

No. _____

In the Supreme Court of the United States

DOLBY LABORATORIES LICENSING CORPORATION,
Petitioner,

v.

UNIFIED PATENTS, LLC,
Respondent.

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

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

To discourage unnecessary litigation and protect patent owners' rights, the America Invents Act requires a petition for inter partes review to identify "all real parties in interest" both "to the patent owner" and "to the public." 35 U.S.C. § 312(a)-(b). When a real party in interest is named to a petition, estoppel attaches to that entity, precluding it from bringing certain further challenges to the patent. § 315(e).

Notwithstanding the statutory text, the Federal Circuit concluded that patent owners have no right to know all real parties in interest to petitions brought against them and suffer no injury from deprivation of that information. It also held that § 314(d), which renders the Director's determination whether to institute an inter partes review "final and nonappealable," bars review of final written decisions concerning real parties in interest. In so doing, the Federal Circuit failed to cite or discuss this Court's contrary decision in *SAS Inst., Inc. v. Iancu*, which held that "nothing in § 314(d)" withdraws judicial authority "to ensure that an inter partes review proceeds in accordance with the law's demands." 584 U.S. 357, 371 (2018).

The questions presented are:

1. Whether a patent owner is injured by the Patent Trial and Appeal Board's refusal to require a petition to identify all real parties in interest.

2. Whether § 314(d) bars judicial review of a final decision regarding real parties in interest.

PARTIES TO THE PROCEEDING

Petitioner is Dolby Laboratories Licensing Corp. (NYSE: DLB), which was appellant before the Federal Circuit and patent owner before the Patent Trial and Appeal Board.

Respondent is Unified Patents, LLC, which was appellee before the Federal Circuit, and petitioner before the Patent Trial and Appeal Board.

Additional Respondent is John A. Squires, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, who was represented by then-Acting Director Coke Morgan Stewart as an intervenor before the Federal Circuit.

RULE 29.6 STATEMENT

Petitioner Dolby Laboratories Licensing Corporation (a New York corporation) is a wholly-owned subsidiary of Dolby Laboratories, Inc. (a California corporation), which is a wholly-owned subsidiary of Dolby Laboratories, Inc. (a Delaware corporation), a publicly held company.

RELATED PROCEEDINGS

The proceedings below are:

Patent Trial and Appeal Board:

Unified Patents, LLC v. Dolby Laboratories Licensing Corp., IPR No. 2021-00275

Federal Circuit:

Dolby Laboratories Licensing Corp. v. Unified Patents, LLC, No. 23-2110 (June 5, 2025), *reh'g denied* (September 23, 2025)

Petitioner is unaware of any other related cases.

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INTRODUCTION

Congress enacted the America Invents Act (AIA) “to balance the competing interests” inherent in the patent system. H.R. Rep. No. 112-98, pt. 1, at 40 (2011). To underscore “the importance of quiet title” and to discourage challengers from using the inter partes review (IPR) process as a “tool[] for harassment,” Congress included important protections for patent owners. *Id.* at 48. Section 312 provides that a petition for inter partes review “may be considered *only* if ... the petition identifies *all* real parties in interest.” § 312(a)(2) (emphasis added). This requirement has consequences; any named real party in interest is estopped from raising similar challenges to the patent in a subsequent inter partes review petition or civil action. § 315(e).

Section 312(a)(2)’s “all real parties in interest” identification requirement is thus necessary to protect patent owners from serial litigation. Those seeking inter partes review need not have Article III standing; rather, *any* individual or entity can file a petition with no actual or anticipated threat of injury to itself from the patent it seeks to invalidate. *See Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 279 (2016) (“Parties that initiate the proceeding ... may lack constitutional standing.”). This scheme invites “reverse patent troll[s]”—“nonpracticing entit[ies] that seek[] to invalidate a patent” by filing an inter partes review petition on behalf of their clients while employing a “shielded business model, so that the patentee cannot readily prove that the clients amount to [real parties in interest].” Jordan Garsson, *Real Parties in Interest: The Problem with RPIs in IPRs*, 30 Tex. Intel. Prop. L. J.

315, 334 (2022). By remaining unnamed, the hidden real parties in interest avoid being identified and thus avoid the estoppel provisions of § 315(e) formally attaching against them.

Petitioner Dolby is a publicly traded American company headquartered in San Francisco with more than 1,000 employees in the United States and over 2,000 employees worldwide. Since its founding in 1965 by inventor Ray Dolby, Dolby has pioneered innovations in audio and image signal processing and compression technologies, enabling more immersive experiences for cinema, television, mobile devices, streaming, and home entertainment.

Respondent Unified Patents, LLC, is a nonpracticing, for-profit, membership-based entity that files IPR petitions to benefit its paying customers. Although Unified has filed more than 200 IPRs, it has never named a single member-customer as a real party in interest to any of its petitions. Notably, Unified has admitted it filed the IPR petition below without any threat or concern of infringement or royalty obligations of its own. Instead, it brought the petition only to further the interests of its unnamed customers.

Before the Patent Trial and Appeal Board, Dolby demonstrated the patentability of the challenged patent, U.S. Patent 10,237,577, which improves complex video encoding methods to reduce error and increase compression efficiency. Dolby also presented extensive evidence that Unified is not the sole real party in

interest to the petition, and that nine other entities¹ are unnamed real parties in interest. Dolby asked the Board to name those entities to the IPR so that Dolby could establish quiet title against them.

The Board’s final written decision upheld the patentability of the ’577 patent, but refused to reach any determination on the real parties in interest, despite § 312(a)(2)’s statutory requirement. The Board thus denied Dolby the full scope of the estoppel benefit it had obtained by successfully defending its patent. The Federal Circuit denied Dolby’s appeal, holding that a patent owner is not injured by an incomplete identification of the real parties in interest acting against it, and that § 314(d) separately bars review.

In so doing, the Federal Circuit gutted the protections Congress guaranteed patent owners under § 312(a)(2). Its decision erects artificial barriers that are inconsistent with the statute’s text, structure, and history. And those barriers contravene this Court’s and other federal appeals courts’ treatment of right to information standing. Under this Court’s precedents, a showing that “the alleged information deficit hindered” the plaintiff’s ability to use that information suffices to establish injury in fact. *TransUnion v. Ramirez*, 594 U.S. 413, 442 (2021). But the Federal Circuit ignored Dolby’s showing that its informational injury here impairs its statutorily guaranteed estoppel rights and thus exposes it to unwarranted future costs. Nor did it address that the deprivation of this

¹ The names of these entities and the evidence of their interests were sealed below, provided only to Dolby’s outside counsel.

information hinders Dolby’s investigation as to bringing infringement suits against the nine entities, as well as Dolby’s future licensing discussions with them.

The Federal Circuit’s application of § 314(d)’s appeal bar to insulate judicial review of the proceeding also flouts the statutory text and this Court’s precedents. By its own terms, § 314(d) is limited to the Director’s decision “whether to institute” a review. This Court has held that § 314(d) does not “withdraw[]” judicial authority “to ensure that an inter partes review proceeds in accordance with the law’s demands.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 371 (2018). Where, as here, an appeal challenges “the manner in which the agency’s review ‘proceeds’ once instituted,” not “whether the agency should have instituted review at all,” § 314(d) cannot bar review. *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 58 (2020). The Federal Circuit did not cite or even discuss this Court’s decisions in concluding otherwise.

If left uncorrected, the decision below will vitiate the quiet title protection Congress afforded patent owners and disrupt the careful balance Congress struck in crafting the AIA. As Congress explained, allowing “repeated ... administrative attacks on the validity of a patent” would “frustrate the purpose of the [AIA] as providing quick and cost effective alternatives to litigation” and would wrongly “divert resources from the research and development of inventions.” H.R. Rep. No. 112-98, pt. 1, at 48 (2011). Certiorari is warranted.

OPINIONS BELOW

The Federal Circuit’s opinion is reported at 138 F.4th 1363 and is reproduced at App.1a-9a. Its order denying rehearing by the panel and en banc is unreported and is reproduced at App.10a-12a. The Patent Trial and Appeal Board’s final written decision below is unreported and reproduced at App.13a-55a.

JURISDICTION

The Federal Circuit entered judgment on June 5, 2025, and denied a petition for rehearing by the panel and en banc on September 23, 2025. Chief Justice Roberts extended the time to file this petition until February 20, 2026. *See Dolby Laboratories Licensing Corporation v. Unified Patents, LLC*, No. 25A713. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Relevant provisions of the AIA, 35 U.S.C. §§ 312, 314, and 315, are reproduced at App.64a-69a.

STATEMENT OF THE CASE

A. Statutory Background

The AIA provides that a petition for inter partes review “may be considered only if ... the petition identifies all real parties in interest.” 35 U.S.C. § 312(a)(2). The statute separately requires the petitioner to accurately and completely disclose real parties in interest “to the patent owner.” § 312(a)(5). Congress added § 312(a)(5) to ensure that patent owners receive “the same identification of any real parties in interest or privies that is provided to the [Patent] Office.” 157

Cong. Rec. S1375 (Mar. 8, 2011) (statement of Sen. Kyl). The statute further requires that the petition be made “available to the public,” § 312(b), along with the entire “file” of an inter partes review proceeding, § 316(a).

Naming all real parties in interest to a petition helps ensure that those parties cannot directly or indirectly mount repeated challenges to the same patent. A petition “that results in a final written decision” estops any real party in interest from “request[ing] or maintain[ing]” further challenges before the Patent Office that a petitioner already “raised or reasonably could have raised” as to that patent during the review proceeding. § 315(e)(1). And it further estops any real party in interest “in a civil action” or before the International Trade Commission from asserting invalidity against the patent on “any ground” that the petitioner already “raised or reasonably could have raised.” § 315(e)(2). Section § 312(a)(2)’s real parties in interest disclosure requirement thus reflects Congress’s desire to provide patent owners with “quiet title,” and to protect them against “harassment.” H.R. Rep. No. 112-98, pt. 1, at 48 (2011).

B. Factual Background

Respondent Unified Patents is among the most prolific filers of inter partes review petitions before the Patent and Trademark Office. In fact, Unified’s “primary activity” is “filing IPRs.” *Unified Patents v. American Patents*, IPR2019-00482, Paper 115 at 41 (Aug. 13, 2020). Unified files IPRs to invalidate patent threats to members or to obtain licenses to the challenged patents for its members. ECF 52, Appendix

Vol. I at 3755, 3703-3706. And Unified’s member-customers fund every Unified IPR. *Id.* at 3726.

On December 11, 2020, Unified filed an IPR petition challenging Dolby’s U.S. Patent 10,237,577 (the ’577 patent)—which improves complex video encoding methods to reduce error and increase compression efficiency—as unpatentable in view of the prior art. App.19a. In doing so, Unified certified that it was the sole real party in interest to the petition—a core pillar of its business strategy. App.2a. But Unified later admitted that it did not file the IPR petition out of a concern of infringement or royalty obligations to itself, but as part of its strategy on behalf of its member-customers. ECF 52, Appendix Vol. I at 3668-3671.

In response, Dolby expended significant effort and incurred substantial costs to gather and present detailed evidence that Unified is not the sole real party in interest to the petition. Dolby showed that nine Unified members should also be named as real parties in interest to the proceeding under the prevailing legal standards.² App.2a. Notably, Dolby did *not* ask the Board to terminate the proceeding or otherwise disturb its decision to institute review. Rather, Dolby asked the Board to require, in its final written

² The Board’s precedent provides that where members pay subscription fees to a for-profit organization to reduce their patent exposure, and the organization files an IPR “despite having no apparent risk of infringement liability itself, ... equitable and practical considerations point clearly towards” finding such members to be real parties in interest to the petition. *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 at 32 (Oct. 2, 2020) (precedential) (cleaned up).

decision, that the nine entities at issue be named as real parties in interest to the proceeding. App.17a.

C. Proceedings Below

On June 15, 2022, the Board issued a final written decision, ruling in Dolby's favor on the patentability of the '577 patent. But the Board refused to determine whether Unified had met its obligation to "identif[y] all real parties in interest" under § 312(a)(2). App.15a, 17a-18a. In doing so, the Board did not address or rely on the statute's text. Instead, citing concerns about "cost and efficiency," the Board held that it need not resolve disputes over the real party in interest that do not implicate issues of time bar or estoppel in the *current* proceeding. App.3a, 17a-18a (citing *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00735, Paper 11 at 18-20 (Oct. 6, 2020)). In other words, the Board unilaterally amended § 312(a)(2) to require disclosure of *only those* real parties in interest *that may be time barred or estopped in the current proceeding*. App.17a-18a. The Board failed to explain why it would have been costly or inefficient to render a determination on a fully developed record. Nor did the Board consider the harms to Dolby from a decision that failed to establish estoppel rights going forward against the nine entities at issue, and that hindered Dolby's ability to inform its future commercial and legal conduct vis a vis those nine entities.

On appeal, the Federal Circuit concluded that Dolby "failed to establish an injury in fact sufficient to confer Article III standing." App.9a. While acknowledging that this Court has recognized statutory

information rights in “cases involving ‘public-disclosure or sunshine laws that entitle all members of the public to certain information,’” App.5a (quoting *TransUnion*, 594 U.S. at 441), the court held that “the AIA does not create an informational right.” App.7a. Relying heavily on its view of the AIA’s purported singular “purpose,” App.6a, the court glossed over the logical starting point: the AIA’s text. The decision gave no weight to the fact that §§ 312(b) and 316(a) entitle all members of the public access to the petition and proceedings, including the identities of all real parties in interest as required by § 312(a)(2). App.5a-7a. And it similarly disregarded the statutory language requiring that the petitioner disclose all real parties in interest *directly* “to the patent owner.” § 312(a)(5). As for the AIA’s legislative purpose, the Federal Circuit further disregarded Congress’s statement that depriving patent owners of “quiet title” and exposing them to “harassment” would “frustrate the purpose of the section as providing quick and cost effective alternatives to litigation” and improperly “divert resources from the research and development of inventions.” H.R. Rep. No. 112-98, pt. 1, at 48 (2011).

Nor did the court engage with this Court’s relevant precedents. The Federal Circuit emphasized that the AIA contains no “special statutory cause of action” for adjudicating disputes over the real party in interest. App.6a. But this Court has recognized statutory informational standing where the underlying statute did *not* include a private right of action. *Public Citizen v. U.S. Dep’t of Justice*, 491 U.S. 440, 449-50 (1989). And this Court has never held that a “special statutory cause of action” is a prerequisite to a statutory

right of information. The Federal Circuit’s analysis disregarded the holdings of this Court.

Separately, the Federal Circuit relied upon § 314(d)’s appeal bar to conclude that the AIA precludes “judicial review of ... decisions concerning the RPI requirement under 35 U.S.C. § 312(a)(2).” App.6a. But once again, the court did not address Dolby’s showing that it did not seek to disturb the Board’s decision to institute review—only its failure to identify the real parties in interest post-institution, as part of its final written decision. App.17a. And the Federal Circuit simply ignored this Court’s prior decisions holding that § 314(d) does not bar judicial review of “the manner in which the agency’s review ‘proceeds’ once instituted.” *Thryv*, 590 U.S. at 58 (citing *SAS Inst.*, 584 U.S. at 371).

Finally, the Federal Circuit held Dolby was not injured because it is not “*barred* from asserting estoppel against the Alleged RPIs in hypothetical future litigation.” App.8a (emphasis added). In doing so, the court did not consider or address Dolby’s showing that the Board’s refusal to enforce § 312(a)(2) in this proceeding hinders Dolby’s ability to enforce its estoppel rights against those entities in the future, ECF 37, Reply Br. 12-13—an injury of the type this Court has recognized as sufficient. *See TransUnion*, 594 U.S. at 442. Nor did the Federal Circuit address Dolby’s additional showing that the information deprivation here also hinders Dolby’s investigation as to bringing infringement suits against the nine entities, and its future patent licensing discussions with those entities. ECF 37, Reply Br. 11, ECF 11, Opening Br. 13-14.

Instead, the Federal Circuit dismissed those harms because Dolby had not shown that any of the nine entities infringes the '577 patent. App.8a. In so doing, the court again ignored Dolby's sufficient showing of injury and imposed yet another requirement far exceeding this Court's precedents in *TransUnion* and *Public Citizen*.

Following the panel's decision, Dolby sought rehearing by the panel or en banc, which the court denied. App.11a-12a.

REASONS FOR GRANTING THE PETITION

Certiorari is warranted because the decision below strips patent owners of a significant Congressionally guaranteed right, conflicts with this Court's precedents and those of other circuits about informational standing and injury in fact, and clashes with this Court's decisions regarding the scope of § 314(d)'s appeal bar. Because these issues are appealable only to the Federal Circuit, no other courts can squarely address these statutory provisions. 35 U.S.C. §§ 319, 411(c), 421(c), 431(c), 441(c), 451(c), 461(c), 471(c), 481(c), 491(c), 501(c), 511(c), 521(c), 531(c), 541(c), 551(c), 561(c), 571(c), 581(c), 591(c), 601(c), 611(c), 621(c), 631(c), 641(c), 651(c), 661(c), 671(c), 681(c), 691(c), 701(c), 711(c), 721(c), 731(c), 741(c), 751(c), 761(c), 771(c), 781(c), 791(c), 801(c), 811(c), 821(c), 831(c), 841(c), 851(c), 861(c), 871(c), 881(c), 891(c), 901(c), 911(c), 921(c), 931(c), 941(c), 951(c), 961(c), 971(c), 981(c), 991(c), 1001(c), 1011(c), 1021(c), 1031(c), 1041(c), 1051(c), 1061(c), 1071(c), 1081(c), 1091(c), 1101(c), 1111(c), 1121(c), 1131(c), 1141(c), 1151(c), 1161(c), 1171(c), 1181(c), 1191(c), 1201(c), 1211(c), 1221(c), 1231(c), 1241(c), 1251(c), 1261(c), 1271(c), 1281(c), 1291(c), 1301(c), 1311(c), 1321(c), 1331(c), 1341(c), 1351(c), 1361(c), 1371(c), 1381(c), 1391(c), 1401(c), 1411(c), 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2531(c), 2541(c), 2551(c), 2561(c), 2571(c), 2581(c), 2591(c), 2601(c), 2611(c), 2621(c), 2631(c), 2641(c), 2651(c), 2661(c), 2671(c), 2681(c), 2691(c), 2701(c), 2711(c), 2721(c), 2731(c), 2741(c), 2751(c), 2761(c), 2771(c), 2781(c), 2791(c), 2801(c), 2811(c), 2821(c), 2831(c), 2841(c), 2851(c), 2861(c), 2871(c), 2881(c), 2891(c), 2901(c), 2911(c), 2921(c), 2931(c), 2941(c), 2951(c), 2961(c), 2971(c), 2981(c), 2991(c), 3001(c), 3011(c), 3021(c), 3031(c), 3041(c), 3051(c), 3061(c), 3071(c), 3081(c), 3091(c), 3101(c), 3111(c), 3121(c), 3131(c), 3141(c), 3151(c), 3161(c), 3171(c), 3181(c), 3191(c), 3201(c), 3211(c), 3221(c), 3231(c), 3241(c), 3251(c), 3261(c), 3271(c), 3281(c), 3291(c), 3301(c), 3311(c), 3321(c), 3331(c), 3341(c), 3351(c), 3361(c), 3371(c), 3381(c), 3391(c), 3401(c), 3411(c), 3421(c), 3431(c), 3441(c), 3451(c), 3461(c), 3471(c), 3481(c), 3491(c), 3501(c), 3511(c), 3521(c), 3531(c), 3541(c), 3551(c), 3561(c), 3571(c), 3581(c), 3591(c), 3601(c), 3611(c), 3621(c), 3631(c), 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I. The Federal Circuit, which is the only Court of Appeals that interprets § 312 of the America Invents Act, ignored the text, structure, and history of that statute.

Section 312(a)(2)'s language is clear and mandatory: "A petition filed under section 311 may be considered *only if*—(2) the petition identifies all real parties in interest." (emphasis added). This Court has recognized that the term "only if" introduces a "necessary

... condition[.]” *California v. Hodari D.*, 499 U.S. 621, 628 (1991). “A necessary condition describes a prerequisite.” *Twp. of Tinicum v. U.S. Dept. of Transp.*, 582 F.3d 482, 488 (3d Cir. 2009) (citing *Hodari D.*); *see also Keats v. Becerra*, 2021 WL 6102200, at *2 (D.C. Cir. 2021) (noting that the term “only if” ... introduces a necessary condition”).

The immediate statutory context confirms that the identification of the real parties in interest is a requirement. It appears in the statute alongside a list of other conditions that, too, are plainly mandatory: the payment of a filing fee, § 312(a)(1); the identification of the subject of and basis for the challenge, § 312(a)(3); the provision of any information required by regulations, § 312(a)(4); and notice in the form of copies of the petition and supporting documents to the patent owner, § 312(a)(5). Nothing in the text of § 312 grants the Board any discretion to waive or ignore these requirements.

Nor is there any question that § 312(a)(2) is intended to benefit the owner of the challenged patent. Section § 312(a)(5) specifically requires that all the information supporting the challenge be provided “to the patent owner.” *See also* 157 Cong. Rec. S1375 (Mar. 8, 2011) (statement of Sen. Kyl) (explaining that Congress added § 312(a)(5) “to require petitioners to provide to the patent owner the same identification of any real parties in interest or privies that is provided to the Office”).

The Patent Trial and Appeal Board nonetheless refused to enforce Dolby’s right. Its stated basis—“cost

and efficiency”—“cannot supersede the language chosen by Congress.” *Mohasco Corp. v. Silver*, 447 U.S. 807, 825 (1980). Indeed, this Court has previously held that the Director cannot refuse to apply the AIA’s statutory text in favor of “efficiency.” *SAS Inst.*, 548 U.S. at 368. And the Federal Circuit, although finding Dolby suffered no injury, did not contend otherwise.

The decision below has a massive impact on patent holders. Because the Federal Circuit is the only jurisdiction that hears appeals from the Board, *see* 28 U.S.C. § 1295(a)(4)(A), no other court will have the opportunity to interpret or apply § 312(a)’s requirements. There is thus no opportunity for any split to develop; *all* patent owners who face inter partes review can no longer rely on the statutory protections Congress enacted to protect their interests. The result is that patent owners who expend significant cost and effort to successfully defend an inter partes review proceeding through a final written decision cannot establish, in that same proceeding, the scope of the estoppel benefit they have obtained.³

Providing patent owners with such “quiet title” and protection from “harassment” was the point of this part of the America Invents Act. *See* H.R. Rep.

³ Although the Director of the Patent and Trademark Office may take administrative action to enforce § 312(a)(2)’s requirement, *see* Memo disavowing *SharkNinja* precedent (available at perma.cc/C5VF-HQ4E), the language in the statute does not permit discretion on this point. The Board must follow Congress’s direction first, and patent holders should not be left to hope that future administrations will make different choices than the one that denied Dolby its rights below.

No. 112-98, pt. 1, at 48 (2011) (emphasizing “the importance of quiet title to patent owners” and seeking to prevent “harassment ... through repeated ... administrative attacks on the validity of a patent”). The decision below “frustrate[s] the purpose of the section as providing quick and cost effective alternatives to litigation,” and also “divert[s] resources from the research and development of inventions.” H.R. Rep. No. 112-98 at 48. The Court should grant certiorari to restore the America Invents Act to its proper scope within the only Circuit that applies § 312(a).

II. The Federal Circuit’s decision conflicts with this Court’s and other federal appeals courts’ decisions about informational standing.

Although the Federal Circuit is the only court that has the opportunity to pass upon § 312(a), the court’s analysis of whether Dolby has standing to assert its rights under the statute conflicts with the approaches taken by this Court and other circuits in statutory right to information cases. The Federal Circuit’s decision ascribes a *singular* “purpose” to the AIA—“a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.” App.6a. The decision does not consider or acknowledge any other “purpose” of the Act. The decision then reasons that because the Act’s purported *singular* purpose is something other than allowing public access to certain information, “the AIA does not create an informational right.” App.6a-7a.

That reasoning starkly contradicts this Court’s approach in *Public Citizen*, 491 U.S. at 446. There, this Court recognized that the Federal Advisory Committee Act (FACA) was intended to serve multiple purposes: “to ensure that new advisory committees be established only when essential and that their number be minimized; that they be terminated when they have outlived their usefulness; that their creation, operation, and duration be subject to uniform standards and procedures; that Congress and the public remain apprised of their existence, activities, and cost; and that their work be exclusively advisory in nature.” *Id.* But FACA *also* provided for public access to certain committee minutes, records, and reports. *Id.* at 446-47. Although FACA’s information access provisions reflected only *one* purpose of the legislation, this Court nonetheless held that those provisions created a statutory right to information that the plaintiff had standing to enforce. *Id.* at 448-51.

Here, as in *Public Citizen*, the statutory text establishes multiple purposes of the AIA. In addition to the purpose the Federal Circuit identified—a more efficient process that streamlines litigation—Congress also recognized the need to provide patent owners with quiet title, to protect them from harassment through repeated challenges, to provide them with efficient adjudication, and to avoid diverting their resources away from research and development. H.R. Rep. No. 112-98, pt. 1, at 48 (2011). That is why § 312(a)(2) requires a petition to identify “*all* real parties in interest,” and § 312(a)(5) directs the petitioner to disclose all real parties in interest “to the patent owner.” Sections 312(b) and 316(a) further require

complete disclosure of the petition and the docket to the public. No different than *Public Citizen*, the AIA attempts to achieve multiple aims—one of which is providing patent owners with the identity of “*all* real parties in interest to the petition” for inter partes review. §§ 312(a)(2) (emphasis added), 312(a)(5).

The Federal Circuit’s decision also improperly placed dispositive weight on its finding that § 312(a)(2)’s identification requirement is not a “free-standing right” backed by a “special statutory cause of action.” App.6a-7a. To the contrary, this Court has recognized that the AIA provides rights that parties to inter partes review can enforce without such requirements. In *SAS Inst.*, 584 U.S. at 371, this Court held that a party to inter partes review has an enforceable right under § 318(a) to obtain a final written decision as to every claim the petition challenged. This Court reached that conclusion even though § 318(a) was neither backed by a special statutory cause of action nor stated a right that exists outside of the AIA. See 35 U.S.C. § 318(a). Likewise, in *Public Citizen*, this Court held that the plaintiff had informational standing even though there was no separate statutory cause of action and the rights at issue there too only arose out of statute. 491 U.S. at 446.

The Federal Circuit’s decision further conflicts with this Court’s precedents governing injury in the context of right to information standing. The Federal Circuit held that Dolby was not injured because Dolby did not show that (1) “it will be barred from asserting estoppel against the Alleged RPIs in hypothetical future litigation” or (2) “that any of the alleged RPIs is

engaged in, or intends to engage in, activity that may trigger an infringement suit.” App.8a. The Federal Circuit did not cite any decision to support imposing such requirements.

To the contrary, this Court has consistently applied a far lower standard for establishing injury in fact in right to information cases—one Dolby easily satisfied here. “[A] plaintiff suffers an ‘injury in fact’ when the plaintiff fails to obtain information which must be publicly disclosed pursuant to a statute.” *FEC v. Akins*, 524 U.S. 11, 21 (1998) (citing *Public Citizen*, 491 U.S. at 449). A mere showing that the “alleged information deficit hindered” the plaintiff in some way is sufficient. *TransUnion*, 594 U.S. at 442.

The other circuits have likewise concluded that “[t]he law is settled that a denial of access to information qualifies as an injury in fact where a statute (on the claimants’ reading) requires that the information be publicly disclosed and there is no reason to doubt their claim that the information would help them.” *Campaign Legal Ctr. & Democracy 21 v. FEC*, 952 F.3d 352, 356 (D.C. Cir. 2020); *NRDC, Inc. v. EPA*, 961 F.3d 160, 168 (2d Cir. 2020) (quoting and adopting same); *Kelly v. Realpage Inc.*, 47 F.4th 202, 212 (3d Cir. 2022) (“[U]nder *Akins* and *Public Citizen*, a plaintiff need only allege that she was denied information to which she was legally entitled, and that the denial caused some adverse consequence related to the purpose of the statute.”).

Dolby’s showing of injury satisfied this Court’s precedents and the “settled law” recognized by other

circuits. Dolby demonstrated that the information it has been denied must be publicly disclosed by statute (and indeed directly disclosed to patent owners by statute), and that the deprivation of that information *hinders* Dolby's ability to enforce its estoppel rights and obtain quiet title. ECF 37, Reply Br. 12-13. Dolby further explained that the information has other uses, too—it would inform the nature and terms of future licensing agreements Dolby grants to the nine entities at issue, would cause Dolby to investigate whether to sue those entities for infringement, and would influence its decision whether to bring suit since those entities would be estopped from challenging validity pursuant to § 315(e). ECF 37, Reply Br. 11, ECF 11, Opening Br. 13-14.

Because of the Federal Circuit's decision, Dolby itself remains unaware of the names of the nine entities it has asked the Board to identify as real parties in interest to the proceeding below. Unified has placed that information under seal, and it is only available to Dolby's outside counsel. Both the Board and Federal Circuit denied Dolby's requests to unseal that information. And the protective order in this proceeding requires destruction of all sealed information within 60 days of final disposition of this action—including the names of the nine entities at issue. ECF 37, Reply Br. 12-13. As a result, Dolby simply *will not know* if a future IPR filed against the '577 patent has been brought by one of the nine entities at issue below. In addition, other significant evidence about Unified's real parties in interest—including documents and deposition testimony—remains under seal, and likewise stands to be destroyed under the protective

order. Re-creating that evidence in a later proceeding is highly impractical, if not impossible, requiring a successful motion before the Board for third party discovery, 37 C.F.R. §§ 42.51, 42.52, and a subpoena from a district court, 35 U.S.C. § 24, all within the three-month deadline for patent owners to submit a preliminary response seeking non-institution. 37 C.F.R. § 42.107(b).

In view of those realities, Dolby is more than “hindered” by the deprivation of the information here. Dolby thus satisfied the fundamental question underlying this Court’s injury in fact jurisprudence: “What’s it to you?” *Bost v. Ill. State Bd. of Elections*, 146 S. Ct. 513, 519 (2026). Just as candidates “are not mere bystanders in their own elections,” *id.* at 520, patent owners are not “mere bystanders” to the IPR proceedings instituted against them. “Departures from the preordained rules cause them particularized and concrete harm.” *Id.* The Federal Circuit’s contrary decision conflicts with this Court’s precedents and imposes requirements inconsistent with the law.

III. The decision below conflicts with this Court’s precedents interpreting § 314(d).

The Federal Circuit held that “[e]ven if patent owners have a right under” § 312(a)(2) to have real parties in interest disputes adjudicated, § 314(d) bars judicial review. App.6a-7a. In the Federal Circuit’s view, “such a right only arises in the context of IPR proceedings” and “the AIA bars judicial review” of final written decisions about real parties in interest. App.6a. That holding badly misreads § 314(d)’s text

and squarely conflicts with this Court's decisions interpreting that specific provision.

Section 314(d) makes the Director's determination *whether* to institute an inter partes review "final and nonappealable." This provision "prevent[s] courts from entertaining an argument that the Director erred in instituting an inter partes review of certain patent claims." *SAS Inst.*, 584 U.S. at 370 (citing *Cuozzo*, 579 U.S. at 271-76)). That is not what Dolby argued here. ECF 11, Opening Br. 8-9, 11-12; App.17a.

Dolby neither challenged the Board's decision to institute a review nor requested that the court disturb or vacate the proceeding. *Id.* Dolby sought only to obtain the full benefit of successfully defending its patent through a final written decision—estopping not only Unified from further challenging the '577 patent, but also the nine other entities that lurked behind Unified's petition. *Id.* Those entities funded the petition, benefitted from the petition, and currently remain free to bring their own challenges against the '577 patent.

In reading § 314(d) to bar judicial review here, the Federal Circuit did not address—indeed, did not even mention—this Court's decisions expressly rejecting the argument that § 314(d) "foreclos[es] judicial review of any legal question bearing on the institution of inter partes review." *SAS Inst.*, 584 U.S. at 370; *see also Cuozzo*, 579 U.S. at 273. Indeed, this Court has recognized the "strong presumption" in favor of judicial review" that applies when interpreting statutes,

including those “that may limit or preclude review.” *Cuozzo*, 579 U.S. at 273; *see also SAS Inst.*, 584 U.S. at 370. “To overcome that presumption,” there must be “clear and convincing indications” that “Congress meant to foreclose review.” *SAS Inst.*, 584 U.S. at 370. And “[g]iven the strength of this presumption and the statute’s text,” this Court has concluded that “§ 314(d) precludes judicial review only of the Director’s ‘initial determination[s]’” that review is “justified.” *Id.* at 370-71. In other words, § 314(d)’s appeal bar is limited to cases challenging “whether the agency should have instituted review at all.” *Thryv*, 590 U.S. at 58. That provision does not bar review of cases challenging “the manner in which the agency’s review ‘proceeds’ once instituted.” *Id.*

On top of that, the Court has expressly held that § 314(d) does not bar judicial review when a party contends only that the Director “exceeded his statutory authority.” *SAS Inst.*, 584 U.S. at 371; *see id.* ([N]othing in § 314(d) ... withdraws our power to ensure that an inter partes review proceeds in accordance with the law’s demands.”). Indeed, this Court has “emphasize[d] that § 314(d) does not ‘enable the agency to act outside its statutory limits.’” *Id.* “If a party believes the Patent Office” has “exceed[ed] its statutory bounds,” judicial review “remains available.” *Id.* (cleaned up).

Again, because IPR decisions are exclusively appealed to the Federal Circuit, there is no opportunity for a circuit split to develop. As it did in *SAS Inst.*, this Court should grant the petition to correct the Federal Circuit’s over-extension of § 314(d)’s appeal bar to

preclude review of the Board's failure to abide by § 312(a)(2)'s mandatory requirement.

IV. This case is an excellent vehicle to decide the important questions presented.

This case is an appropriate vehicle for this Court to consider the issue presented. The issue was preserved, presented, and decided below. Dolby prevailed on the merits of the underlying patent challenge, so the scope of estoppel has meaningful consequences here. The factual record is fully developed and contains extensive evidence that specific entities are unnamed real parties in interest. Because the Federal Circuit has exclusive nationwide appellate jurisdiction over appeals from the Patent Trial and Appeal Board, 28 U.S.C. § 1295(a)(4)(A), the decision below will be ossified as the law of the land absent this Court's intervention. There can be no square circuit split on this particular statute, and it is unlikely that any future litigant could challenge the Federal Circuit's decision in view of the binding, conclusive precedent it has set.

The Federal Circuit's approach also directly conflicts with this Court's precedents and those of other circuits with respect to informational injuries. It also presents an important, pure question of law—the rights granted to patent owners under § 312(a)(2) and the showing necessary to establish an injury from the deprivation of those rights. In light of the Federal Circuit's creation of a new exception to § 312(a)(2), patent owners' only hope is that the Director will use his discretion to impose the requirement already set forth in the statute. In *SAS Inst.*, this Court refused to accept

that outcome, and intervened to reject the Director's power to apply or ignore the plain text of § 318(a) at his or her own whim. This Court should do the same with respect to § 312(a)(2) here.

CONCLUSION

The Court should grant the petition.

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APPENDIX

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**APPENDIX A — OPINION OF THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT,
DECIDED JUNE 5, 2025**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2023-2110

DOLBY LABORATORIES
LICENSING CORPORATION,

Appellant,

v.

UNIFIED PATENTS, LLC,

Appellee,

COKE MORGAN STEWART, ACTING
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND ACTING
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE,

Intervenor.

Decided: June 5, 2025

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. IPR2021-
00275.

Appendix A

Before MOORE, *Chief Judge*, CLEVENGER and CHEN,
Circuit Judges.

MOORE, *Chief Judge*.

Dolby Laboratories Licensing Corporation (Dolby) appeals from a final written decision of the Patent Trial and Appeal Board (Board) determining all challenged claims of U.S. Patent No. 10,237,577 are not unpatentable. Because Dolby fails to establish an injury in fact sufficient to confer standing to appeal, we dismiss.

BACKGROUND

Dolby owns the '577 patent, directed to a prediction method using an in-loop filter. '577 patent at 1:54–58. Unified Patents, LLC (Unified) petitioned for *inter partes* review (IPR) challenging claims 1, 7, and 8 of the '577 patent as anticipated and obvious. J.A. 76. In its petition, Unified certified it was the sole real party in interest (RPI) under 37 C.F.R. § 42.8(b)(1). J.A. 81. Dolby identified nine other entities it believed should also have been named as RPIs (Alleged RPIs). J.A. 3568–86. In its institution decision, the Board declined to adjudicate whether the Alleged RPIs were RPIs and instituted review with Unified as the sole RPI. J.A. 5044–47.

In its final written decision, the Board held Unified failed to show any of the challenged claims are unpatentable. J.A. 36. The Board again declined to adjudicate the RPI dispute, explaining such a determination is unnecessary because there is no evidence any of the Alleged RPIs

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are time-barred or estopped under 35 U.S.C. § 315 from bringing the IPR or that Unified purposefully omitted any of the Alleged RPIs to gain an advantage. J.A. 3–5 (citing *SharkNinja Operating LLC v. iRobot Corp.*, No. IPR2020-00734, Paper 11 at 2, 16, 18, 32, 2020 Pat. App. LEXIS 13188 (P.T.A.B. Oct. 6, 2020) (precedential)). The Board followed the United States Patent and Trademark Office’s practice of only adjudicating RPI disputes when material to the proceeding in the interest of cost and efficiency. *SharkNinja*, No. IPR2020-00734, Paper 11 at 18–20, 2020 Pat. App. LEXIS 13188. Dolby appeals. Unified and the Director of the Patent and Trademark Office, who has intervened, challenge standing on appeal.

DISCUSSION

We have jurisdiction to review final decisions of the Board pursuant to 28 U.S.C. § 1295(a)(4)(A). However, our jurisdiction is limited to “Cases” and “Controversies.” U.S. CONST. art. III, § 2, cl. 1. To establish a case or controversy, a party must meet the “irreducible constitutional minimum of standing.” *Lujan v. Defs. of Wildlife*, 504 U.S. 555, 560, 112 S. Ct. 2130, 119 L. Ed. 2d 351 (1992). Although a party does not need Article III standing to file an IPR petition or obtain a Board decision, the party must establish standing once it seeks our review of the Board’s final decision. *Allgenesis Biotherapeutics Inc. v. Cloudbreak Therapeutics, LLC*, 85 F.4th 1377, 1380 (Fed. Cir. 2023).

To meet Article III standing requirements, an appellant must have “(1) suffered an injury in fact, (2) that is fairly traceable to the challenged conduct of the

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[appellee], and (3) that is likely to be redressed by a favorable judicial decision.” *Spokeo, Inc. v. Robins*, 578 U.S. 330, 338, 136 S. Ct. 1540, 194 L. Ed. 2d 635 (2016). To establish an injury in fact, an appellant must show it has “suffered ‘an invasion of a legally protected interest’ that is ‘concrete and particularized’ and ‘actual or imminent, not conjectural or hypothetical.’” *Id.* at 339 (quoting *Lujan*, 504 U.S. at 560). As the party seeking judicial review, Dolby bears the burden of establishing it has standing. *Phigenix, Inc. v. Immunogen, Inc.*, 845 F.3d 1168, 1171 (Fed. Cir. 2017).

Dolby argues it has standing to appeal the Board’s refusal to adjudicate the RPI dispute based on (1) the statutory right of a “dissatisfied” party under 35 U.S.C. § 319; (2) the violation of Dolby’s statutory right to information under 35 U.S.C. § 312(a)(2); and (3) various harms stemming from the Board’s refusal, which amount to injury in fact.¹ We conclude Dolby failed to meet its burden to establish standing on any ground.

I.

Dolby first argues 35 U.S.C. § 319 confers standing to appeal the Board’s decision because it is a “dissatisfied” party. Dolby Op. Br. 12; *see also* 35 U.S.C. § 319 (“A party dissatisfied with the final written decision of the [Board] under section 318(a) may appeal the decision pursuant

1. Dolby repeats these arguments to assert standing to challenge (1) *SharkNinja* as procedurally void and (2) the Board’s grant of Unified’s motion to seal certain information related to the unadjudicated RPI dispute as confidential. Dolby Op. Br. 24, 28.

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to sections 141 through 144.”). We do not agree. It is well established that a statutory right to appeal under the America Invents Act (AIA) does not obviate the requirement for Article III standing. *See, e.g., JTEKT Corp. v. GKN Auto. LTD.*, 898 F.3d 1217, 1219 (Fed. Cir. 2018) (“In a series of decisions, we have held that the statute cannot be read to dispense with the Article III injury-in-fact requirement for appeal to this court.”).

II.

Dolby also argues 35 U.S.C. § 312(a)(2) grants patent owners an informational right to know the identities of all RPIs in IPR proceedings, and the violation of such a right constitutes an injury in fact. Dolby Op. Br. 12–13; Dolby Reply Br. 1–10; *see also* 35 U.S.C. § 312(a)(2) (“A petition filed under section 311 may be considered only if the petition identifies all real parties in interest.”). We do not agree.

The Supreme Court has found an informational right exists in cases involving “public-disclosure or sunshine laws that entitle all members of the public to certain information.” *TransUnion LLC v. Ramirez*, 594 U.S. 413, 441, 141 S. Ct. 2190, 210 L. Ed. 2d 568 (2021). For instance, denial of access to records from the American Bar Association’s Standing Committee on the Federal Judiciary constituted an injury in fact because the Federal Advisory Committee Act (FACA) requires that advisory committee minutes, records, and reports be made publicly available. *Pub. Citizen v. Dep’t of Just.*, 491 U.S. 440, 449, 446–47, 109 S. Ct. 2558, 105 L. Ed. 2d 377 (1989) (citing 5 U.S.C. app. 2 § 10(b)).

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Similarly, denial of information about the American Israel Public Affairs Committee’s contributors and activities constituted an injury in fact because the Federal Election Campaign Act (FECA) requires political committees to disclose detailed reports of donors, contributions, and expenditures. *FEC v. Akins*, 524 U.S. 11, 14–15, 20, 118 S. Ct. 1777, 141 L. Ed. 2d 10 (1998) (citing 2 U.S.C. §§ 432–34). FECA specifically provides a statutory cause of action for any party to file suit if they believe a violation of the Act, such as failure to disclose certain information, has occurred. *Id.* at 19 (quoting 2 U.S.C. § 437g(a)(1), (a)(8)(A)).

One of the express purposes of FACA and FECA is thus to allow the public access to certain information. By contrast, the purpose of the AIA is “to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.” *Thryv, Inc v. Click-To-Call Techs., LP*, 590 U.S. 45, 54, 140 S. Ct. 1367, 206 L. Ed. 2d 554 (2020) (quoting H.R. Rep. No. 112–98, pt. 1, at 40 (2011)).

Even if patent owners have a right under 35 U.S.C. § 312(a)(2) to have RPI disputes adjudicated, such a right only arises in the context of IPR proceedings; there is no freestanding right to that information. Rather than creating a special statutory cause of action, the AIA bars judicial review of IPR institution decisions, which includes decisions concerning the RPI requirement under 35 U.S.C. § 312(a)(2). *ESIP Series 2, LLC v. Puzhen Life USA, LLC*, 958 F.3d 1378, 1386 (Fed. Cir. 2020); *cf. SIPCO*,

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LLC v. Emerson Elec. Co., 980 F.3d 865, 869 (Fed. Cir. 2020); *see also* 35 U.S.C. § 314(d) (“The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.”). We therefore hold the AIA does not create an informational right.

III.

Dolby argues it has suffered an injury in fact because (1) the Alleged RPIs may be breaching license agreements, (2) the empaneled Administrative Patent Judges (APJs) that rendered the Board’s final written decision may have conflicts of interest with the Alleged RPIs, (3) the Alleged RPIs may not be properly estopped in future proceedings, and (4) Unified may be disincentivized from filing IPRs if it must identify its members as RPIs. Dolby Op. Br. 12–15. We conclude Dolby’s purported injuries are too speculative to establish Article III standing.

First, Dolby does not argue any of the Alleged RPIs are subject to license agreements with Dolby, much less provide evidence the Alleged RPIs are breaching license agreements. *See* Dolby Op. Br. 12–13; *see also Apple Inc. v. Qualcomm Inc.*, 992 F.3d 1378, 1383–84 (Fed. Cir. 2021) (holding appellant failed to show standing to appeal an IPR final decision based on ongoing license obligations that would not be affected by the validity determination).

Second, Dolby provides no evidence any of the APJs had a potential conflict based on any of the Alleged RPIs, despite Dolby’s counsel knowing the identities of

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the Alleged RPIs and having the ability to request the APJs' financial disclosures once the case was empaneled. *See* Dolby Op. Br. 13; Director Br. 20–21. The APJs had sufficient information to ensure a lack of conflicts because Dolby identified the Alleged RPIs before institution. J.A. 3573–74. More importantly, Dolby cannot show harm from a potential conflict because it prevailed before the Board. J.A. 36. Dolby does not seek to disturb the decision in its favor issued by the APJs it claims may have had a conflict.

Third, Dolby provides no evidence it will be barred from asserting estoppel against the Alleged RPIs in hypothetical future litigation. *See* Dolby Op. Br. 14. Nor does Dolby claim that any of the Alleged RPIs is engaged in, or intends to engage in, activity that may trigger an infringement suit. *Id.* It is undisputed there is no pending or threatened litigation related to the '577 patent such that estoppel issues would be implicated. J.A. 4–5. It is also undisputed there is no collateral estoppel effect of the Board's refusal to adjudicate the RPI dispute that would prevent Dolby from raising the issue in future proceedings, whether before the Board or in district court. Director Br. 15; Unified Br. 15, 18.

Finally, Dolby provides no evidence Unified would change its strategies should it be required to disclose its members as RPIs. *See* Dolby Op. Br. 14–15. Dolby merely speculates that, if required to do so, Unified may never challenge another Dolby patent again. *Id.* The only support Dolby cites is Unified's CEO's testimony that requiring its members to be named as RPIs in IPRs would be "a dramatic departure" from its existing practices. J.A.

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3662 at 24:23–24. That is far too speculative to establish injury in fact.

CONCLUSION

For these reasons, we conclude Dolby has failed to establish an injury in fact sufficient to confer Article III standing. We dismiss the appeal and do not reach the merits of Dolby’s substantive challenges.

DISMISSED

Costs

No costs.

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**APPENDIX B — ORDER OF THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT,
FILED SEPTEMBER 23, 2025**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2023-2110

DOLBY LABORATORIES
LICENSING CORPORATION,

Appellant,

v.

UNIFIED PATENTS, LLC,

Appellee,

COKE MORGAN STEWART, ACTING
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND ACTING
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE,

Intervenor.

Filed September 23, 2025

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. IPR2021-
00275.

Appendix B

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

Before MOORE, *Chief Judge*, LOURIE, CLEVINGER¹, DYK,
PROST, REYNA, CHEN, HUGHES, STOLL, CUNNINGHAM, and
STARK, *Circuit Judges*.²

PER CURIAM.

ORDER

Dolby Laboratories Licensing Corporation filed a combined petition for panel rehearing and rehearing en banc. Alliance of U.S. Startups & Inventors for Jobs requested leave to file a brief as amicus curiae, which the court granted. The petition was first referred to the panel that heard the appeal, and thereafter the petition 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.

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

2. Circuit Judge Newman and Circuit Judge Taranto did not participate.

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The petition for rehearing en banc is denied.

FOR THE COURT

September 23, 2025

Date

Jarrett B. Perlow
Clerk of Court

**APPENDIX C — PTAB DECISION OF THE
UNITED STATES PATENT AND TRADEMARK
OFFICE, DATED JUNE 15, 2022**

Trials@uspto.gov
571-272-7822

Paper 48
Date: June 15, 2022

UNITED STATES PATENT
AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL
AND APPEAL BOARD

UNIFIED PATENTS, LLC,

Petitioner,

v.

DOLBY LABORATORIES
LICENSING CORPORATION,

Patent Owner.

IPR2021-00275
Patent 10,237,577 B2

Dated June 15, 2022

Before AMBER L. HAGY, SHARON FENICK, and
IFTIKHAR AHMED, *Administrative Patent Judges.*

FENICK, *Administrative Patent Judge.*

Appendix C

JUDGMENT

Final Written Decision

Determining No Challenged Claims Unpatentable

35 U.S.C. § 318(a)

Granting Petitioner’s Motion to Seal

Granting Petitioner’s Motion for Entry of Protective Order

I. INTRODUCTION

Petitioner filed a Petition (Paper 1, “Pet.”), requesting an *inter partes* review of claims 1, 7, and 8 (“the challenged claims”) of U.S. Patent 10,237,577 B2 (“the ’577 patent”). Patent Owner filed a Preliminary Response. Paper 11 (“Prelim. Resp.”) (filed as Parties and Board Only); Paper 20 (Petitioner’s redacted version). After authorization (Paper 13), Petitioner filed a Pre-Institution Reply (Paper 14) and Patent Owner filed a Pre-Institution Sur-reply (Paper 15) addressing the application of the written description standard in the determination of the priority date for the challenged claims of the ’577 patent. We determined that the information presented in the Petition established that there was a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims and we instituted this proceeding on June 17, 2017, as to all challenged claims and all grounds of unpatentability. Paper 21 (“Institution Decision” or “Dec. on Inst.”). We have jurisdiction under 35 U.S.C. § 314.

Patent Owner filed a request for rehearing relating to real party-in-interest (“RPI”) issues. Paper 24 (filed as Board and Parties Only). We issued a decision denying the request for rehearing. Paper 37.

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During the course of trial, Patent Owner filed a Patent Owner Response (Paper 32, “PO Resp.”), Petitioner filed a Reply to the Patent Owner Response (Paper 36, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 39, “PO Sur-reply”). Each of these were filed as Board and Parties Only. An oral hearing was held on March 23, 2022, and two transcripts were entered, one corresponding to the public portion of the hearing (Paper 46, “Public Tr.”) and one corresponding to a confidential portion of the hearing (Paper 45).

During the proceeding, Petitioner filed a Motion to Seal Patent Owner’s Preliminary Response as well as Exhibits 2005, 2006, 2009, 2012, 2013, 2014, 2016, and 2018. Paper 18, “Mot. Seal.” This filing was accompanied by an Unopposed Motion for Entry of Protective Order. Paper 19, “Mot. Prot.” Patent Owner opposed Petitioner’s Motion to Seal (Paper 23, “PO Opp. Mot. Seal,” filed as Board and Parties Only) and Petitioner replied to Patent Owner’s Opposition (Paper 26, “Pet. Reply Mot. Seal”).

We have jurisdiction under 35 U.S.C. § 6(b)(4). This decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of claims 1, 7, and 8 of the ’577 patent. For the reasons discussed below, Petitioner has not demonstrated by a preponderance of the evidence that claims 1, 7, and 8 of the ’577 patent are unpatentable. Additionally, we grant Petitioner’s Motion to Seal and Petitioner’s Motion for Entry of a Protective Order.

*Appendix C***II. BACKGROUND****A. Related Matters**

The parties identify no related matters. Pet. 1; Paper 5 (Patent Owner’s Mandatory Notices), 2.

B. Real Parties-in-Interest

Petitioner identifies only itself as the real party-in-interest. Pet 1. Patent Owner identifies itself and Dolby Laboratories, Inc. as RPIs. Paper 5, 2. Patent Owner, in the Preliminary Response, contended that nine other entities (“Alleged RPIs”) are RPIs for the challenges presented in the Petition. Prelim. Resp. 48–70. Patent Owner argued that the Petition should be denied “due to [Petitioner’s] direct contravention of the Board’s precedent in *AIT Remand*, which requires member organizations like [Petitioner] to name members as RPIs.” *Id.* at 68 (citing *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 at 32 (Oct. 2, 2020) (precedential) (“*AIT Remand*”)).

In our Institution Decision, we followed the precedential decision in *SharkNinja*, and as there was no indication that time bar or estoppel provisions under 35 U.S.C. § 315 would be implicated or that any omission would be material to the case at the institution stage, we declined to decide whether the Alleged RPIs were RPIs. Dec. on Inst. 2–5; *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 at 18 (PTAB Oct. 6, 2020) (precedential).

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In its Patent Owner Response, Patent Owner argues that *SharkNinja* “does not grant the Board discretion to ignore Patent Owner’s RPI challenge at the Final Written Decision stage” because that holding is limited to the context of decisions on institution. PO Resp. 18. Patent Owner additionally argues that *SharkNinja* expressly rested on the lack of a contention that the petitioner in that case had omitted RPIs to gain some advantage. *Id.* at 18–19. Patent Owner repeats its assertions that, here, the Alleged RPIs stand to gain an advantage “by funding this IPR while avoiding (thus far) the corresponding estoppel consequences.” *Id.* at 19; *see* Prelim. Resp. 49–67; PO Sur-reply 19–26. Patent Owner therefore argues that we may not consider the Petition without determining whether the Alleged RPIs are RPIs, or that we should “at least” name the Alleged RPIs as RPIs. PO Resp. 17, 21, 37.

On this record, we determine that we need not address whether the Alleged RPIs were improperly excluded because, “even if [they] were, it would not create a time bar or estoppel under 35 U.S.C. § 315.” *SharkNinja* at 32. As in *SharkNinja* and *AIT Remand*, the alleged unnamed RPIs here have a relationship with the petitioner. *SharkNinja* at 16; *AIT Remand* at 20–21. Unlike in *AIT Remand*, however, neither Petitioner nor any of the Alleged RPIs were sued. *SharkNinja* at 2; *AIT Remand* at 24–26; Pet. Reply 28 (asserting that “[n]o one, including no [Petitioner] member, has challenged the patent, and, to [Petitioner’s] knowledge, no one has been sued or threatened with suit on it,” and that thus, “no alleged RPI is estopped under §315(e) and/or time-barred under §315(b), the framework’s driving policy considerations”) (citing *AIT Remand* at 2,

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SharkNinja at 32). Patent Owner does not dispute this. *See, e.g.*, Paper 5 (Patent Owner’s Mandatory Notices), 2; PO Resp. 17–37. Accordingly, we determine that neither issues of time bar nor issues of estoppel are implicated.

Under the Board’s precedential decision in *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, the Board’s jurisdiction to consider a petition does not require an identification of all RPIs in a petition. IPR2015-00739, Paper 38 at 5–6 (PTAB Mar. 4, 2016) (precedential); *see also Blue Coat Sys., Inc. v. Finjan, Inc.*, IPR2016-01444, Paper 11 at 10 (PTAB July 18, 2017) (“Evidence [of failure to identify all RPIs] is, at best, suggestive of an issue that is not jurisdictional.”). The Federal Circuit has held that § 312(a)(2) is not jurisdictional. *See Mayne Pharma Int’l Pty. Ltd. v. Merck Sharp & Dohme Corp.*, 927 F.3d 1232, 1240 (Fed. Cir. 2019) (reiterating the Board’s aim to achieve a “just, speedy, and inexpensive resolution” of *inter partes* review proceedings and citing *Lumentum*’s holding that jurisdiction is maintained even where a petition does not identify all real parties in interest).

In the present proceeding, there is no allegation that Petitioner’s exclusion of the Alleged RPIs should result in termination of the proceeding for any reason other than for the alleged failure of jurisdiction. *See* PO Resp. 21. Additionally, there is no allegation or evidence that any of the Alleged RPIs is barred or estopped from this proceeding, or that Petitioner purposefully omitted any of the Alleged RPIs to gain some advantage in our forum. Therefore, we decline to make the requested determination.

*Appendix C***C. The '577 Patent**

The '577 patent issued from application No. 15/210,978 (“the '978 application”), filed on July 15, 2016, which is a continuation of application No. 14/609,472 (“the '472 application”), filed on January 30, 2015, which is a continuation of application No. 13/877,253 (“the '253 application”), which is a national stage application of PCT/KR2012/003125 (hereinafter “the '125 PCT application”), filed April 23, 2012. Ex. 1001, codes (21), (22), (63), 1:9–17; Pet. 12; PO Resp. 5.

The '577 patent, titled “Method and Apparatus for Encoding/ Decoding Images Using a Prediction Method Adopting In-Loop Filtering,” relates to video encoding and decoding, and describes using in-loop filtering while encoding and decoding video in order to “improv[e] the accuracy of prediction and reduc[e] errors in prediction, thus improving the efficiency of video compression and reducing the amount of data to be transmitted.” Ex. 1001, codes (54), (57), 1:21–22. The '577 patent explains that “[t]ypically, when video data is encoded, the video data is encoded by performing intra prediction or inter prediction, transformation, quantization, entropy coding, or the like on each picture of the video data in units of blocks.” *Id.* at 1:30–34. Further explanation of intra prediction is included:

Typically, a video may include a series of pictures, and each picture may be divided into a predetermined region such as a frame or block. When a region of the video is divided into

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blocks, the divided block may be . . . classified into an intra block and an inter block according to a coding method. The intra block refers to a block encoded using an intra prediction coding scheme. The intra prediction coding refers to a scheme of generating a prediction block by predicting a pixel of a current block using pixels of previously encoded, decoded and restored blocks in a current picture that is currently encoded, and encoding a difference value between the prediction block and the current block.

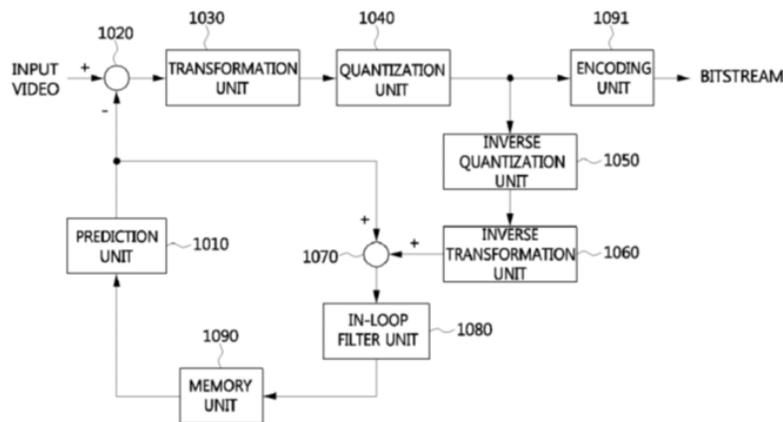
Id. at 5:23–34.

A flowchart “for explaining an intra prediction method according to the present invention” provided in the ’577 patent includes the following four steps, in this sequence: (S110) “generating a residual block through inverse quantization and inverse transformation;” (S120) “generating a prediction block through intra prediction;” (S130) “performing in-loop filtering on a current block obtained by summing the residual block and the prediction block;” and (S140) “storing the current block subjected to the in-loop filtering in a frame buffer for intra prediction of a next encoding target block.” *Id.* at 3:42–43, 5:55–65, Fig. 1. Step 130, in Figure 1, is labelled as “SUM RESIDUAL BLOCK AND PREDICTION BLOCK TO GENERATE CURRENT BLOCK AND PERFORM IN-LOOP FILTERING.” *Id.* at Fig. 1. Figures 10 and 11 are block diagrams depicting exemplary configurations of a video encoding (Figure 10) or decoding (Figure 11) device

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in which the described intra prediction methods have been implemented. *Id.* at 4:4–11, 15:57–19:3. Figure 10, reproduced below, is a block diagram of a video encoding device. *Id.* at 4:4–7, 15:60–65.

FIG. 10



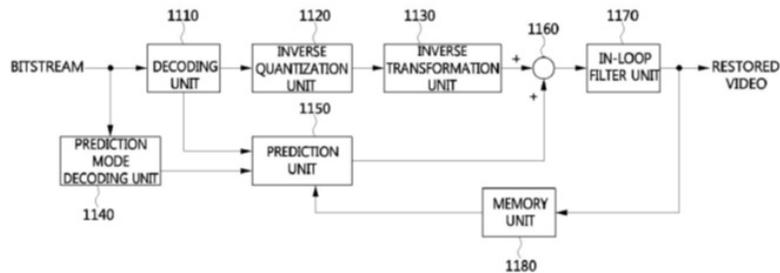
In Figure 10, a subtraction unit 1020 subtracts a prediction block, generated by prediction unit 1010, from an encoding target block (“INPUT VIDEO”), yielding a residual block. *Id.* at 16:6–9, 16:15–22. Transformation unit 1030 and quantization unit 1040 transform and quantize this residual block, which is then encoded and output by encoding unit 1091. *Id.* at 16:23–40, 18:1–3. That transformed and quantized residual block is also inversely quantized and inversely transformed by inverse quantization unit 1050 and inverse transformation unit 1060. *Id.* at 16:41–55. Prediction unit 1010 generates a

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prediction block corresponding to the current block; this corresponds to the Figure 1 step S120 of “generating a prediction block through intra prediction.” *Id.* at 16:6–14, 56–57. Addition unit 1070 adds the prediction block predicted by prediction unit 1010 to the residual block that has been inversely quantized and transformed, resulting in a current block. *Id.* at 16:56–59. In-loop filter unit 1080 filters the current block restored by addition unit 1070. *Id.* at 16:60–61.

Figure 11, reproduced below, is a block diagram of a video decoding device. *Id.* at 4:8–11, 18:18–23.

FIG. 11



As in Figure 10, inverse quantization (performed here by inverse quantization unit 1120) and inverse transformation (performed here by inverse transformation unit 1130) are performed, resulting in a restored residual block. *Id.* at 18:34–39, 18:62–63. Additionally, as in Figure 10, a prediction block is generated, here by prediction unit 1150. *Id.* at 18:58–62. This may occur using information

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regarding prediction mode received from prediction mode decoding unit 1140, which decodes information on a prediction mode from the received bitstream. *Id.* at 18:40–57.

Addition unit 1160 adds the restored residual block and prediction block, resulting in a restored target block. *Id.* at 18:61–63. “The restored target block is filtered by the in-loop filter unit 1170 and then stored in the memory unit (1180) so that the target block can be used as reference data when a next block of a current block or another block is restored in future.” *Id.* at 18:64–67.

D. Illustrative Claims

The Petition challenges independent claims 1, 7 and 8. Claims 1 and 7 illustrate the challenged claims at issue and are reproduced here with bracketed numbering from the Petition added for ease of reference to certain limitations:

1. A video decoding method performed by a video decoding apparatus, the method comprising:

obtaining quantized coefficients of a current block by decoding an input bitstream;

generating a residual block of the current block by performing an inverse-quantization and an inverse-transform on the quantized coefficients;

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generating a prediction block by performing an intra prediction on the current block, the intra prediction being performed by using an intra prediction mode relating to the current block and neighboring pixels adjacent to the current block;

[1.4] determining, based on a direction of the intra prediction mode, both whether to perform filtering on at least one predicted pixel adjacent to a boundary of the prediction block and a location of the at least one predicted pixel on which the filtering is performed;

[1.5] performing the filtering on the at least one predicted pixel adjacent to the boundary of the prediction block when the filtering is determined to be performed based on the direction of the intra prediction mode; and

[1.6] generating a restored block based on the residual block and the filtered prediction block.

7. A video encoding method performed by a video encoding apparatus, the method comprising:

generating a prediction block by performing an intra prediction on a current block, the intra prediction being performed by using an

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intra prediction mode relating to the current block and neighboring pixels adjacent to the current block;

[7.2] determining, based on a direction of the intra prediction mode, both whether to perform filtering on at least one predicted pixel adjacent to a boundary of the prediction block and a location of the at least one predicted pixel on which the filtering is performed;

[7.3] performing the filtering on the at least one predicted pixel adjacent to the boundary of the prediction block when the filtering is determined to be performed based on the direction of the intra prediction mode;

[7.4] generating a residual block based on the current block and the filtered prediction block; and

encoding the residual block by performing transformation and quantization on coefficients of the residual block.

Ex. 1001, 19:11–33, 20:14–34.

E. Prior Art and Asserted Grounds

Petitioner challenges claims of the '577 patent as follows (Pet. 4):

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Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 7, 8	102	Lee ¹
1, 7, 8	103	Lee
8	103	Lee, Guo ²
1, 7, 8	102	Van der Auwera ³
1, 7, 8	103	Van der Auwera

Petitioner additionally relies on the declaration of Dr. Immanuel Freedman (Ex. 1008).

III. ANALYSIS

A. Legal Standards

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring [*inter partes*] review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden never shifts to Patent Owner. See *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800

1. Lee et al., US 2013/0301720 A1 (pub. Nov. 14, 2013) (Ex. 1005).

2. Guo et al., US 2014/0376634 A1 (pub. Dec. 25, 2014) (Ex. 1031).

3. Van der Auwera et al., US 2013/0114708 A1 (pub. May 9, 2013) (Ex. 1006).

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F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review). Furthermore, Petitioner must explain with particularity how the prior art would have rendered the challenged claims unpatentable. 35 U.S.C.A. § 312(a)(3); 37 C.F.R. § 42.104 (2020) (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”).

A claim is unpatentable under 35 U.S.C. § 102(b) “if each and every [claim] limitation is found either expressly or inherently in a single prior art reference.” *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 851 F.3d 1270, 1273 (Fed. Cir. 2017) (citation omitted). “A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present.” *Akamai Techs., Inc. v. Cable & Wireless Internet Servs., Inc.*, 344 F.3d 1186, 1192 (Fed. Cir. 2003) (citing *Rosco, Inc. v. Mirror Lite, Co.*, 304 F.3d 1373, 1380 (Fed. Cir. 2002)).

A claim is unpatentable under 35 U.S.C. § 103 if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject

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matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

Relying on the testimony of Dr. Freedman, Petitioner contends that “[a] person of ordinary skill in the art at the priority date (July 15, 2016) for the ’577 Patent . . . would have had a bachelor’s degree in electrical or computer engineering, or a closely related scientific field such as physics or computer science, and two years of work experience with video processing.” Pet. 11 (citing Ex. 1008 ¶¶ 35–39).

Patent Owner’s declarant opines that:

a POSITA in the technology area of the ’577 Patent as of the filing date of the PCT Application—April 23, 2012—would have had at least a bachelor’s degree in electrical engineering, computer engineering, computer science, or a similar discipline, and at least two years of experience in video processing. Superior education could compensate for a deficiency in work experience, and vice-versa.

Ex. 2017 (Declaration of Dan Schonfeld, Ph.D.) ¶¶ 42–43.

With the exception of the date applied, the two definitions appear, on the whole, consistent. Petitioner

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specifies the qualifications that one of ordinary skill in the art would have had as of July 2016, whereas Patent Owner's declarant ties the qualifications to April 2012. The record provides no reason that the differences between the two definitions are attributable to the dates provided.

We adopt Petitioner's proposed level of ordinary skill in the art, which we determine would apply at all relevant times. This level of skill comports with the teachings of the '577 patent and the asserted prior art. Our analysis would be the same if we applied the level of skill described by Patent Owner's declarant at all relevant times.

C. Claim Construction

In an *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b), including construing the claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b). We apply the claim construction standard as set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

Claim terms are generally given their ordinary and customary meaning as would be understood by one with ordinary skill in the art in the context of the specification, the prosecution history, other claims, and even extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises, although extrinsic

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evidence is less significant than the intrinsic record. *Phillips*, 415 F.3d at 1312–17. Usually, the specification is dispositive, and it is the single best guide to the meaning of a disputed term. *Id.* at 1315.

Only those terms that are in controversy need be construed, and only to the extent necessary to resolve the controversy. *Nidec Motor Corp.*, 868 F.3d at 1017 (citing *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). Petitioner does not identify any claim term that requires construction. Pet. 35. Patent Owner makes no arguments relying on the construction of a claim term. *See* PO Resp.; PO Sur-reply. For purposes of this Decision, no express construction of any term is necessary.

D. Priority Date of the Challenged Claims

Petitioner's challenge is based on an assertion that the challenged claims of the '577 patent are entitled to a priority date no earlier than the July 15, 2016, filing date of the '978 application (which issued as the '577 patent). Pet. 3, 12–13. The asserted grounds of unpatentability rely on Lee, Guo, and Van der Auwera, and none of these references are available as prior art if, as Patent Owner asserts, the challenged claims of the '577 patent are instead entitled to a priority date of April 23, 2012, the filing date of the '125 PCT application. Pet. 3–4; PO Resp. 4–5.

1. Legal Standards

A patent claim is entitled to the benefit of the filing date of an earlier filed, related application if it meets the

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requirements of 35 U.S.C. § 120. *Hollmer v. Harari*, 681 F.3d 1351, 1355 (Fed. Cir. 2012). To claim “the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997); *see also* *Novozymes A/S v. DuPont Nutrition Biosciences APS*, 723 F.3d 1336, 1344 (Fed. Cir. 2013) (“[C]laims added during prosecution must find support sufficient to satisfy § 112 in the written description of the original priority application.”).

“[T]o satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue.” *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000). It, however, must convey with reasonable clarity to those skilled in the art that the inventor was in possession of the invention. *Id.* “Put another way, one skilled in the art, reading the original disclosure, must *immediately discern* the limitation at issue in the claims.” *Id.* (emphasis added)

“The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not.” *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003); *see also* *Droplets, Inc. v. E*Trade Bank*, 887 F.3d 1309, 1316 (Fed. Cir. 2018) (emphasizing that § 120 embodies an important public policy and requires “strict adherence to its requirements”). Accordingly, “[e]ntitlement to a

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filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed.” *Lockwood*, 107 F.3d at 1571–72; *see also Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (en banc) (“[A] description that merely renders the invention obvious does not satisfy the requirement.”). Likewise, a “mere wish or plan” for obtaining the claimed invention does not satisfy the written description requirement. *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997).

The test for written description support “requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Ariad*, 598 F.3d at 1351. “[T]he test for sufficiency is whether the specification reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *In re Glob. IP Holdings LLC*, 927 F.3d 1373, 1377 (Fed. Cir. 2019) (internal quotes omitted) (quoting *Ariad*, 598 F.3d at 1351).

The primary consideration in written description analysis is factual and must be assessed on a case-by-case basis. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562 (Fed. Cir. 1991); *see also Smith v. Horne*, 450 F.2d 1401, 1404 (CCPA 1971) (“The question as to whether an application forms a proper support for a claim to a composition which is not specifically disclosed, but which falls among compositions suggested by general language in the application is one which must be determined largely by the particular circumstances of each case.”).

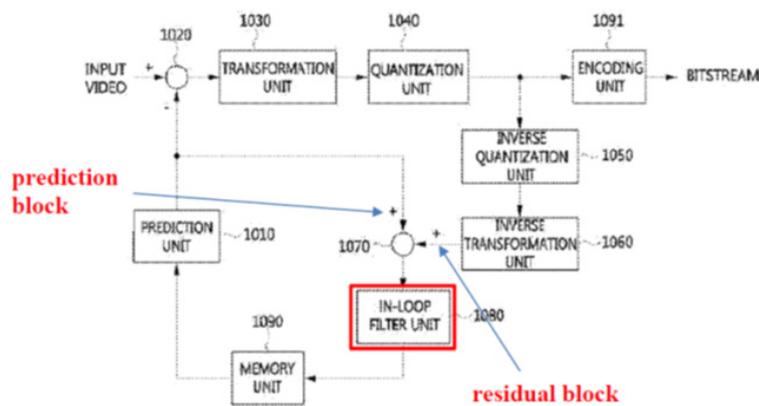
*Appendix C***2. Petitioner’s Contentions**

In the Petition, Petitioner argues that the prior applications to which the ’577 patent claimed priority do not contain written description support for the challenged claims. Pet. 9, 12–35. Specifically, Petitioner argues that the ’253 application (the national stage of the ’125 PCT application) does not support the claimed “filtering on reconstructed video **after** a predicted video and residual video are combined” but supports only “filtering at a different part of the encoding and decoding process.” Pet. 9. Petitioner argues that “each challenged independent claim requires filtering to be performed on **predicted pixels**” and that “the resultant **filtered prediction block** would be understood to be a block that comprises the at least one **filtered predicted pixel**” that would be used to generate a restored block (claim 1) or a residual block (claims 7 and 8). Pet 14–15 (citing Ex. 1008 ¶¶ 52–53). But, Petitioner contends, filtering as disclosed in the ’253 application only takes place on a restored block – one that results from the addition of a residual block to a predicted block. *Id.* at 15–20, 22–23 (citing Ex. 1007, 2:17–18, 4:2–4, 4:20–5:1, 5:8–10, 5:14–6:2, 15:10–12, 34:3–4, 35:16–17, 35:10–13, 35:19, 39:11–14, 40:7–13, 49, Figs. 1, 10, 11; Ex. 1008 ¶¶ 54–63).

Petitioner provides an annotated version of the block diagram of a video encoding device in Figure 10 of the ’253 application, reproduced below, to explain its argument.

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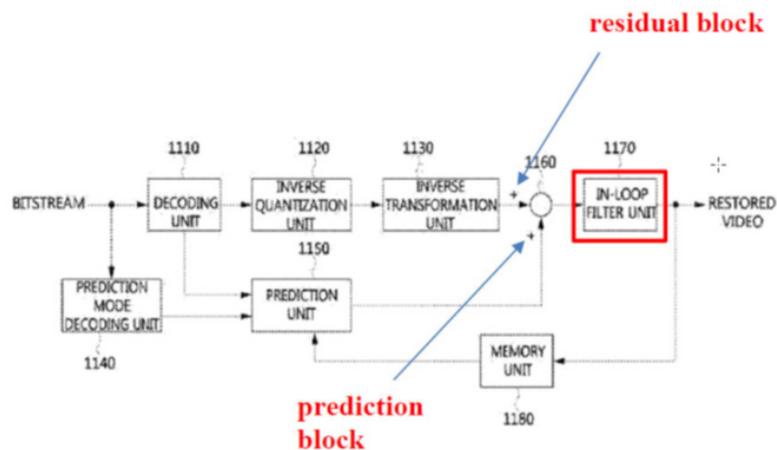
FIG. 10



EX1007, Figure 10 (annotated)

Pet. 17; Ex. 1008 ¶ 57. As shown in annotations in Petitioner's version of Figure 10, addition unit 1070 sums a prediction block and a residual block, and the result of this addition is then filtered by the in-loop filter unit 1080. *Id.* at 17–18 (citing Ex. 1007, 35:10–13; 34:3–4; 35:16–17, 35:19; Ex. 1008 ¶¶ 56–58). Similarly, Petitioner provides an annotated version of the block diagram of a video decoding device of Figure 11 of the '253 application, reproduced below.

FIG. 11

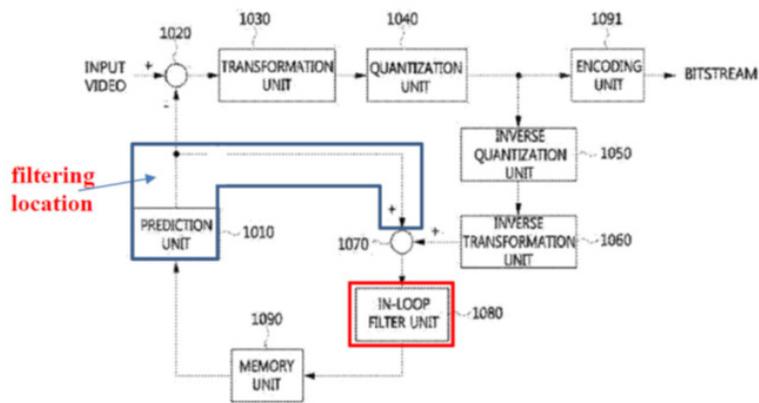


EX1007, Figure 11 (annotated)

Pet. 19; Ex. 1008 ¶ 59. Petitioner explains that its annotated version of Figure 11 shows that a prediction block and a residual block are added by addition unit 1160, with the result of this addition then filtered by the in-loop filter unit 1170. Pet. 18–19 (citing Ex. 1007, 39:11–14, 40:7–8, 40:9–13; Ex. 1008 ¶ 59).

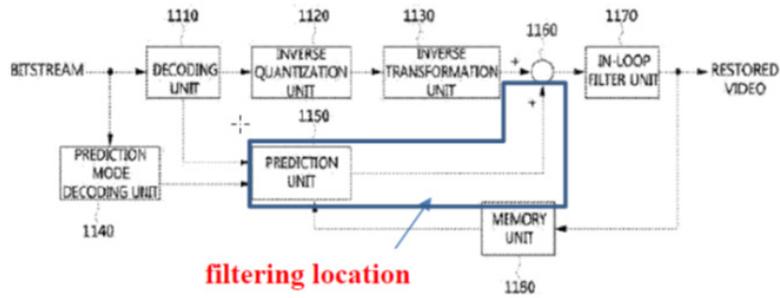
Petitioner argues that in order to provide support for the filtering recited in the challenged claims, the filtering would have to be performed on the prediction block before the addition unit combines the prediction block with the residual block. *Id.* at 19–21. Petitioner provides another annotated version of Figures 10 and 11 of the '253 application, reproduced below, in which the location of filtering would occur in order to correspond to the challenged claims, according to Petitioner's arguments.

FIG. 10



EX1007, Figure 10 (annotated)

FIG. 11



EX1007, Figure 11 (annotated)

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Pet. 20–21; Ex. 1008 ¶¶ 64–65. Each of these annotated versions includes a blue box indicating a filtering location before addition unit 1070 in Figure 10 and addition unit 1160 in Figure 11. “But,” Petitioner contends, “the ’253 Application does not disclose filtering that is performed in these locations.” Pet. 21. Petitioner argues that each mention of filtering in the ’253 application describes filtering on a block that is obtained from summing a residual block and a prediction block. Pet. 21–22 (citing Ex. 1007, 2:17–18, 4:2–4, 4:20–5:1, 5:8–10, 5:17–18; Ex. 1008 ¶¶ 66–68).

After considering the Patent Owner’s Preliminary Response and the additional briefing by the parties, in our Institution Decision, we determined, “preliminarily and for the purposes of institution” that the claims were not entitled to the earlier priority date of April 23, 2012, but rather to the filing date of the application that issued as the ’577 patent, July 15, 2016. Dec. on Inst. 21–24; *see* Ex. 1001, code (22). This was based on our preliminary determination that one skilled in the art would not “immediately discern” that the ’253 application supported the claim limitation (in claims 1 and 8) of “performing the filtering on the at least one predicted pixel adjacent to the boundary of the prediction block when the filtering is determined to be performed based on the direction of the intra prediction mode.” Dec. on Inst. 21–24 (quoting *Purdue Pharma*, 230 F.3d at 1323).

Citing this determination, Petitioner contends, while acknowledging the burden of persuasion remains with Petitioner, that the production burden regarding the

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question of whether the '577 patent is entitled to a priority date shifted to Patent Owner. Petitioner argues that this burden of production shifts “after the priority claim is challenged by a party asserting no entitlement.” *Id.* at 1 (citing *Tech. Licensing*, 545 F.3d at 1327). Petitioner argues that this burden of production has not been met by Patent Owner. *Id.* at 1–4.

Petitioner additionally argues that, during the prosecution of the application that issued as the '577 patent (the '978 application), the applicant made relevant admissions while arguing against a double-patenting rejection. Pet. 27–33. Petitioner argues that during the prosecution of the '577 patent, the applicant admitted that the '180 patent (which issued from the '253 application) “does not explicitly disclose” or is “silent” regarding certain limitations of the then-pending versions of claims of the '978 application dealing with filtering the prediction block. Pet. 28–33 (citing Ex. 1002, 264, 311, 369, 386). Petitioner further cites in its Reply a portion of the applicant’s argument against the double-patenting rejection, contending that the contrast drawn by the applicant between the '180 patent’s claims and the claims in the '253 application amounted to an argument that “in-loop filtering [] performed on a restored block’ was not the same as filtering on prediction block pixels.” Pet. Reply 4–7 (citing, *inter alia*, Ex. 1002, 386–387). Petitioner argues that “[t]he applicant **achieved allowance** by **disclaiming** the current analogy [between filtering on a restored block and filtering on a predicted block] and arguing the current analogy was **mistaken**” and that Patent Owner should therefore be estopped from using

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the “ambiguous (or lack of)” disclosure from the ’253 application to show written description support for the priority claim. *Id.* at 6–7.

Petitioner argues that the cited support from the application of “modifications, equivalents, and alternatives” is merely rote boilerplate and does not show adequate disclosure. *Id.* at 7–9. Rather, Petitioner stresses, each reference to the “present invention” in the ’577 patent relates to an embodiment where filtering is performed after a residual block and a prediction block are summed. *Id.* at 9–13 (citing Ex. 1001, code (57), 1:62–2:4, 5:56–65, Figs 1, 11).

Petitioner describes Patent Owner’s path to support for the claims in the priority documents as “tortuous” and argues that “[Patent Owner]’s theory requires multiple undisclosed logical leaps” and is a “hindsight-driven substantive modification that is beyond the invention’s scope.” Pet. Reply 13–20. Petitioner in its Reply presents charts and figures to demonstrate the “tortuous” path to support and the alleged logical leaps; Petitioner, however, does not present additional evidence relating to the opinions of one of ordinary skill in the art regarding Patent Owner’s arguments, but relies solely on attorney argument in its Reply. *Id.* Petitioner does argue that Dr. Freedman’s original declaration should be accorded weight, but does not offer a supplemental declaration or any additional evidence specifically relating to Patent Owner’s arguments. *Id.* at 23–24.

Petitioner additionally argues that Patent Owner does not meet its burden of production because it addresses

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only support in the '577 patent's specification, and not in the priority document. Pet. Reply 2–3. Relatedly, Petitioner argues that Patent Owner addresses limitations 1.5 and 1.6 (and similar limitations in claims 7 and 8) but not limitation 1.4, which Petitioner also argued in the Petition was unsupported, and that, in any case, support for all limitations must be shown. *Id.* at 3–4.

3. Patent Owner's Contentions

Patent Owner argues that the Petitioner has failed in its challenge to the priority date. PO Resp. 3–4. Patent Owner argues that Petitioner did not meet its burden to show with particularity why the challenged patent is unpatentable, citing *Dynamic Drinkware's* instruction that the burden never shifts to the Patent Owner. *Id.* (citing *Dynamic Drinkware*, 800 F.3d at 1378).

Patent Owner contends that Dr. Freedman's declaration does not address the pertinent question because it is directed to the wrong standard. *Id.* at 4, 54–56. Specifically, Patent Owner contends that the declaration is directed only towards whether certain features were “not expressly disclosed” by the priority application. *Id.* at 4, 54–55 (citing Ex. 1008 ¶ 5, 87; Ex. 2026, 19:19–20:1); PO Sur-reply 1. Thus, Patent Owner contends, Dr. Freedman never considered “whether the disclosure of the [earlier] application relied upon **reasonably conveys to those skilled in the art** that the inventor had possession of the claimed subject matter” as of the date of the earlier disclosure. PO Resp. 4 (quoting, with added emphasis, *Ariad*, 598 F.3d at 1351),

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54 (same), 57; PO Sur-reply 1. Patent Owner argues: “[i]n challenging the priority date of the ’577 Patent, the Petitioner has therefore relied exclusively on assessments that were based on Petitioner’s witness evaluating the ’577 Patent for express disclosure (rather than accounting for what the specification would reasonably convey to a person of ordinary skill in the art).” PO Resp. 4, 54–57; PO Sur-reply 4–7. Thus, Patent Owner argues that the only evidence that addresses the proper standard is its declarant Dr. Schoenfeld’s testimony. PO Resp. 4; PO Sur-reply 2–7. Patent Owner asserts that Petitioner has not properly established the perspective of one of skill in the art or rebutted any of Patent Owner’s evidence of this perspective. PO Resp. 39; PO Sur-reply 1, 7–10.

Substantively, Patent Owner argues that the priority document specifically describes in-loop filters, which were known to include multi-tap linear filters, also known as finite impulse response (FIR) filters. PO Resp. 38–39 (citing Ex. 2024 ¶¶ 41–45; Ex. 2002). Thus, Patent Owner asserts, one of ordinary skill in the art would have recognized that applying filtering on the combination of the prediction block and the residual block (the output of addition unit 1070 in Figure 10 and addition unit 1160 in Figure 11) is equivalent to directly applying the filtering separately on the prediction and residual blocks prior to combining them. *Id.* at 39–41 (citing Ex. 2024 ¶¶ 45–48; Ex. 2002; Ex. 2003). Patent Owner argues that “[t]he distributive property of FIR filters dictates that the direct filtering of a combination of two signals is mathematically equivalent to directly filtering each of the two signals prior to combining them.” *Id.* at 40–41 (citing Ex. 2024 ¶¶ 47–48; Ex. 2003, Appendix A).

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We raised concerns in the Institution Decision, discussing similar arguments made in Patent Owner’s Preliminary Response, whether one of ordinary skill applying the distributive property to arrive at equivalence of filtering before the addition unit with filtering after the addition unit would arrive at an equivalent system with two filters (filtering the predicted block and filtering the residual block, before adding them). Dec. on Inst. 22–23; *see* Prelim. Resp. 30, 32–36, 40. We preliminarily found that, with respect to only optionally filtering the residual block, “[w]e . . . have no record evidence before us as to why one of ordinary skill would know that the inventor was in possession of this invention of the broader scope or its equivalent.” *Id.* at 23.

In its Response, Patent Owner addresses these issues, providing argument and evidence that one of ordinary skill would readily recognize that the design intent for the video encoding/decoding systems in the figures “would be for the prediction block to carry the bulk of the energy of the underlying video signals” and that, therefore, a person of ordinary skill in the art “would readily recognize that directly filtering the values of the residual block has much less impact on the energy of the restored signal (and is therefore less important) than directly filtering the values of the prediction block, which would typically include most of the energy of the restored signal.” PO Resp. 43–44 (citing Ex. 2024 ¶¶ 52–53; Ex. 2020; Ex. 2026, 50:14–22). Patent Owner additionally asserts that one of ordinary skill might have omitted the filtering of the restored block as shown in Figures 10 and 11, which is not critical to the error reduction offered by the invention, to account

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for resource constraints. *Id.* at 45–48 (citing Ex. 2024 ¶¶ 54–56; Ex. 2026, 58:21–59:9). Generally, Patent Owner argues that one of ordinary skill would recognize that the broader invention disclosed can achieve the disclosed advantages by performing in-loop filtering on the residual block as shown in the figures or by directly applying in-loop filtering on the prediction block. *Id.* at 49, 53 (citing Ex. 2024 ¶¶ 57).

Patent Owner, in response to Petitioner’s assertions that it does not find support in the priority document for the disputed claim limitations, provides a chart in its Sur-reply, which Patent Owner contends shows where each limitation was addressed in Patent Owner’s Response and in Dr. Schoenfeld’s declaration. PO Sur-reply 12–15 (citing PO Response 5, 8–9, 11, 15; Ex. 2024 ¶¶ 26, 30, 34, 37; Ex. 1018 ¶¶ 9–11, 29, 71, 135–136, 157–158; Ex. 1001, 2:17–23, 4:4–7, 8:50–64, 16:23–40, 18:1–14, 18:58–63).

4. Analysis

As noted above, in an *inter partes* review, the burden of persuasion is on the petitioner to prove unpatentability by a preponderance of the evidence, and that burden never shifts to the patent owner. *Dynamic Drinkware*, 800 F.3d at 1378. The petitioner also has the initial burden of production to show that an asserted reference qualifies as prior art under 35 U.S.C. § 102. *Id.* at 1378–79. With respect to this issue, “the burden of going forward [with evidence and argument] may jump from one party to another as the issues in the case are raised and developed.” *Tech. Licensing*, 545 F.3d 1316, 1329 (Fed. Cir. 2008); *see id.* at

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1327 (“We understand, and we shall use here, the phrase ‘going forward with the evidence’ to mean both producing additional evidence and presenting persuasive argument based on new evidence or evidence already of record, as the case may require.”). In *Technology Licensing*, which involved an appeal from an infringement action brought in district court, the defendant (alleged infringer) satisfied its burden of going forward with evidence of anticipating prior art, at which point the plaintiff/patentee had the burden of going forward with evidence that the prior art was not anticipating because the asserted claim was entitled to an earlier date. *Id.* at 1327. This was done by “producing sufficient evidence and argument to show that an ancestor to [the asserted patent in *Technology Licensing*], with a filing date prior to the [asserted prior art] date, contains a written description that supports all the limitations of . . . the claim asserted.” *Id.* At that point, “the burden of going forward again shifts to the proponent of the invalidity defense, [the defendant], to convince the court that [plaintiff/patentee] is not entitled to the benefit of the earlier filing date.” *Id.* at 1328.

Here, Petitioner met its initial burden of production by providing evidence of prior art that antedated the filing date of the application that issued as the ’577 patent. Pet. 3–4, 35–92. Thus, with respect to the question of whether the claims were entitled to an earlier priority date, the burden shifted to the Patent Owner. Patent Owner produced evidence and argument in its Preliminary Response. Prelim. Resp. 29–47 (citing Ex. 2017 ¶¶ 47–51; Ex. 1018 ¶¶ 132–133, 137–138, 153–154, 157, Figs. 1, 2, 3A, 3B, 6a, 6b, 11). Preliminarily, we determined that Patent

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Owner did not, on that record, sufficiently establish that the challenged claims were entitled to an earlier priority date. Dec. on Inst. 21–24. We specifically described our decision as relating to the support in the record at that time for the limitations relating to filtering of a prediction block. *Id.* at 22–23. Thus, in the parlance of *Technology Licensing*, the issues in the case relating to support for the challenged claims in the priority document continued to be developed, and the burden of going forward jumped to Patent Owner. *Tech. Licensing*, 545 F.3d at 1329.

In its Response, as detailed above, Patent Owner adduces additional evidence and argument with respect to the limitations relating to filtering of a prediction block. PO Resp. 38–53. Patent Owner makes arguments based on additional declaration evidence from Dr. Schoenfeld specifically relating to, and commenting on the issues raised in, the Institution Decision. *Id.* at 41–49 (citing Ex. 2024 ¶¶ 52–57). Additionally, Patent Owner raises the question of whether the declaration Petitioner submitted with the Petition relates to the correct standard of whether the priority applications reasonably conveyed to those skilled in the art that the inventor had possession of the invention as claimed in the ’275 patent, as opposed to a determination of whether the claimed limitations were “expressly disclosed” by the priority applications. PO Resp. 3–4, 54–57; Ex. 1008 ¶¶ 51, 87; *see id.* at ¶¶ 60, 66.

Upon review of the complete record, we determine that Patent Owner establishes that the ’253 application would have conveyed the inventor’s possession of the claimed subject matter to one of ordinary skill in the art.

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While Petitioner describes Patent Owner's path to support as "nothing short of tortuous" and requiring "multiple undisclosed logical leaps" (Pet. Reply 13), Petitioner provides no declaration testimony, relying generally on attorney argument to rebut Patent Owner's arguments and evidence by asserting that the support proffered is "beyond the invention's scope, untethered to the disclosure, and unsupported by objective evidence." Pet. Reply 13–20; Public Tr. 51:5–52:1. In this argument, Petitioner contends that Patent Owner's proposition that the challenged claims (e.g. filtering only the prediction block and not the residual block or the restored block, with respect to decoding (claim 1)) would have been *obvious* in light of the priority document is foreclosed by precedent. *Id.* at 16–17 (citing *L.A. Biomedical Research Inst. v. Eli Lilly & Co.*, 849 F.3d 1049, 1057 (Fed. Cir. 2017)). However, Patent Owner does not make an obviousness argument; but rather argues, with the support of its declarant, that one of ordinary skill would "readily recognize" or "immediately discern" that filtering of the prediction block is one way in which the concept of in-loop filtering described in the priority document could be implemented. PO Resp. 2–3, 38–49; Ex. 2024 ¶¶ 53–56. While evidence of unpredictability or nonobviousness might be used to counter Patent Owner's arguments, Petitioner has not produced any such evidence. In fact, Petitioner has offered no rebuttal evidence as to what one of ordinary skill would have readily recognized from the priority document's disclosure. *See generally* Pet. Reply. Petitioner's attorney argument characterizing Patent Owner's contentions as premised on obviousness are not sufficient to counter Patent Owner's arguments and evidence regarding what is reasonably conveyed in

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the priority documents. See *In re Curtis*, 354 F.3d 1347, 1352–53 (Fed. Cir. 2004); *Bilstad v. Wakalopoulos*, 386 F.3d 1116, 1123–1126 (Fed. Cir. 2004) (requiring focus on an analysis of what one skilled in the art would have understood from the priority document and the degree of predictability of technical variations in the field of art); PO Resp. 50 (describing digital signal processing principles as predictable).

Patent Owner argues and supports with declaration evidence that one of ordinary skill would have recognized a broader concept to have been described in the specification of the '577 patent⁴ than the implementations shown in Figures 10 and 11, and that one of ordinary skill would have readily recognized that the challenged claims are a predictable way in which that concept could be

4. Petitioner argues that Patent Owner improperly refers to and analyzes the content of the '577 patent rather than that of the PCT document (Ex. 1018). Pet. Reply 2–3. As we noted in the Institution Decision, at the time of that Decision “[n]either Petitioner nor Patent Owner [had] identif[ied] or discuss[ed] any material differences between the disclosure of the '253 application and the disclosures of other applications to which priority may be claimed.” Dec. on Inst. 18 n.6. Petitioner still does not describe what differences, if any, exist and make this a material error. Patent Owner’s declarant provided the appropriate citations in parallel with the citations to the '577 patent, and Patent Owner has provided a chart setting forth the corresponding portions of the PCT document that provide support. Ex. 2024 ¶¶ 26, 30, 34, 37; PO Sur-reply 12–16; Public Tr. 89:16–90:17. Additionally, Petitioner’s own declarant testified that the '253 application, the '472 application, and the specification of the '577 patent are “identical” or “nearly identical.” Ex. 1008 ¶¶ 47, 84.

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implemented. PO Resp. 46–49 (citing Ex. 2024 ¶¶ 55–57). We give significant weight to Dr. Schonfeld’s testimony, which remains uncontroverted, regarding what one of ordinary skill would have readily recognized from the priority document’s disclosure, beyond what is explicitly disclosed there. The discussion in this testimony of existing knowledge in the field and predictability of the aspect at issue is supported by evidence. *See Ariad*, 598 F.3d at 1351; *see, e.g.*, Ex. 2024 ¶¶ 22, 45–47, 53; *see also* Ex. 2026, 28:3–12.

With respect to Petitioner’s argument that the position espoused by Patent Owner conflicts with positions taken by the applicant during prosecution of the ’978 application that issued as the ’577 patent, these statements, in context, discuss distinctions between the then-pending claims in the ’978 application and the claims of the ’180 patent that issued from the ’253 application. While the applicant argues that “US 9,008,180 does not explicitly disclose” or “is silent on” claimed features, the context of the argument is double patenting, in which claims are compared to *claims* of an earlier related patent, not to the entire disclosure of that earlier patent. *See* Pet. 28–33; Ex. 1002, 261–264, 311–312, 367–370. Petitioner’s argument in its Reply focuses on a different portion of the file history of the ’577 patent, but these arguments, again, relate to double patenting and distinctions between claims, and thus, again, are not compelling here as evidence of an inconsistent position during prosecution relating to the relevant *disclosure* and the challenged claims. Pet. Reply 4–7.

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Petitioner additionally argues that Patent Owner has not made a showing of support for all limitations, but focuses only on those discussed in the Institution Decision. Pet. Reply 1–4. Petitioner cites a non-precedential opinion of the Board in which a patent owner did not address all limitations, but only certain challenged limitations, and this showing was found insufficient. *Id.* at 3 (citing *Inguran, LLC v. Premium Genetics Ltd.*, PGR2015-00017, Paper 22, 33–34 (Dec. 20, 2016)). However, in that case, the Board specifically noted that the patent owner failed to provide support for all limitations in either the preliminary response or the subsequent briefing. *Inguran*, Paper 22, 33 (“Patent Owner, however, does not address the remaining limitations of claim 1 and whether the prior applications disclose those remaining limitations in the manner required by § 112(a). *See* PO Resp. 3–6; Prelim. Resp. 7–13.”). Here, Patent Owner addressed each limitation in its Preliminary Response. Prelim. Resp. 40–47.

Petitioner argues that:

To the extent PO argues the Board should consider its Preliminary Response contentions, such argument should be rejected. PO waived Preliminary Response arguments not raised in the POR. Paper 22, 8 (waiver); *In re NuVasive, Inc.*, 842 F.3d 1376, 1380-81 (Fed. Cir. 2016). The Preliminary Response forms no part of this trial and should not influence the Board’s decision.

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In *NuVasive*, however, while arguments regarding the public accessibility of a prior art reference were made by the patent owner in its preliminary response, the patent owner “failed to challenge public accessibility during the trial phase” and “explicitly declined to make further arguments as to public accessibility” during oral argument. *NuVasive*, 842 F.3d at 1380–1381.

Whether or not the present case is distinguishable from the cited cases, we agree with Patent Owner that it sufficiently described support for all limitations in the Patent Owner Response, as argued in the Patent Owner Sur-reply. PO Sur-reply 12–15 (citing PO Resp. 5, 8–9, 11, 15; Ex. 2024 ¶¶ 26, 30, 34, 37; Ex. 1018 ¶¶ 9–11, 29, 71, 135–136, 157–158; Ex. 1001, 2:17–23, 4:4–7, 8:50–64, 16:23–40, 18:1–14, 18:58–63). While Petitioner has argued that this shows support in the specification of the ’577 patent and not in the claimed priority document, we find, in light of the Petitioner’s declarant’s testimony that the ’577 patent’s specification is “identical” or “nearly identical” to the ’253 application, and the lack of any argument relating to the significance of the differences between the documents, that Patent Owner sufficiently shows support for all the limitations of the challenged claims in the Patent Owner Response, as detailed in the Sur-reply. *See supra* n.4; Ex. 1008 ¶¶ 47, 85.

For these reasons, on the record before us, the challenged claims are entitled to a priority date of April 23, 2012.

Therefore, as each of the asserted grounds of unpatentability rely on Lee, Guo, and Van der Auwera, and

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none of these references are available as prior art given the priority date of the challenged claims, Petitioner has not prevailed in showing that claims 1, 7, and 8 of the '577 patent are unpatentable.

IV. PETITIONER'S MOTION TO SEAL AND MOTION FOR PROTECTIVE ORDER

In its Motion to Seal, Petitioner argues that Patent Owner's Preliminary Response and Exhibits 2005, 2006, 2009, 2012, 2013, 2014, 2016, and 2018 should be sealed. *See generally* Mot. Seal. Petitioner also argues for us to grant its Unopposed Motion for Entry of Protective Order. Mot. Prot.

According to Petitioner, "Exhibits 2005, 2006, 2009, 2012, 2013, 2014, and 2016 contain information that Petitioner has identified as confidential business information." Mot. Seal, 3. Petitioner additionally contends that Exhibit 2018 is a transcript of a call in which Petitioner's confidential information was discussed. *Id.* Petitioner discusses the factors laid out in *Argentum*:

[A] movant to seal must demonstrate adequately that (1) the information sought to be sealed is truly confidential, (2) a concrete harm would result upon public disclosure, (3) there exists a genuine need to rely in the trial on the specific information sought to be sealed, and (4), on balance, an interest in maintaining confidentiality outweighs the strong public interest in having an open record.

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Argentum Pharms. LLC v. Alcon Research, Ltd., IPR2017-01053, Paper 27 at 4 (PTAB Jan. 19, 2018) (informative) (cited at Mot. Seal 2–3). With respect to the first three factors, Petitioner argues that the information relates to trade secrets and highly confidential business practices, that disclosure would affect its relationships with members or future members, and that the information relates only to the determination of whether Petitioner will remain the sole named real-party-in-interest. Mot. Seal 3–7, 8–14. With respect to the fourth factor, Petitioner argues that its interest in maintaining confidentiality outweighs the public interest in an open record, especially because the information is not, Petitioner argues, related in any way to the reasons for patentability. *Id.* at 7–8. Petitioner seeks to redact the entirety of Exhibits 2009. *Id.* at 8–10. Petitioner has submitted redacted versions of Exhibits 2005, 2006, 2012, 2013, 2014, 2016, and 2018, and of the Patent Owner Preliminary Response. *Id.* at 12–14; *see* Exs. 1032, 1034, 1036, 1033, 1037, 1035, 1039 (redacted copies of Exs. 2005, 2006, 2012, 2013, 2014, 2016, and 2018 respectively); Paper 20.

Patent Owner argues that Exhibit 2012 is a communication with a non-member and bears no evidence of confidentiality obligations. PO Opp. Mot. Seal 1, 10–11. Additionally, Patent Owner argues that Petitioner does not allege that a concrete harm would result, but only that potential harms could occur. *Id.* at 1–2, 5–6, 8, 9, 11–13. Patent Owner argues that Petitioner has not shown that all of Exhibit 2009 is truly confidential and that a document should not be sealed with no redacted version provided. *Id.* at 4–7. Patent Owner cites its own “strong interest” in

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disclosure as part of the public interest, including allowing it “to more fully assess the real party in interest issue in this proceeding.” *Id.* at 1, 7, 8, 9–10, 14. Patent Owner lastly argues that the Motion to Seal was not filed promptly and thus should be denied. *Id.* at 14–15.

We are not persuaded by Patent Owner’s arguments and are, instead, persuaded by Petitioner’s contentions that the balance of factors favors granting the sealing request. Additionally, the desire of internal employees of one party to access confidential information of another is not reflective of the strong public interest in an open record. We note that we did not reach the issue of whether the Alleged RPIs were real parties in interest, and thus the public interest is not hampered by closing the record on the portions of the record that argued this issue. As such, we grant Petitioner’s Motion to Seal in its entirety and also grant Petitioner’s Motion for Entry of Protective Order. Mot. Seal; Mot. Prot.

We note that, at present, there exists no public version of Patent Owner’s Preliminary Response (Paper 11), Patent Owner’s Opposition to the Motion to Seal (Paper 23), Patent Owner’s Request for Rehearing (Paper 24), Patent Owner’s Response (Paper 32), Petitioner’s Reply (Paper 36), Patent Owner’s Sur-Reply (Paper 39), the March 17, 2022 Patent Owner’s Update Exhibit List (Paper 43), or the confidential portion of the Oral Hearing Transcript (Paper 45). Additionally, we note that Exhibits 2019 through 2022 have been filed designated as Parties and Board Only. Some of these papers and exhibits do not appear to contain any confidential information. In view

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of the strong public interest in an open record, we will require the parties to jointly submit to the Board, for each of these papers or exhibits, a proposed redacted version, or a request to change the designation from “Parties and Board” to “Public.”

V. CONCLUSION

After considering all the evidence and arguments in the complete record, we conclude that Petitioner fails to demonstrate, by a preponderance of the evidence, that any of the challenged claims are unpatentable.

In summary:

Claims	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1, 7, 8	102	Lee		1, 7, 8
1, 7, 8	103	Lee		1, 7, 8
8	103	Lee, Guo		8
1, 7, 8	102	Van der Auwera		1, 7, 8
1, 7, 8	103	Van der Auwera		1, 7, 8
Overall Outcome				1, 7, 8

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VI. ORDER

Accordingly, it is

ORDERED that claims 1, 7, and 8 are not unpatentable based on the instituted grounds of unpatentability;

FURTHER ORDERED that the parties shall jointly submit to the Board, within 15 business days of this Decision, for each of Papers 11, 23, 24, 32, 36, 39, 43, and 45 and Exhibits 2019, 2020, 2021, and 2022, either a proposed redacted version of the document or a request to change its designation to Public; and

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

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**APPENDIX D — PTAB DECISION OF THE
UNITED STATES PATENT AND TRADEMARK
OFFICE, DATED APRIL 27, 2023**

Trials@uspto.gov
571-272-7822

Paper 48
Date: June 15, 2022

UNITED STATES PATENT
AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL
AND APPEAL BOARD

UNIFIED PATENTS, LLC,

Petitioner,

v.

DOLBY LABORATORIES
LICENSING CORPORATION,

Patent Owner.

IPR2021-00275
Patent 10,237,577 B2

Dated April 27, 2023

Before AMBER L. HAGY, SHARON FENICK, and
IFTIKHAR AHMED, Administrative Patent Judges.

FENICK, *Administrative Patent Judge.*

Appendix D

DECISION

Denying Petitioner's Request for Rehearing

37 C.F.R. § 42.71(d)

I. INTRODUCTION

Unified Patents, LLC ("Petitioner") filed a Request for Rehearing (Paper 49, "Request" or "Reh. Req.") of our Final Written Decision (Paper 48, "Final Written Decision" or "Dec.") in which we determined that Petitioner had not demonstrated claims 1, 7, and 8 of U.S. Patent 10,237,577 B2 ("the '577 patent") to be unpatentable. For the reasons that follow, Petitioner's Request for Rehearing is denied.

II. THE REQUEST FOR REHEARING

In pertinent part, 37 C.F.R. § 42.71(d) states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply.

Thus, a request for rehearing is not an opportunity merely to disagree with the Board's assessment of the arguments or weighing of the evidence, or to present new arguments or evidence.

With respect to the determination that the challenged claims were entitled to the priority date of an earlier priority

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document (*see* Dec. 26–33), Petitioner first argues that we overlooked its arguments that support for a specific claim limitation was not shown in the priority document to which the ’577 patent claimed priority. Req. Reh. 2–7. Additionally, Petitioner argues that we misapprehended the legal standard for written description support. *Id.* at 8–12.

We have reviewed Petitioner’s Request and carefully considered all of the arguments presented. For the following reasons, we are not persuaded that we overlooked any arguments or misapprehended the law.

III. DISCUSSION

A. Arguments Regarding “Determining” Limitations

In the Decision, we reviewed the Petitioner’s contentions that the ’577 patent was not entitled to the date of documents to which a claim of priority had been made, and we determined that, with respect to “the issues in the case relating to support for the challenged claims in the priority document . . . [,] the burden of going forward jumped to Patent Owner.” Dec. 25–28 (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)). We cited uncontroverted evidence of Patent Owner’s declarant regarding the support for the challenged claims in the priority documents, and specifically addressed Petitioner’s contention (Pet. Reply¹ 1–4) that Patent Owner did not make a showing of support for all limitations of the challenged claims, including the “determining” limitations. Dec. 31–33.

1. Paper 36, redacted public version Paper 54 (“Pet. Reply”).

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Each challenged claim includes a method step limitation requiring “determining, based on a direction of the intra prediction mode, both whether to perform filtering on at least one predicted pixel adjacent to a boundary of the prediction block and a location of the at least one predicted pixel on which the filtering is performed.” Ex. 1001, 19:23–37 (claim 1); 20:22–26 (claim 7); 20:44–48 (claim 8) (collectively “the ‘determining’ limitations”). Petitioner argues that we “never addressed the merits of Petitioner’s arguments regarding the ‘determining’ limitation[s].” Req. Reh. 2–3 (citing Petition², 14–15; Petitioner’s Reply, 3). The cited portion of the Petition is entitled “Limitations of Challenged Claims without Written Description Support,” and lists limitations of the claims, including the “determining” limitations. Pet. 13–14. The Petition, through added emphasis in the quotation of the claim limitations and in a short summary of the arguments following, stresses that “each challenged independent claim requires filtering to be performed on **predicted pixels**” and that “the resultant **filtered prediction block** would be understood to be a block that comprises the at least one **filtered predicted pixel**, and it is this filtered prediction block that is used to generate” a restored or residual block. *Id.* at 14–15. The Petition continues by stating “*these features* are not disclosed by the priority applications,” and then provides an extended discussion regarding whether filtering of predicted pixels or generating a restored or residual block based on a filtered prediction block is disclosed in the priority documents. *Id.* at 15–34 (emphasis added); see Ex. 1008 ¶¶ 51–87. The cited portion of the Reply

2. Paper 1 (“Pet.”).

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does not present or expand on any arguments related specifically to the “determining” limitations beyond these issues. Pet. Reply 3 (generally asserting that Patent Owner had not demonstrated support for the “determining” limitations). Thus, aside from arguments regarding the filtering and the use of the resultant filtered prediction block, which were addressed in the Decision, we do not find Petitioner presented any specific argument regarding the “determining” limitations that we overlooked.

Additionally, while Petitioner contends in the Request that the Decision did not address whether the “determining” limitations were supported by the priority applications, the Decision cites Patent Owner’s Sur-Reply³ and its included citations to the Patent Owner’s Response⁴, to Patent Owner’s declarant’s supplemental declaration⁵, to the asserted priority document⁶, and to the ’577 patent.⁷ Dec. 32–33 (citing, *inter alia*, PO Sur-Reply 12–13; PO Resp. 5, 11; Ex. 2024 ¶ 26; Ex. 1018 ¶¶ 9–11; Ex. 1001, 2:17–23). Each

3. Paper 39, redacted public version Paper 55 (“PO Sur-Reply”).

4. Paper 32, redacted public version Paper 53 (“PO Resp.”).

5. Ex. 2024, Supplemental Declaration of Dr. Dan Schonfeld.

6. Ex. 1018, a certified translation of PCT/KR2012/003125, filed April 23, 2012.

7. As detailed in the Decision, we determined citations to the ’577 patent were relevant as the specification there appeared to be materially the same as the alleged priority document (Ex. 1018), and Patent Owner provided parallel citations to that document (PO Sur-Reply 12–16). Dec. 30 n.4.

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of these citations provides support for the “determining” limitations, and supports our finding that the challenged claims were entitled to the earlier priority date. Dec. 26–33.

In light of our discussion of Patent Owner’s showing of support for all limitations, our inclusion of references to the arguments and evidence in the Decision, and the lack of any showing of any argument relating to the “determining” limitations that was not addressed, we are not persuaded that we overlooked evidence or argument by Petitioner that the claims were not supported by the priority document.

B. Legal Standard for Written Description

Petitioner argues that we deviated from the proper legal framework in our reasoning relating to our determination that the claims were entitled to the date of the PCT application⁸ to which a priority claim was made. Reh. Req. 1, 8–13. Petitioner argues that “the Decision found sufficient disclosure of a readily recognizable **variant** of what was claimed.” *Id.* at 8. Petitioner characterizes the decision as “plainly” making a finding that the claimed subject matter was “‘permissible’ . . . [but] admittedly not ‘disclosed.’” *Id.* at 10. However, as we addressed in the Decision, Petitioner’s arguments relating to the support Patent Owner showed in the PCT application relied generally on attorney argument and did not present any contravening testimony. Dec. 28–30. Petitioner argued that the support

8. WO 2012/144876A2 (translation and original provided in Ex. 1018); *see* Ex. 1001, code (63), 1:9–17.

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Patent Owner showed was “beyond the invention’s scope, untethered to the disclosure, and unsupported by objective evidence,” but, upon consideration of the record, we did not agree. *Id.* (quoting Pet. Reply 15).

Petitioner argues that the Decision finds sufficient disclosure of a “readily recognizable variant” and “acknowledges that the challenged claims’ limitations are not disclosed in the four corners” of the asserted priority document. Reh. Req. 8, 10. Petitioner asserts that “[t]he conclusion that Patent Owner proposed a variant is immediately recognizable from Dr. Scho[n]feld’s testimony” and describes part of Dr. Schonfeld’s testimony which includes an alternative version of Figure 11 of the PCT application. *Id.* at 11. Petitioner argues that “the depicted ‘equivalent embodiment of FIG. 11’ is a conjured **variation of what was disclosed** and not taught in the priority documents.” *Id.* Petitioner concludes that this “**undisclosed** ‘equivalent’ . . . is on its face insufficient for priority . . . because it was undisputedly not part of the priority documents.” *Id.*

However, while the figure provided in Dr. Schonfeld’s declaration was not present in the PCT application, Dr. Schonfeld’s testimony was that “the disclosure of the PCT Application contemplated applying the disclosed in-loop filter to the predicted block” as depicted in Dr. Schonfeld’s figure. Ex. 2024 ¶¶ 48–49. While Petitioner focuses on the embodiment of Figure 11 and on the illustration produced by Dr. Schonfeld being absent from the PCT Application, as discussed in the Decision our focus was on the “broader invention” while considering the complexity and predictability

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of the relevant technology as testified to by Dr. Schonfeld, including with the aid of his illustration. Dec. 28–30. Our determination was that Patent Owner’s expert’s un rebutted testimony set forth what was reasonably conveyed in the priority documents. *Id.*

The Decision discusses, and does not overlook, Petitioner’s argument that Patent Owner’s written description contentions were premised on what would have been obvious, and the Decision specifically noted that “Patent Owner does not make an obviousness argument.” *Id.* at 29. To the extent that Petitioner points out specific language in the Decision to assert that we used a newly-created “readily recognize” test, we reiterate that our determination was based only on the uncontested testimony of Dr. Schonfeld regarding what was disclosed within the four corners of the specification from the perspective of a person of ordinary skill in the art. *See id.* at 29–30.

IV. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated that we misapprehended or overlooked any matters in the Decision.

V. ORDER

Upon consideration of the record before us, it is:

ORDERED that the Petitioner’s Request for Rehearing is denied.

**APPENDIX E —
STATUTORY PROVISIONS INVOLVED**

35 U.S.C. § 312. Petitions

Effective: September 16, 2012

(a) Requirements of Petition.--A petition filed under section 311 may be considered only if--

- (1) the petition is accompanied by payment of the fee established by the Director under section 311;
- (2) the petition identifies all real parties in interest;
- (3) the petition identifies, in writing and with particularity, 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, including--
 - (A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and
 - (B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions;
- (4) the petition provides such other information as the Director may require by regulation; and
- (5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4)

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to the patent owner or, if applicable, the designated representative of the patent owner.

(b) Public Availability.--As soon as practicable after the receipt of a petition under section 311, the Director shall make the petition available to the public.

* * *

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35 U.S.C. § 314. Institution of inter partes review

Effective: September 16, 2012

(a) **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.

(b) **Timing.**--The Director shall determine whether to institute an inter partes review under this chapter pursuant to a petition filed under section 311 within 3 months after--

(1) receiving a preliminary response to the petition under section 313; or

(2) if no such preliminary response is filed, the last date on which such response may be filed.

(c) **Notice.**--The Director shall notify the petitioner and patent owner, in writing, of the Director's determination under subsection (a), and shall make such notice available to the public as soon as is practicable. Such notice shall include the date on which the review shall commence.

(d) **No Appeal.**--The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.

* * *

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35 U.S.C. § 315. Relation to other proceedings or actions

Effective: September 16, 2012

(a) Infringer's Civil Action.--

(1) Inter partes review barred by civil action.--An inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.

(2) Stay of civil action.--If the petitioner or real party in interest files a civil action challenging the validity of a claim of the patent on or after the date on which the petitioner files a petition for inter partes review of the patent, that civil action shall be automatically stayed until either--

(A) the patent owner moves the court to lift the stay;

(B) the patent owner files a civil action or counterclaim alleging that the petitioner or real party in interest has infringed the patent; or

(C) the petitioner or real party in interest moves the court to dismiss the civil action.

(3) Treatment of counterclaim.--A counterclaim challenging the validity of a claim of a patent does not constitute a civil action challenging the validity of a claim of a patent for purposes of this subsection.

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(b) Patent Owner's Action.--An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

(c) Joinder.--If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

(d) Multiple Proceedings.--Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.

(e) Estoppel.--

(1) Proceedings before the Office.--The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision

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under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

(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.