the IPR. That is, because the petition defines the scope of the IPR, it necessarily defines the scope of estoppel. *See id.* § 315(e)(2) (rooting estoppel in what the “petitioner . . . raised or reasonably could have raised during [an] inter partes review”). Thryv, however, asks to be held to a different standard, to not face responsibility for what it challenged, and instead be allowed to take advantage of the Board’s error that Thryv helped reinforce. A court should not construe a statutory provision (i.e., § 315(e)(2)) in a manner that fails to “produce[] a substantive effect that is compatible with the rest of the law” (i.e., §§ 314 & 318). *See United Sav. Ass’n of*

Texas v. Timbers of Inwood Forest Assocs., Ltd., 484 U.S. 365, 371 (1988).

The Board’s error was to shift its determination on Thryv’s (unsuccessful) challenge of Claim 27 from the final written decision to an unauthorized partial-institution decision. But this error does not change the core facts about Thryv’s estoppel-triggering conduct: It chose to challenge Claim 27, it knew about Dezonno, and it chose not to challenge Claim 27 under Dezonno, but nevertheless, Claim 27 was part of the IPR that concluded in a final written decision.

Thryv indeed had every opportunity to correct the final written decision here and bring it into compliance with SAS and §§ 314 & 318. As it admitted at oral argument below, it could have sought the Board to reconsider the erroneous partial institution decision and “consider[]” the Freeman ground against Claim 27 after SAS. Pet. App. 11a (Oral Arg. at 18:30–19:10).⁷ At the time, the final written decision was not yet final and still on appeal to the Federal Circuit.

Thryv chose not to because, as it told the Federal Circuit, there was no profit for Thryv: It had a final written decision in hand invalidating thirteen claims under Dezonno and did not want to risk disturbing it. *See id.* Thryv knew it was unlikely to succeed on Claim 27 after institution because the Board had decided already that Thryv’s sole challenge to Claim 27 under Freeman was not reasonably likely to succeed. App. 9a–11a. By strategically foregoing the opportunity to correct any defect in the final written decision, Thryv entrenched the Board’s error, yet now

⁷ Available at https://oralarguments.cafc.uscourts.gov/default.aspx?fl=22-1016_06092022.mp3

seeks to take advantage of that error in its misreading of § 315(e)(2).

Thryv argues what it hypothetically could have done to correct the IPR is not relevant. The point, though, is not the hypothetical, but what the law actually authorizes. SAS and Sections 314 and 318 only permit one of two outcomes for a petitioner: either (1) a final written decision that includes all claims or grounds challenged in the petition *or* (2) no final written decision at all and therefore no estoppel or invalidation of any claims. Thryv is arguing for an untenable third option where it can enjoy the *benefits* of challenging the thirteen claims under Dezonno, yet face none of the estoppel *costs* of *only* challenging Claim 27 under Freeman and then failing in that challenge during the IPR. SAS has foreclosed this third possibility. Regardless of whether the final written decision addressed the Freeman-based grounds, Thryv forewent raising any argument that Claim 27 was invalid under Dezonno by not raising it in its petition.

iv. *Thryv's New Arguments in Its Petition Do Not Warrant Review.*

Thryv newly argues in its petition that it had no way of asking the Board to reconsider the final written decision after SAS while the decision was on appeal to the Federal Circuit. According to Thryv, the Federal Circuit later was held to lack appellate jurisdiction over the appeal, so the court did not have jurisdiction at the time to remand to the Board. *See Thryv*, 140 S. Ct. 1367. This is wrong and beside the point.

As discussed, Thryv admitted the opposite already to the Federal Circuit. SAS remands were a common

practice at the time. *See, e.g., BioDelivery Scis. Int'l, Inc. v. Aquestive Therapeutics, Inc.*, 898 F.3d 1205, 1208 (Fed. Cir. 2018) (“Post-SAS cases have held that it is appropriate to remand to the PTAB to consider non-instituted claims as well as non-instituted grounds.”) (compiling Federal Circuit cases). Thryv’s only citation in its petition to argue that remand was not possible here, *Steel Co. v. Citizens for a Better Env’t*, 523 U.S. 83, 94 (1998) (quoting *Ex parte McCardle*, 74 U.S. 506, 514, 19 L. Ed. 264 (1868)), does not help. *Steel Co.* and the quoted case *McCardle* discuss the unremarkable point that absence of jurisdiction precludes any court from deciding the “merits” of issues. *See id.* Neither case addresses or has reason to address the remand powers of appellate courts. *McCardle*, for example, was a habeas appeal. When this Court concluded that Congress had stripped its jurisdiction over this type of appeal, there was nothing further for the Court to do or for any lower court to do on remand—the decision below that approved the detention remained intact. *McCardle*, 74 U.S. at 506, 514.

Importantly, however, Thryv did not need to rely on the Federal Circuit to remand to the Board. It could have asked the Board directly to reconsider its institution decision because the Board has the “inherent” authority to do so. *GTNX, Inc. v. INTTRA, Inc.*, 789 F.3d 1309, 1313 (Fed. Cir. 2015) (explaining the Board has “inherent” or “default authority” to “reconsider[] [an] initial institution decision” and “allow[] a party to file a later request for rehearing from an institution decision.”); *see BioDelivery Scis. Int'l, Inc. v. Aquestive Therapeutics, Inc.*, 935 F.3d 1362, 1366 (Fed. Cir. 2019) (“[A]dministrative agencies possess inherent authority to reconsider

their decisions.”); *AC Techs. S.A. v. Amazon.com, Inc.*, 912 F.3d 1358, 1364-65 (Fed. Cir. 2019) (The Board acted within “its statutory authority when it reconsidered its final written decision and addressed [a] noninstituted ground” after SAS.).

B. The Federal Circuit Correctly Applied “Reasonably Could Have Raised During That Inter Partes Review” In § 315(e)(2).

The decision below correctly held that Thryv “reasonably could have raised” the Dezonno “ground” against Claim 27 “during [the] inter partes review” by asserting this ground in its petition (if the argument had any merit). 35 U.S.C. § 315(e)(2). “Here, claim 27 was ‘included in the petition’ and there is no reasonable argument that Ingenio could not have raised Dezonno against that claim” where Thryv knew about Dezonno and raised it as to 13 other claims in the same petition. *See CTC*, 45 F.4th 1370.

Thryv counterargues this interpretation is wrong because a petition is not an event “during [an] inter partes review” which, in Thryv’s view, begins only *after* institution.⁸ According to Thryv, this clause requires a claim to first be instituted and then the petitioner to take some action to raise a ground against the claim after institution. Because there was no institution of Claim 27 under Freeman, Thryv

⁸ Thryv does not dispute that it knew about Dezonno and it “reasonably could have raised” Dezonno. *See Intuitive Surgical, Inc. v. Ethicon LLC*, 25 F.4th 1035, 1041 (Fed. Cir. 2022) (where petitioner “*actually knew* of the . . . prior art at the time it filed the . . . petition[],” it “reasonably could have” raised the ground under § 315(e)(2)) (emphasis added). What Thryv appears to dispute is only whether raising Dezonno in its petition constitutes raising it “*during* [an] inter partes review.” Pet. at ii.

claims it could not “reasonably have raised” Dezonno against Claim 27 “during” the IPR.

This argument makes no sense. Whether or not the Board instituted review on Claim 27, Thryv never could have raised Dezonno against Claim 27 because it *never challenged Claim 27 under Dezonno in its petition*. Thryv does not dispute that it must raise a claim and the ground(s) against it in the petition to challenge the claim on those grounds during the IPR. See 35 U.S.C. § 312. Nor does Thryv propose any mechanism for newly adding grounds to challenge a claim after institution if those grounds were omitted from the petition, as here. In reality, Thryv has no real stake in the argument it is advancing—that “reasonably” being able to “raise[]” a ground against a claim “during [an] inter partes review” requires the claim first be instituted—where Thryv never challenged Claim 27 under Dezonno in its petition in the first place.

Thryv is also legally wrong. Raising a ground in a petition *does* raise it “during” the IPR. And, correspondingly, what a petitioner “reasonably could have raised during that inter partes review” refers to what a petitioner reasonably could have raised in its *petition*.

To begin, the petition is part of the IPR and initiates the IPR, so raising a ground in the petition in fact raises it “during” the IPR. Nowhere does the statute specify it is referring only to the post-institution period.

But, even if it were, the petition is *still* the mechanism for raising a ground “during [an] inter partes review” after institution. As SAS explained,

“the petitioner’s contentions [in the petition] . . . define the scope of the [IPR] litigation all the way from institution through to conclusion.” 138 S. Ct. at 1357. If a ground is in the petition, then it necessarily is “raised” and litigated “during” the period after institution. *See id.* Of course, a petition may not be instituted, but the provision presumes there is an “inter partes review,” which Thryv argues means a post-institution IPR.

Thryv’s reading also eviscerates part of § 315(e)(2). In arguing a petitioner must take some action *after* institution to “raise” a ground against a claim “during that inter partes review,” Thryv overlooks that the petitioner still has to raise the ground first in its petition. But once a petitioner has done so, the ground *is* “raised” in the IPR. *See id.* This clause targets not just what a petitioner “raised,” however, but what it “reasonably could have raised,” yet did not raise, “during” the IPR. Thryv’s position renders the “reasonably could have raised” language inoperative.

Put in context, the clause—“reasonably could have raised during that inter partes review”—means a petitioner had an effective means to raise a ground “during that inter partes review” and did not use that means. As discussed, the means is the petition, which is both sufficient and necessary for raising grounds against a claim “during” the IPR.

II. THIS CASE IS A POOR VEHICLE FOR REVIEW OF § 315(E)(2).

This case is a poor vehicle for reviewing Thryv’s first question presented on whether a final written decision must include a claim for estoppel to apply. The actual issue is far more context- and fact-specific:

whether Thryv can escape estoppel where it challenged the claim at issue and is now attempting to take advantage of an error in a final written decision that it forewent correcting. This question is also futile. SAS has foreclosed IPR petitioners from ever making an argument like Thryv's because all final written decisions must include all challenged claims and grounds. *See infra* at Section III.A.

This case is also a poor vehicle for reviewing Thryv's second question presented on whether asserting a ground in the petition is sufficient to raise it "during [an] inter partes review." 35 U.S.C. § 315(e)(2). Thryv never relied on this ground to resist estoppel in the district court. App. 15a–16a. At most, it argued fleetingly in the Federal Circuit *in response to Click-to-Call's argument* that institution is not necessary before a petitioner can raise a ground "during [an] inter partes review." App. 28a–29a. Thryv instead was all-in on its formalistic argument that the final written decision excluded Claim 27. *See infra* at Section B.iii–iv.

This forfeiture is made even clearer by the mismatch between Thryv's legal argument and the facts: Thryv is attempting to argue that the Board's failure to institute review on Claim 27 *under Freeman* somehow is significant to whether Thryv "reasonably could have raised" Dezonno as to Claim 27 "during" the IPR. 35 U.S.C. § 315(e)(2). But Thryv could not do the latter because it never made this challenge in its petition. *See infra* at Section I.B. Thryv is merely trying to duplicate the question presented in *Caltech*, No. 22-203, *cert. denied*, in its second question presented, but this issue is not properly teed up or plausible under the facts.

In any case, this Court just denied a petition for certiorari in *Caltech* which sought review on this identical question.⁹ In the decision below, the Federal Circuit cited to *Caltech* in explaining that *Shaw* was overruled and that raising a ground in a petition is sufficient for raising it “during [an] inter partes review.” *CTC*, 45 F.4th at 1370-71. If *Caltech* was not a suitable vehicle for reviewing the issue squarely presented there, certainly this case is not.

III. THIS CASE PRESENTS NO SIGNIFICANT LEGAL ISSUES WARRANTING REVIEW.

A. This Court Has Already Addressed the Partial Institution Problem Animating This Case.

The issue in this case is driven by Board’s erroneous past practice of partial institution. *SAS*, 138 S.Ct. 1348, has now resolved that issue by making clear that partial institutions are not permitted. It also extinguished Thryv’s unusual argument that the improper exclusion of a *challenged* claim from a final written decision forecloses estoppel.

Because this Court has already stepped in and provided the necessary guidance in *SAS*, it need not intervene now. *SAS* made clear that the petition drives the scope of the IPR and the final written decision, and—by necessary implication—estoppel. *Id.* at 1355, 1357. This is because, under § 315(e)(2), estoppel turns on what a petitioner argues or forfeits arguing in the IPR. *SAS* has dissolved the distinctions between what a petitioner argues, what claims are in

⁹ See Jun. 26, 2023 Order List, No. 22-203, available at https://www.supremecourt.gov/orders/courtorders/062623zor_7m58.pdf.

the IPR, and what a Board decides, for purposes of estoppel. 35 U.S.C. § 315(e)(2).

Nor is there a large class of cases like this one, *i.e.*, where an IPR was partially instituted pre-SAS, the final written decision did not address certain claims challenged in the IPR, the petitioner did not ask the Board to provide a final written decision addressing all grounds, and estoppel is being applied with respect to a ground that the petitioner knew about but waived by not including it in its petition. Although SAS was decided 5 years ago, this case appears to be the first in this posture coming up in the Federal Circuit. Since 2018, SAS has foreclosed the possibility of any cases with this posture.

B. This Case Does Not Create Any Inconsistency in Federal Circuit Precedent.

Thryv attempts to drum up conflicts between this case and controlling Federal Circuit precedent. There are none.

Thryv complains the decision below is in conflict with pre-SAS Federal Circuit precedent, *Shaw*, 817 F.3d 1293, and *Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1316 (Fed. Cir. 2016). Pet. at 4–5. But this is necessarily so. Those cases were inconsistent with SAS. The decision below *is* consistent with SAS and is part of the effort by the Federal Circuit to harmonize its cases with SAS.

Shaw was overruled *because* of SAS. *Shaw* had held that “grounds raised in a petition (or that reasonably could have been raised in a petition) were necessarily not raised during the IPR.” 817 F.3d at 1300. It reasoned that, because the Board controlled what claims and grounds were instituted, raising a

ground in a petition was not sufficient to bring it into the IPR. *See id.* Plainly, this was wrong after *SAS*. As the Federal Circuit explained in overruling *Shaw*: “Given the statutory interpretation in *SAS*, any ground that could have been raised in a petition is a ground that could have been reasonably raised ‘during inter partes review.’ Thus, the Supreme Court’s later decision in *SAS* makes clear that *Shaw* . . . cannot be sustained.” *Caltech*, 25 F.4th at 990–91.

The same logic applies to *Synopsys*. *Thryv* cites *Synopsys* for its statement that “[t]he validity of claims for which the Board did not institute inter partes review can still be litigated in district court.” Pet. at 4-5 (quoting *Synopsys*, 814 F.3d at 1316). *Synopsys*, however, is making this point specifically about *challenged* claims which were not instituted under partial institution. As *SAS* has now made clear, all challenged claims must be addressed in the final written decision and are part of the IPR. The discussion in *Synopsys* from which *Thryv* quotes is obviously untenable because it directly contradicts this *SAS* principle: “*Synopsys* argues that, because § 318(a) directs the Board to issue a final written decision with respect to ‘any patent claim challenged by the petitioner,’ *the Board’s final decision must address every claim raised in the petition. However, the statute cannot be read to impose such a requirement* The validity of claims for which the Board did not institute inter partes review can still be litigated in district court.” *Synopsys*, 814 F.3d at 1315–16 (emphasis added).

Thryv also claims that the decision below is at odds with *Intuitive Surgical*, 25 F.4th at 1035. There, the Federal Circuit characterized that estoppel applies on

a “claim-by-claim basis.” But that is exactly what the Federal Circuit said below and directly quoted *Intuitive Surgical* in saying so: “It is true that § 315(e) estoppel applies on a ‘claim-by-claim basis.’ *Intuitive*, 25 F.4th at 1042.” *CTC*, 45 F.4th at 1369. The decision below correctly applied estoppel in a claim-by-claim analysis by recognizing that the IPR included Claim 27, the IPR concluded in a final written decision, and estoppel attached as to Claim 27.

C. This Case Has Little Impact on Parties In Inter Partes Review.

The facts of this case are highly unusual, unlikely to recur, and turn on an IPR decided pre-*SAS* and not corrected post-*SAS*. The Federal Circuit was careful to cabin its holding to these unique circumstances. The decision below has limited applicability beyond itself and does not warrant further review.

Thryv warns this case will make IPRs much more burdensome because “petitioners must now put up all arguments against all claims or risk estoppel as to unchallenged claims.” Pet. at 17. This is completely wrong and *not* the implication of the decision below by a long shot. All this case reinforces is that, where a party does choose to challenge a given claim, it should diligently raise any *grounds* (or at least the best grounds) against that claim that it can reasonably identify in its petition. See *CTC*, 45 F.4th at 1370 (“[E]stoppel 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.*”) The petitioner still controls *which* claims and how many to raise in its IPR. Thryv’s own citation

establishes this: “A petitioner may . . . file multiple petitions where each petition focuses on a separate, manageable subset of the claims to be challenged.” *Intuitive Surgical*, 25 F.4th at 1041.

Throughout its petition, Thryv inaccurately argues that, “[u]nder the Federal Circuit’s new rule [in the decision below], . . . petitioners may be estopped based on unchallenged claims that could have been addressed in the petition and IPR.” Pet. at 17. Thryv even argues the decision below exceeds *Caltech*’s principle that estoppel applies “to ‘all grounds not stated in the petition but which reasonably could have been asserted against the claims included.’” *Id.* at 15.

Thryv misrepresents that the decision below holds it accountable for an “unchallenged claim[.]” *Id.* at 17. The Federal Circuit is in fact holding that Thryv is estopped as to a claim (Claim 27) that it *did* challenge and for which it never raised Dezonno in the IPR. This case is consistent with *Caltech*’s principle, which is obvious from the full quote in *Caltech*: “[E]stoppel 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.*” *Caltech*, 25 F.4th at 991 (emphasis added). Here, the Federal Circuit properly limited estoppel to the “claims included in the petition,” i.e., including Claim 27.

Thryv’s general complaint that this decision shifts focus away from institution and to the petition is not a principle that originated below. Rather this is the fundamental principle of *SAS*. *SAS* made clear the primacy of the petition, not institution, for setting the scope of the IPR. 138 S. Ct. at 1355-56. The Federal

Circuit acted consistently with that dictate. Thryv's attempts to turn back the clock to the pre-SAS order are unjustified.

CONCLUSION

The petition should be denied.

Respectfully submitted,

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JUNE 26, 2023

APPENDIX

1a

Appendix A

**UNITED STATES PATENT
AND TRADEMARK OFFICE**

**BEFORE THE PATENT TRIAL
AND APPEAL BOARD**

ORACLE CORPORATION;
ORACLE OTC SUBSIDIARY LLC;
INGENIO, LLC.; and
YELLOWPAGES.COM LLC;

Petitioner

—v.—

CLICK-TO-CALL TECHNOLOGIES LP

Patent Owner

Patent No. 5,818,836

Issued: October 6, 1998

Filed: August 9, 1995

Inventor: Stephen C. DuVal

Title: Method and Apparatus for Anonymous Voice
Communication Using An Online Data Service

CASE IPR: Unassigned

**PETITION FOR INTER PARTES REVIEW OF
U.S. PATENT NO. 5,818,836 UNDER 35 U.S.C.
§§ 311-319 AND 37 C.F.R. §§ 42.1-80, 42.100-123**

2a

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II. IDENTIFICATION OF CHALLENGE

In accordance with 35 U.S.C. § 311 and 37 C.F.R. § 42.104(b), *inter partes* review of claims 1, 2, 8, 12-13, 15-16, 18-19, 22-24, and 26-30 of the '836 patent is requested in view of the following grounds:

A. Claims 1, 2, 12, 13, 19, 22-23 and 29-30 are invalid under 35 U.S.C. § 102(e) as anticipated by, or alternatively under 35 U.S.C. § 103 as obvious over, U.S. Pat. No. 5,991,394 to Dezonno et al. (“Dezonno”) (Exhibit 1002).

B. Claims 8 and 15-16 are invalid under 35 U.S.C. § 103 as obvious over Dezonno.

C. Claims 22 and 29 are invalid under 35 U.S.C. § 103 as obvious over Dezonno in view of U.S. Pat. No. 5,870,552 to Dozier et al. (“Dozier”) (Exhibit 1003) or Dougherty and Koman, The Mosaic Handbook (1st ed. October 1994) (“Mosaic Handbook”) (Exhibit 1004).

D. Claims 1, 2, 8, 12-13, 15-16, 18-19, 22-24, and 26-30 are invalid under 35 U.S.C. § 103 as obvious over U.S. Pat. No. 5,428,608 to Freeman et al. (“Freeman”) (Exhibit 1005) in view of Lewis, *Attention Shoppers: Internet is Open*, N.Y. Times August 12, 1994 (“Attention Shoppers”) (Exhibit 1006).

E. Claims 8 and 15-16 are invalid under 35 U.S.C. § 103 as obvious over Freeman in view of Lewis and U.S. Pat. 4,796,293 to Blinken et al. (“Blinken”) (Exhibit 1016).

F. Claims 1, 2, 8, 12-13, 15-16, 18-19, 22-24, 26 and 29-30 are invalid under 35 U.S.C. § 103 as obvious over Freeman in view of Benedikt, ed.,

CyberSpace: First Steps (1991) (“Cyberspace”) (Exhibit 1012) and Krol, The Whole Internet 1991 (Exhibit 1013) (“Whole Internet”).

* * *

VIII. CONCLUSION

For the foregoing reasons, Petitioner requests that Trial be instituted and claims 1, 2, 8, 12-13, 15-16, 18-19, 22-24 and 26-30 be cancelled.

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Appendix B

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Paper 26

Entered: October 30, 2013

UNITED STATES PATENT
AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL
AND APPEAL BOARD

ORACLE CORPORATION;
ORACLE OTC SUBSIDIARY LLC;
INGENIO, LLC.; and
YELLOWPAGES.COM LLC;

Petitioners

—v.—

CLICK-TO-CALL TECHNOLOGIES LP

Patent Owner

Case IPR2013-00312
US Patent No. 5,818,836

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

ZECHER, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Oracle Corporation, Oracle OTC Subsidiary LLC, Ingenio, LLC, and Yellowpages.com LLC (“Petitioners”) filed a petition (“Pet.”) requesting *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 (“the ‘836 patent”). Paper 1. Click-to-Call Technologies LP (“Patent Owner”) filed a preliminary response (“Prelim.Resp.”). Paper 14. We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides:

THRESHOLD—The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

For the reasons set forth below, we conclude that the information presented in the petition establishes that there is a reasonable likelihood that Petitioners will prevail in challenging claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 as unpatentable. However, we conclude that the information presented in the petition does not establish that there is a reasonable likelihood that Petitioners will prevail in challenging claims 18, 24, 27, and 28 as unpatentable. Pursuant to 35 U.S.C. § 314, we hereby authorize an *inter partes* review to be instituted only

as to claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the '836 patent.

* * *

4. Analysis

As discussed above, Freeman discloses that, depending on the context of the user's request, the application retrieves the telephone number of a person best suited to help the user. Ex. 1005, 13:24-27. Next, Freeman indicates that the application instructs the adjunct controller to establish a voice connection with the retrieved telephone number through a CSN. Ex. 1005, 13:35-40. After a voice connection is established between the user and the retrieved telephone number, Freeman discloses that the user is alerted to the existence of the voice connection. Ex. 1005, 13:45-48.

Based on these cited disclosures, we agree with Patent Owner that Freeman establishes a single voice connection, i.e., telephone call, between the user and the person best suited to help the user. There is no indication that Freeman's SVD system establishes a first telephone call with the user, establishes a second telephone call with the person best suited to help the user, and then bridges the connection between the first and second telephone calls. As such, we are not persuaded that Petitioners have presented sufficient evidence to support a finding that Freeman teaches the following claim limitations: (1) "establishing a first telephone call for the first party," "establishing a second telephone call for the second party," and "connecting said first telephone call with said second telephone call," as recited in independent claim 1; and (2) "[the] voice system . . . connects a

first telephone call of the first party with a second telephone call of the second party in response to the connect command,” as recited in independent claim 12.

Based on the record before us, Petitioners have not demonstrated a reasonable likelihood of prevailing on their assertion that independent claims 1 and 12 are unpatentable based in part on Freeman. Claims 2, 8, 22-24, 26, and 27 directly or indirectly depend from independent claim 1, and claims 13, 15, 16, 18, 19, and 28-30 directly or indirectly depend from independent claim 12. For the same reasons discussed above with respect to independent claims 1 and 12, Petitioners have not demonstrated a reasonable likelihood of prevailing on their assertion that dependent claims 2, 8, 13, 15, 16, 18, 19, 22-24, and 26-30 are unpatentable based in part on Freeman.

IV. CONCLUSIONS

For the foregoing reasons, we conclude that the information presented in the petition establishes that there is a reasonable likelihood that Petitioners would prevail in showing that claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are unpatentable. However, we conclude that the information presented in the petition does not establish that there is a reasonable likelihood that Petitioners will prevail in challenging claims 18, 24, 27, and 28 as unpatentable.

* * *

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Appendix C

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

Civil Action No. 1:12-cv-00465-LY

JURY TRIAL DEMANDED

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.

**DEFENDANTS' MOTION FOR SUMMARY
JUDGMENT OF INVALIDITY**

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C. Thryv Is Not Estopped from Challenging Validity.

CTC may attempt to argue that Thryv itself is estopped from challenging the validity of the claims it asserts. Such an argument has no merit, as the judgment of the courts in *Intellectual Ventures* and *Chrimar Systems, supra*, establish. Indeed, because claim 27 was not subject to the FWD, no estoppel attaches. The same, of course, holds true for claims 24 and 28, if they are even deemed part of this case.

What is commonly referred to as IPR estoppel only attaches to challenges to validity of claims which were the subject of review during an IPR and addressed in the final written decision. 35 U.S.C. § 315(e)(2) (“[R]eview of a *claim* in a patent under this chapter that results in a final written decision. . . .” (emphasis added)). The statute makes clear that the “results in a final written decision” is with regard to a specific claim, and not the patent as a whole, because § 315(e)(2) refers to § 318(a) which reads “[i]f an inter partes review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any *patent claim* challenged by petitioner.” (emphasis added).

IPR estoppel thus focuses on whether the *claim* was adjudicated invalid or not. This is consistent with how the Federal Circuit applied estoppel in *Shaw*. In *Shaw*, the petition was not instituted and thus no FWD was issued as to any claim. 817 F.3d at 1300. Because no IPR was conducted on those claims, no estoppel attached to the grounds raised by the petitioner. *Id.*; see also *Synopsys, Inc. v. Mentor*

Graphics Corp., 814 F.3d 1309, 1316 (Fed. Cir. 2016) (“The validity of claims for which the Board did not institute inter partes review can still be litigated in district court.”).

There is no dispute that claim 27 was not a part of the FWD. The same is true for claims 24 and 28. The PTAB made clear which claims were subject to the IPR in note 3 of the FWD. Ex. C, p. 8 n.3. Because claim 27, as well as 28 and 24, were not part of the FWD, Thryv is not estopped from asserting they are invalid as anticipated by Dezonno.

V. Conclusion

Claim 27, as well as 28 and 24, add menial, nonsubstantive, and certainly old aspects to already invalid claims. Both collateral estoppel and the prior art Dezonno patent independently confirm that CTC’s effort to assert such claims fails as a matter of law. Because the issue has been litigated and because Dezonno expressly teaches both advertising and text in addition to every element of claim 1 and 12, this Court should find invalid claim 27, and to the extent still in the case, claims 28 and 24.

Respectfully submitted, this 20 of October, 2020.

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Appendix D

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

Civil Action No. 1:12-cv-00465-LY

JURY TRIAL DEMANDED

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.

REPLY IN SUPPORT OF DEFENDANTS'
MOTION FOR SUMMARY JUDGMENT
OF INVALIDITY

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II. Thryv Is Not Estopped Under the Statutory Estoppel Provisions.

CTC's entire argument about why Thryv is supposedly estopped simply ignores the statute and applies cases dealing with drastically different issues. In fact, nowhere does CTC address the language of the statute. Dkt. 195, p. 16-18. 35 U.S.C. § 315(e) does not attach estoppel simply to the assertions of invalidity (the "grounds" on which an invalidity assertion is made). Rather, the statute attaches estoppel only to assertions of invalidity of a given *patent claim* that reaches final adjudication based on prior art that was or could have been asserted. If the claim was not finally adjudicated – i.e., was not part of the final written decision – no estoppel ever attaches. CTC's cases do not suggest otherwise because the statute is clear.

In its Opening, Thryv cited numerous cases where defendants were not estopped from asserting the same grounds of validity – on which the defendant was successful in the IPR – against different claims in district court. Dkt. 194, p. 17. CTC ignored these cases, but they are dispositive on the issue of whether Thryv is estopped.

CTC argues that the "reasonably could have been raised" language somehow salvages its position, but preclusion of those bases (grounds) again only attaches if the *claims at issue were subject to a final written decision*. CTC's analysis of *Shaw* and its post-SAS progeny simply cannot overcome the statute's clear statement that estoppel attaches to a "petitioner in an inter partes review of a *claim* in a patent under this chapter that *results in a final*

written decision.” 35 U.S.C. § 315(e)(2) (emphasis added). The cases on page 16 of CTC’s Response focus on estopping defendants from asserting specific bases of invalidity (grounds) that it could have raised against *claims that were fully litigated* before the PTAB. But there is no dispute claims 27, 28, and 24 were not so litigated. Indeed, each of CTC’s cases clearly notes that the *ground* for invalidity is barred because a final decision on the *claim* had occurred.⁵

Thus, CTC’s effort to ignore the statute and use of the word “ground” when the issue before the Court concerns “claims” should be rejected and summary judgment granted.

⁵ See *Douglas Dynamics, LLC v. Meyer Prods. LLC*, 2017 WL 1382556, at *5 (W.D. Wis. Apr. 18, 2017) (*permitting* the defendant to assert grounds of invalidity against a claim not subject to the final written decision – claim 6); *Milwaukee Elec. Tool Corp. v. Snap-on Inc.*, 271 F. Supp. 3d 990, 1028 (E.D. Wis. 2017) (focusing solely on whether the ground was raised because all claims were at issue in the IPR); *SiOnyx, LLC v. Hamamatsu Photonics K.K.*, 330 F. Supp. 3d 574, 601 (D. Mass. 2018) (applying estoppel to claims not addressed because the petitioner failed to seek reconsideration of those claims as per the Federal Circuit’s requirement); see also *Clearlamp, LLC v. LKQ Corp.*, 2016 WL 4734389, at *8 (N.D. Ill. Mar. 18, 2016) (a petitioner is estopped “from asserting that a *claim* is unpatentable during *inter partes* review on any *ground.*”) (emphasis added)).

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Respectfully submitted, this 24th day of November,
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Appendix E

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

No. 2022-1016

CLICK-TO-CALL TECHNOLOGIES LP,

Plaintiff-Appellant

—v.—

INGENIO, INC., dba KEEN, ETHER, THRYV, INC.,

Defendants-Appellees

On Appeal from the United States District Court
For the Western District of Texas
The Honorable Judge Yeakel
1:12-cv-00465-LY

**CORRECTED RESPONSE BRIEF
FOR DEFENDANTS-APPELLEES**

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2015); *Wills v. Arizon Structures Worldwide, L.L.C.*, 824 F.3d 541, 545 (5th Cir. 2016). The trial court's denial of CTC's motion for leave to amend claim selections and its interpretation of local patent rules are reviewed for abuse of discretion. *See O2 Micro Int'l Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1366-67 (Fed. Cir. 2006).

B. The District Court Correctly Granted Summary Judgment on Dezonno's Anticipation of Claim 27.

The district court's grant of summary judgment of invalidity was correct and well-reasoned. CTC identifies no legitimate error by the district court, and instead continues to pursue factually and legally unsound arguments that were appropriately rejected below. Accordingly, the district court's judgment should be upheld.

1. *The district court correctly found that IPR estoppel did not apply to Claim 27, as it was not part of the PTAB's Final Written Decision.*

IPR estoppel applies only to the specific patent claims on which an IPR was instituted and a final written decision was reached. The text of the statute itself—when read in its full context rather than the disjointed snippets CTC provides—makes this abundantly clear:

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) . . . may not assert either in a civil action . . . 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). The statute thus expressly states that IPR estoppel applies on a ***claim-by-claim*** basis. It does not apply to ***claims*** which were never subject to a final written decision.

This is also consistent with this Court’s decision in *Shaw Indus. Grp., Inc. v. Automated Creel Sys., Inc.*, 817 F.3d 1293, 1300 (Fed. Cir. 2016), which found that, because the IPR did not begin until it was instituted, the relevant inquiry for estoppel is what was considered after, not before, institution. *See also Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1316 (Fed. Cir. 2016) (“The validity of claims for which the Board did not institute inter partes review can still be litigated in district court.”), *overruled on other grounds*.

There can be no dispute that Claim 27 was not considered in the IPR and was not part of the PTAB’s Final Written Decision. *See* Appx1572 (“[T]he Board instituted this proceeding on October 30, 2013, only as to these claims [1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30] of the ’836 patent This decision is a final written decision under 35 U.S.C. § 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.”). Accordingly, Claim 27 is not subject to IPR estoppel, as review was not instituted on that claim, and there was no final written decision on that claim, as required by the statute.

Ultimately, CTC’s argument boils down to the fact that Thryv could have raised the invalidity of Claim 27 in light of Dezonno in its IPR ***petition***. *See* Appellant Br. at 14 (“Ingenio unquestionably

could have raised the argument that Dezonno anticipates claim 27 in its IPR petition.”) (emphasis added). But the statute focuses on the IPR itself, which only begins *after* institution. See *Shaw*, 817 F.3d at 1300 (“Both parts of § 315(e) create estoppel for arguments ‘on any ground that the petitioner raised or reasonably could have raised *during* that inter partes review.’ . . . The IPR does not begin until it is instituted.”). As in *Shaw*, where the defendant could not have raised a ground for invalidity that had not been instituted during the IPR, Thryv could not have raised the validity of Claim 27 (based on Dezonno or otherwise) during the IPR when review of Claim 27 was not instituted. See *id.* After the IPR was instituted, there was no means by which Thryv could have raised the invalidity of Claim 27 during the IPR. Accordingly, there is no way Thryv “reasonably could have raised” the invalidity of Claim 27 under Dezonno during the IPR, as required by 35 U.S.C. § 315(e)(2), and IPR estoppel does not apply.

As it did below, CTC attempts to skirt this clear law, based on what it posits would have happened *if* Thryv’s petition had been filed after the Supreme Court’s decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1354 (2018). See Appellant Br. at 17. CTC claims that, had SAS applied when its IPR was filed, instituted, and decided, two things might have happened differently. First, the PTAB would have instituted on all claims brought in the petition, including Claim 27, which was included in the petition on different grounds. Second, the PTAB would have reached a final written decision on Claim 27, rejecting Thryv’s alternative ground for invalidity at that stage rather than at the petition stage.

Under this hypothetical, CTC claims that Thryv would then have been unquestionably estopped from

asserting that Dezonno invalidates Claim 27 in the district court. *Id.* at 16-17. According to CTC, because Thryv would have been estopped in this hypothetical scenario, it should be estopped in this case, despite none of these hypothetical facts actually occurring in the real world. *Id.* at 17.

Setting aside whether the hypothetical scenario CTC posits is even correct,¹ on the actual facts, Claim 27 was *not* part of the IPR or the final written decision and therefore Thryv is *not* estopped under the statute. This Court should reject CTC's invitation to decide this issue on hypotheticals instead of the actual facts that are before this Court. Because statutory IPR estoppel applies only to claims that were actually considered by the PTAB during the IPR and addressed in a final written decision, the district court correctly decided that Thryv was not estopped from asserting the invalidity of Claim 27 based on Dezonno.

* * *

¹ It is equally likely the PTAB would have rejected the entire petition instead of instituting the entire petition in the post-SAS world. Additionally, Thryv's filing strategy may have been different post-SAS and a different petition entirely may have been filed.

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DATED: January 19, 2022

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