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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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May 27, 2025

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90019618
PATENT NO. : 9269208
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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In re Burke :
U.S. Patent No.: 9,269,208 B2 : **DECISION**
Ex Parte Reexamination Proceeding : **ON**
Control No.: 90/019,618 : **PETITION**
Filed: August 9, 2024 :

This decision addresses patent owner's January 3, 2025 petition entitled "Patent Owner's Petition to Vacate Reexamination Order Pursuant to 37 C.F.R. §§ 1.181(a) and 35 U.S.C. § 315(e)(1)" and requester's January 24, 2025 paper entitled "Opposition to Patent Owner's Petition to Vacate *Ex Parte* Reexamination Order of U.S. Patent No. 9,269,208." This decision also addresses patent owner's February 7, 2025 paper entitled "Patent Owner's Additional Statement in Response to Requestor's Opposition to Petition to Vacate Reexamination Order Pursuant to 37 C.F.R. §§ 1.181(a) and 35 U.S.C. § 315(e)(1)."

Patent owner's January 3, 2025 petition and February 7, 2025 paper, requester's January 24, 2025 opposition, and the record as a whole are before the Office of Patent Legal Administration for consideration.

PERTINENT BACKGROUND

- On February 23, 2016, U.S. Patent Number 9,269,208 B2 (the '208 patent) issued from Application 13/572,166 to Burke with claims 1-13. According to Office records, the '208 patent is currently assigned to CPC Patent Technologies Pty Ltd (CPC or patent owner).

District Court Proceedings Involving the '208 Patent

- On February 23, 2021, CPC filed a complaint in the United States District Court for the Western District of Texas asserting at least claim 10 of the '208 patent against Apple Inc.[1] On April 27,

[1] *See CPC Pat. Techs. Pty Ltd. v. Apple Inc.*, 6:21-cv-00165, Document 1, p. 5 (W.D. Tex., Feb. 23, 2021).

2022, the case was transferred to the United States District Court for the Northern District of California.[2]

- On February 23, 2021, CPC filed a complaint in the United States District Court for the Western District of Texas asserting at least claim 10 of the '208 patent against HMD Global Oy.[3]

- On May 23, 2022, ASSA ABLOY AB filed a declaratory judgment action against CPC in the United States District Court for the District of Connecticut alleging noninfringement of the '208 Patent.[4]

- On November 15, 2022, CPC filed a complaint in the United States District Court for the Western District of Texas asserting at least claims 1, 9, and 10 of the '208 patent against HID Global Corporation.[5]

Prior *Inter Partes* Review Proceedings Involving the '208 Patent

IPR2022-00601 (Apple Inc.)

- On February 23, 2022, Apple Inc. filed a petition for *inter partes* review (IPR) of the '208 patent, challenging claims 1, 3-7, 9-11, and 13. The IPR proceeding was assigned case number IPR2022-00601 (the '0601 IPR). The petition raised the following ground:[6]

Claims of the '208 patent	Ground
1, 3-7, 9-11, 13	Obvious over Mathiassen,[7] McKeeth,[8] and Anderson[9]

- On September 28, 2022, the Patent Trial and Appeal Board (PTAB) issued a decision granting institution of the '0601 IPR with respect to all challenged claims and all grounds asserted in the petition.[10]

- On September 27, 2023, the PTAB issued a final written decision in the '0601 IPR, concluding that claims 1, 3-7, 9-11, and 13 of the '208 patent had been shown to be unpatentable as obvious over Mathiassen, McKeeth, and Anderson.[11]

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[2] *See CPC Pat. Techs. Pty Ltd. v. Apple Inc.*, 3:22-cv-02553-NC, Document 93 (N.D. Cal., Apr. 27, 2022). On September 6, 2022, the court entered an order staying the case in view of the PTAB proceedings (Document 142), and, on May 16, 2024, continued the stay until May 15, 2025 (Document 156).

[3] *See CPC Pat. Techs. Pty Ltd. v. HMD Global Oy*, 6:21-cv-00166, Document 1, pp. 4-5 (W.D. Tex., Feb. 23, 2021). On June 5, 2023, the court entered an order cancelling trial (Document 181).

[4] *See Assa Abloy AB, et. al. v. CPC Pat. Techs. Pty Ltd., et. al.*, 3:22-cv-00694, Document 1, p. 1 (D. Conn., May 23, 2022). On November 30, 2022, the court entered an order staying the case in view of the PTAB proceedings (Document 55), and, on February 22, 2024, continued the stay pending appeal of the PTAB decisions (Document 68).

[5] *See CPC Pat. Techs. Pty Ltd., et. al. v. HID Glob. Corp.*, 6:22-cv-01170, Document 1, p. 15 (W.D. Tex., Nov. 15, 2022). On February 22, 2023, the court entered an order staying the case in view of the PTAB proceedings, and, on October 4, 2024, continued the stay pending appeal of the PTAB decisions (Document 42).

[6] *Apple Inc. v. CPC Patent Technologies Pty, Ltd.*, IPR2022-00601, Paper 1, p. 4 (PTAB Feb. 23, 2022).

[7] U.S. Patent Application Publication No. US 2004/0123113 A1 to Mathiassen *et. al.*, published June 24, 2004 (**Mathiassen**).

[8] U.S. Patent No. 6,766,456 B1 to McKeeth, issued July 20, 2004 (**McKeeth**).

[9] U.S. Patent No. 6,509,847 B1 to Anderson, issued Jan. 21, 2003 (**Anderson**).

[10] IPR2022-00601, Paper 11, p. 50 (PTAB Sept. 28, 2022).

[11] IPR2022-00601, Paper 31, pp. 63-64 (PTAB Sept. 27, 2023).

- On October 27, 2023, CPC filed a request for Director Review of the final written decision in the '0601 IPR,[12] which was denied.[13]

- On December 18, 2023, 2024, CPC filed a notice of appeal to the United States Court of Appeals for the Federal Circuit (Federal Circuit) from the final written decision in the '0601 IPR.[14]

IPR2022-01045 and IPR2022-01089 (ASSA ABLOY AB and HID Global Corp., et. al.)

- On June 3, 2022, ASSA ABLOY AB and its wholly owned subsidiaries (petitioner), including HID Global Corporation, filed two petitions for IPR of the '208 patent, challenging claims 1-9 and 10-13. The IPR proceedings were assigned case numbers IPR2022-01045 (the '1045 IPR) and IPR2022-01089 (the '1089 IPR). The petitions raised the following grounds:[15]

Claims of the '208 patent	Grounds
1, 3-5, 9	Obvious over Bianco[16] and Mathiassen-067[17]
2, 6, 7	Obvious over Bianco, Mathiassen-067, and Houvener[18]
8	Obvious over Bianco, Mathiassen-067, Houvener, and Richmond[19]
10-13	Obvious over Bianco and Mathiassen-067

- On January 3, 2023, the PTAB issued a single decision addressing both the '1045 IPR and the '1089 IPR, granting institution with respect to all challenged claims and all grounds asserted in the petitions.[20]

- On December 20, 2023, the PTAB issued a final written decision addressing both the '1045 IPR and the '1089 IPR (the first final written decision), concluding that claims 1-13 of the '208 patent had not been shown to be unpatentable.[21]

- On January 18, 2024, petitioner filed a request for Director Review.[22] On March 15, 2024, the Director granted the request, vacated the first final written decision, and remanded to the PTAB panel for further proceedings.[23]

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[12] IPR2022-00601, Paper 32 (PTAB Oct. 27, 2023).
[13] IPR2022-00601, Paper 33 (PTAB Nov. 6, 2023).
[14] IPR2022-00601, Paper 34 (PTAB Dec. 18, 2024). The case was docketed as *CPC Patent Technologies Pty Ltd. v. Apple Inc.*, Docket No. 24-1278 (Fed. Cir. Dec. 21, 2023), and is currently pending.
[15] *ASSA ABLOY AB et al. v. CPC Patent Technologies Pty Ltd.*, IPR2022-01045, Paper 3, p. 4 (PTAB June 3, 2022) and *ASSA ABLOY AB et al. v. CPC Patent Technologies Pty Ltd.*, IPR2022-01089, Paper 3, p. 4 (PTAB June 3, 2022).
[16] U.S. Patent No. 6,256,737 B1 to Bianco *et. al.*, issued July 3, 2001 (**Bianco**).
[17] WIPO International Publication No. WO 02/28067 A1, published Apr. 4, 2002 (**Mathiassen-067**); note, the designator "Mathiassen-067" is used to avoid confusion with the Mathiassen US 2004/0123113 reference presented in IPR2022-00601.
[18] U.S. Patent No. 5,790,674 to Houvener *et. al.*, issued Aug. 4, 1998 (**Houvener**).
[19] U.S. Patent No. 6,856,237 B1 to Richmond *et. al.*, issued Feb. 15, 2005 (**Richmond**).
[20] IPR2022-01045, Paper 21, p. 55 (PTAB Jan. 3, 2023); IPR2022-01089, Paper 21, p. 55 (PTAB Jan. 3, 2023).
[21] IPR2022-01045, Paper 42, p. 92-93 (PTAB Dec. 20, 2023); IPR2022-01089, Paper 42, p. 92-93 (PTAB Dec. 20, 2023).
[22] IPR2022-01045, Paper 43 (PTAB Jan. 18, 2024); IPR2022-01089, Paper 43 (PTAB Jan. 18, 2024).
[23] IPR2022-01045, Paper 44 (PTAB Mar. 15, 2024); IPR2022-01089, Paper 44 (PTAB Mar. 15, 2024).

- On August 13, 2024, the PTAB issued a final written decision on remand addressing both the '1045 IPR and the '1089 IPR (second final written decision), again concluding that claims 1-13 of the '208 patent had not been shown to be unpatentable.[24]

- On October 14, 2024, petitioner filed a notice of appeal to the Federal Circuit from the second final written decision in the '1045 IPR and the '1089 IPR.[25]

Present *Ex Parte* Reexamination Proceeding

90/019,618 (HID Global Corporation)

- On August 9, 2024, HID Global Corporation (requester) deposited a request for *ex parte* reexamination of claims 1-13 of the '208 patent (the request). The reexamination proceeding was assigned control number 90/019,618 (the present reexamination proceeding) and was accorded a filing date of August 9, 2024. The request raised the following grounds:[26]

Claims of the '208 patent	Grounds
1, 4, 5, 9	Obvious over Catalano[27] and Ikegami[28]
2, 3, 6, 7, 10-13	Obvious over Catalano, Ikegami, and Sands[29]
6, 7	Obvious over Catalano, Ikegami, Sands, and Siegel[30]
8	Obvious over Catalano, Ikegami, Sands, Siegel, and Fitzgibbon[31]
1-7, 9-13	Obvious over Sands and Ikegami
6, 7	Obvious over Sands, Ikegami, and Siegel
8	Obvious over Sands, Ikegami, Siegel, and Fitzgibbon

- On November 4, 2024, reexamination was ordered.[32] The CRU Examiner (the examiner) found that each of the grounds in the request raises a substantial new question of patentability (SNQ).[33]

- On January 3, 2025, patent owner filed a petition entitled "Patent Owner's Petition to Vacate Reexamination Order Pursuant to 37 C.F.R. §§ 1.181(a) and 35 U.S.C. § 315(e)(1)" (petition).

- On January 24, 2025, requester filed a paper entitled "Opposition to Patent Owner's Petition to Vacate Ex Parte Reexamination Order of U.S. Patent No. 9,269,208" (opposition).

- On February 7, 2025, patent owner filed a paper entitled "Patent Owner's Additional Statement

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[24] IPR2022-01045, Paper 59, p. 105-06 (PTAB Aug. 13, 2024); IPR2022-01089, Paper 59, p. 105-06 (PTAB Aug. 13, 2024).

[25] IPR2022-01045, Paper 60 (PTAB Oct. 14, 2024); IPR2022-01089, Paper 60 (PTAB Oct. 14, 2024). The cases were docketed as *Assa Abloy AB v. CPC Patent Technologies Pty Ltd.*, Docket No. 25-1079 and Docket No. 25-1080 (Fed. Cir. Oct. 21, 2024), and are currently pending

[26] *See* "Request For Ex Parte Reexamination," filed August 9, 2024, p. 25-26.

[27] U.S. Patent No. 6,766,040 B1 to Catalano *et. al.*, issued July 20, 2004 (**Catalano**).

[28] U.S. Patent Application Publication No. US 2001/0036297 A1 to Ikegami *et al.*, published Nov. 1, 2001 (**Ikegami**).

[29] U.S. Patent Application Publication No. US 2004/0148526 A1 to Sands *et al.*, published July 29, 2004 (**Sands**).

[30] U.S. Patent Application Publication No. US 2003/0200446 A1 to Siegel *et al.*, published Oct. 23, 2003 (**Siegel**).

[31] U.S. Patent Application Publication No. US 2003/0210131 A1 to Fitzgibbon *et al.*, published Nov. 13, 2003 (**Fitzgibbon**).

[32] *See* "Order Granting Request for *Ex Parte* Reexamination," Nov. 4, 2024 (order).

[33] *See* order, pp. 7-14.

in Response to Requestor's Opposition to Petition to Vacate Reexamination Order Pursuant to 37 C.F.R. §§ 1.181(a) and 35 U.S.C. § 315(e)(1)" (response).

STATUS OF THE CLAIMS

The '208 patent issued with claims 1-13. In the present reexamination proceeding, claims 1-13 are subject to reexamination. Claims 1, 9, and 10 are the independent claims.

DECISION

I. Waiver of 37 CFR 1.540

Patent owner's January 3, 2025 petition is being construed as a combined petition that includes: (i) a petition under 37 CFR 1.183, requesting waiver of the necessary rules to permit entry and consideration of patent owner's January 3, 2025 combined petition prior to examination, and (ii) a petition under 37 CFR 1.181 to vacate the order granting reexamination on the basis of 35 U.S.C. 315(e)(1) estoppel.

37 CFR 1.540, in pertinent part, provides:

> No submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.

Patent owner's petition was filed after the November 4, 2024 order granting *ex parte* reexamination but prior to the issuance of a non-final action on the merits. Permitting patent owner to call attention to potential issues involving 35 U.S.C. 315(e)(1) serves an important purpose in ensuring that the proceeding is statutorily authorized. Accordingly, in view the specific facts and circumstances of the present case, patent owner's petition under 37 CFR 1.183 is **granted**. The provisions set forth in the second sentence of 37 CFR 1.540 are hereby waived to permit entry and consideration of patent owner's January 3, 2025 petition addressing 35 U.S.C. 315(e)(1) estoppel. Patent owner's § 315(e)(1) petition has been entered and considered as set forth in section IV of this decision.

Furthermore, requester is permitted to file a paper in opposition to a patent owner petition requesting termination of the present reexamination proceeding on the basis of § 315(e)(1) estoppel, just as the requester is permitted to file a paper in opposition to a patent owner petition to vacate a reexamination order under 35 U.S.C. 304 (and deny reexamination) on the basis that the order is an *ultra vires* action on the part of the Office.[34] Accordingly, the opposition has been entered and considered to the extent it addresses patent owner's arguments regarding 35 U.S.C. 315(e)(1).

II. Patent owner's February 7, 2025 paper

After requester's opposition, patent owner filed the February 7, 2025 response to address certain aspects of the opposition. After an opposition to a patent owner petition is filed by a third party requester (regardless of whether such opposition has an entry right or not) any further paper in opposition, rebuttal, or response to the third party requester opposition paper is improper and will not

[34] *See, e.g.*, MPEP § 2246, subsection II.

be considered, as there is a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination.[35] Therefore, patent owner's February 7, 2025 response is an **improper paper** and it will not be made of record in the file of the present reexamination proceeding. In view of the above, the arguments in the February 7, 2025 response **will not be considered**. Because the February 7, 2025 patent owner paper has been scanned into the electronic Image File Wrapper (IFW) of the 90/019,618 proceeding, the paper is being **expunged** by marking it "closed" and "non-public" in the IFW, and it will not constitute part of the record of the present reexamination proceeding.

III. Requirements for certification pursuant to 37 CFR 1.150(b)(6)

37 CFR 1.510(b), in pertinent part, provides:

> Any request for reexamination must include the following parts:
>
> *
>
> *
>
> (6) A certification by the third party requester that the statutory estoppel provisions of 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) do not prohibit the requester from filing the *ex parte* reexamination request.

35 U.S.C. 315(e)(1) provides:

> 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 under [35 U.S.C.] 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.

Requester deposited a certification with the request in the present reexamination proceeding, pursuant to 37 CFR 1.510(b)(6). 37 CFR 1.510(b)(6) requires the requester to submit, with its request, a certification that the statutory estoppel provisions of 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) do not prohibit the requester from filing the *ex parte* reexamination request. A certification under 37 CFR 1.510(b)(6) is either proper or improper. If any part of the certification is improper, then the entire certification is improper. If the Office determines that any part of requester's certification pursuant to 37 CFR 1.510(b)(6) is improper, the Office will vacate the entire proceeding, including the filing date of the reexamination proceeding.

IV. The estoppel provisions of 35 U.S.C. 315(e)(1) apply to requester

Whether estoppel under 35 U.S.C. 315(e)(1) applies to a claim requested to be reexamined on any of the grounds raised in an *ex parte* reexamination proceeding may be analyzed by determining:[36]

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[35] *See* MPEP § 2267.

[36] The four elements set forth in this decision are found in the language of the statute, 35 U.S.C. 315(e).

1. Whether the third party requester of the *ex parte* reexamination proceeding was a petitioner in the *inter partes* review, or was a real party in interest or a privy of the petitioner;

2. Whether the claim(s) of the patent under *inter partes* review are also requested to be reexamined in the *ex parte* reexamination proceeding;

3. Whether the *inter partes* review has resulted in a final written decision pursuant to 35 U.S.C. 318(a); and

4. Whether the ground(s) raised in the *ex parte* reexamination proceeding are the ground(s) that were raised or reasonably could have been raised by the requester during the *inter partes* review.

A. The record sufficiently shows that element 1 is satisfied

To satisfy element 1, the record must sufficiently show that the third party requester of the present reexamination proceeding was a petitioner in the *inter partes* review, or was a real party in interest or a privy of the petitioner.

Patent owner alleges "there is no dispute that [requester] HID was a petitioner and a real-party-in-interest in the ['1045 IPR and the '1089 IPR]".[37] The record shows, and requester admits,[38] that the third party requester of the present reexamination proceeding, HID Global Corporation, was a petitioner in the '1045 IPR and the '1089 IPR. Accordingly, the record shows that element 1 has been satisfied.

B. The record sufficiently shows that element 2 is satisfied

To satisfy element 2, the record must sufficiently show that the claims of a patent under *inter partes* review are also requested to be reexamined in the present reexamination proceeding.[39]

Claims 1-13 of the '208 patent are requested to be reexamined in the present reexamination proceeding. Patent owner alleges,[40] and the record shows,[41] that claims 1-13 of the '208 patent were also under review in the '1045 IPR (claims 1-9) and the '1089 IPR (claims 10-13). Accordingly, the record shows that element 2 has been satisfied.

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[37] Petition, p. 7.

[38] Request, p. 20.

[39] The Federal Circuit has specifically held that 35 U.S.C. 315(e)(1) applies on a claim-by-claim basis. In *Credit Acceptance v. Westlake Servs.*, 859 F.3d 1044, 1052-53 (Fed. Cir. 2017), the Federal Circuit explained (emphasis original):

> On its face, the relevant IPR estoppel statute, § 315(e)(1) . . . applies on a claim-by-claim basis. It provides, "[t]he petitioner in an inter partes review *of a claim* in a patent . . . that results in a final written decision under section 318(a) . . . may not request or maintain a proceeding before the Office *with respect to that claim* . . . ." 35 U.S.C. § 315(e)(1) (emphasis added). There is no IPR estoppel with respect to a claim as to which no final written decision results.

[40] Petition, p. 7.

[41] *See* IPR2022-01045, Paper 21, p. 55 (PTAB Jan. 3, 2023); IPR2022-01089, Paper 21, p. 55 (PTAB Jan. 3, 2023).

C. The record sufficiently shows that element 3 is satisfied

To satisfy element 3, the record must sufficiently show that the *inter partes* review has resulted in a final written decision pursuant to 35 U.S.C. 318(a). The record shows that a first final written decision pursuant to 35 U.S.C. 318(a) regarding claims 1-13 of the '208 patent was rendered by the PTAB in the '1045 IPR and the '1089 IPR on December 20, 2023,[42] and the Director subsequently vacated the PTAB's first final written decision and remanded to the PTAB panel for further proceedings on March 15, 2024.[43] The record further shows that a second final written decision pursuant to 35 U.S.C. 318(a) regarding claims 1-13 of the '208 patent was rendered by the PTAB in the '1045 IPR and the '1089 IPR on August 13, 2024.[44]

Requester filed the instant request for *ex parte* reexamination of claims 1-13 of the '208 patent on August 9, 2024, after the first final written decision in the '1045 IPR and the '1089 IPR was vacated and remanded, but before the second final written decision was issued. Requester argues that it "is not estopped from challenging claims 1-13 of the '208 Patent in [the present reexamination proceeding]" because "there is no operative Final Written Decision to estop Requester from seeking to challenge the claims [of the '208 patent]."[45] Requester notes that the PTAB's first final written decision was vacated and remanded by the Director and alleges that the "vacated decision lacks operational force."[46] "Because there are no final written decisions in the IPRs [as of the filing date of the reexamination request]," requester alleges "an essential element for IPR estoppel is absent here."[47]

Requester's arguments regarding the effect of the vacated final written decision on § 315(e)(1) estoppel are not persuasive. As argued by patent owner,[48] the Federal Circuit held in *Intuitive Surgical, Inc. v. Ethicon LLC,* 25 F.4th 1035 (Fed. Cir. 2022) that the estoppel provisions of 35 U.S.C. 315(e)(1) are effective once an IPR concludes with *issuance* of a final written decision.[49] *Intuitive Surgical* explains that the plain language of § 315(e) cannot be ignored based on other circumstances.[50] Therefore, § 315(e)(1) estoppel attached upon *issuance* of the first final written decision on claims 1-13 of the '208 patent.

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[42] *See* IPR2022-01045, Paper 42, p. 92-93 (PTAB Dec. 20, 2023); IPR2022-01089, Paper 42, p. 92-93 (PTAB Dec. 20, 2023).

[43] IPR2022-01045, Paper 44 (PTAB Mar. 15, 2024); IPR2022-01089, Paper 44 (PTAB Mar. 15, 2024).

[44] IPR2022-01045, Paper 59, p. 105-06 (PTAB Aug. 13, 2024); IPR2022-01089, Paper 59, p. 105-06 (PTAB Aug. 13, 2024).

[45] Request, p. 20.

[46] *Id.*

[47] Request, p. 21.

[48] Petition, pp. 8-10.

[49] *See Intuitive Surgical* at 1041. *See also id.* at 1041-43 ("The plain language of § 315(e)(1) is clear that estoppel is triggered when an IPR proceeding results in a final written decision. . . . Subsection 315(e)(1) expressly states that, once the Board issues a final written decision addressing the patentability of the claims of a patent, '[t]he petitioner . . . may not request or maintain a proceeding' challenging those same claims before the Board on grounds that it 'raised or reasonably could have raised during that inter partes review.' That means that, regardless of when the Board memorializes its conclusion that § 315(e)(1) bars a proceeding, the estoppel is effective as of the issuance of the prior written decision. To read § 315(e)(1) otherwise would eviscerate the 'maintain a proceeding' language in the statute.").

[50] *Cf. Click-To-Call Techs., LP v. Ingenio, Inc., YellowPages.com, LLC*, 899 F.3d 1321, 1328 (Fed. Cir. 2018), *vacated on other grounds and remanded sub nom. Thryv, Inc v. Click-To-Call Techs., LP*, 140 S. Ct. 1367 (2020) (holding the PTAB erred in interpreting 35 U.S.C. 315(b) such that the voluntary dismissal without prejudice of the civil action in which the complaint was served "does not trigger" the time-bar). In *Click-To-Call*, the Federal Circuit explained, "Congress [] demonstrated that it knew how to provide an exception to the time bar by including a second sentence in the provision: 'The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).' 35 U.S.C. § 315(b). Similarly, Congress could have chosen to include a variation of the phrase 'unless the action in

Requester argues that patent owner mischaracterized the *Intuitive Surgical* holding, because, according to requester, "[t]he Court specifically indicated that a decision is considered final when it terminates the litigation between the parties . . . and leaves nothing to be done but to enforce by execution what has been determined."[51] Requester further argues "[n]o such finality attached to the vacated [first] Final Written Decision because the Director did not terminate the litigation between the parties—instead, the Director vacated and remanded the decision, and authorized the parties 'to file supplemental briefing . . . .'"[52] However, the portion of the *Intuitive Surgical* decision cited here by requester is addressing the Federal Circuit's jurisdiction under 28 U.S.C. 1295 to review the PTAB's estoppel decision, not the meaning of "final written decision" as applied in § 315(e)(1). The Federal Circuit held "that the plain language of § 1295(a)(4)(A) permits appeal where the adverse judgment is a decision of the Board . . . with respect to an inter partes review proceeding . . . [and] also final, as the judgment terminate[s] the IPR proceeding with respect to a party."[53] Thus, requester's arguments regarding *Intuitive Surgical* are not persuasive to demonstrate that § 315(e)(1) estoppel would not attach upon issuance of the first final written decision.

Regarding the Director vacating the first final written decision, requester's attempt to distinguish the Office's decision in *Frankland* (*ex parte* reexamination proceeding control number 90/019,070) from the circumstances of the present reexamination proceeding is not persuasive.[54] Requester argues that, because the *Frankland* decision "only addresses a final written decision vacated *by the Federal Circuit,*" "the holding in [*Frankland*] does not presume to say that a decision vacated by the Director of the Office constitutes a final decision for the purposes of estoppel."[55] The Office acknowledges the procedural posture regarding the final written decision vacatur in *Frankland* (i.e., final decision vacated and remanded by the Federal Circuit) differs from the vacatur of the present reexamination proceeding (i.e., final decision vacated and remanded by the Director). Nevertheless, § 315(e)(1) estoppel attached upon issuance of the first final written decision on claims 1-13 irrespective of the Director vacating that first final written decision and remanding to the PTAB for further proceedings in '1045 IPR and the '1089 IPR.

Under the PTAB's rules, a dissatisfied party may file a single request for either rehearing or Director review of a final written decision.[56] The Office acknowledges that, for purposes of appeal or civil action, filing a request for rehearing or a request for Director review renders a "final written decision" non-final and, therefore, unappealable.[57] Estoppel under § 315(e)(1), however, attaches as soon as

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which the complaint was served was later dismissed without prejudice,' but it did not do so. . . . Congress did not contemplate subsequent events 'nullifying' § 315(b)'s time bar."). *Click-To-Call* at 1331.

[51] Opposition, p. 5 (emphasis and internal quotations omitted) (citing *Intuitive Surgical,* 25 F.4th at 1040 (Fed. Cir. 2022)).

[52] Opposition, p. 5.

[53] *Intuitive Surgical,* 25 F.4th at 1039-40 (Fed. Cir. 2022) (internal quotation marks omitted).

[54] Opposition, p. 6 (citing "Decisions on Petitions," issued May 26, 2023 in 90/019,070 (applying *Intuitive Surgical* to find § 315(e)(1) attached upon issuance of a final written decision that was subsequently vacated by the Federal Circuit) (*Frankland*)).

[55] Opposition, p. 6 (emphasis original).

[56] Petitioner's request for Director review was filed under the PTAB's Revised Interim Director Review Process. *See* IPR2022-01006, paper 48, p. 2. The Revised Interim Director Review Process provided Director review "in lieu of filing a request for rehearing by the Board under 37 C.F.R. §42.71(d)." *See* PTAB Director Review process webpage, "Superseded - Revised Interim Director Review Process," https://www.uspto.gov/patents/ptab/decisions/director-review-process. The PTAB's Director Review process has since been codified in the rules, and includes similar language. *See* 37 CFR 42.75(c) ("A party to a proceeding under this part may file one request for Director Review of a decision as provided in paragraph (a) of this section, instead of filing a request for rehearing of that decision pursuant to § 42.71(d) . . . .").

[57] *See ICC v. Brotherhood of Locomotive Engineers*, 482 U.S. 270, 284-85 (1987); 37 C.F.R. § 90.3(b).

the *inter partes* review has "result[ed] in" a decision.[58] Congress could have used clear language in the § 315(e)(1) statute that provides for estoppel only after final agency action, but it did not.[59] Thus, Congress was more concerned with accelerating the effect of the estoppel bar than waiting for a final decision, either from the agency or the courts. The PTAB has a one-year time limit to issue a final determination in an instituted proceeding.[60] Connecting estoppel to a final written decision that is required to be issued within this time window provides predictability and certainty, and is consistent with the AIA's goal of providing an efficient, lower cost alternative to district court litigation.[61] A further purpose of the § 315(e)(1) estoppel provision is to "significantly reduce the ability to use post-grant procedures for abusive serial challenges to patents."[62] This purpose of preventing abuse would be thwarted if it were permissible for a petitioner to file a serial challenge to the same patent in the form of a reexamination request in the window of time between a final written decision being vacated and the PTAB issuing a decision on remand. Additionally, unlike the pre-AIA estoppel provision, Congress made the § 315(e)(1) estoppel bar indifferent to outcome.[63] Therefore, the plain language of § 315(e)(1), taken along with the Congressional intent behind the statute, demonstrate that estoppel should not be delayed until the rehearing request or Director review request has been addressed. The Office has, in several instances, applied the § 315(e)(1) bar based upon issuance of the initial final written decision, independent of any pending or possible rehearing request.[64]

Requester provides no persuasive arguments, binding legal precedent, or legal authority to demonstrate that the holding in *Intuitive Surgical* does not equally apply in the circumstances of the present reexamination proceeding. Requester cites to three decisions, rendered by courts other than the Federal Circuit, to support its position that vacatur by the Director strips the final written decision of legal operative force for purposes of estoppel under § 315(e)(1).[65] None of these decisions lend

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[58] The Office's position regarding § 315(e)(1) estoppel in this decision is consistent with the Office's position that § 315(e)(2) estoppel attaches upon issuance of a final written decision, regardless of whether a rehearing request was filed. *See BTG Int'l Ltd. v. Amneal Pharms. LLC*, Invited Brief for the Director – U.S. Patent and Trademark Office as Amicus Curiae in Support of Neither Party, 2019 WL 493951, at *3-16. The Federal Circuit, however, did not reach this estoppel issue in its decision. *See BTG Int'l Ltd. v. Amneal Pharms. LLC,* 923 F.3d 1063 (Fed. Cir. 2019).

[59] Pre-AIA § 315(c) estoppel applied to "any claim being *finally* determined to be valid and patentable" (emphasis added), whereas § 315(e)(1) estoppel attaches after review of a claim that merely "*results* in a final written decision" (emphasis added).

[60] *See* 35 U.S.C. 316(a)(11) and 35 U.S.C. 326(a)(11).

[61] *See* S. Rep. No. 111-18, at 55 (2009) (Minority Views of Sens. Kyl, Feingold, and Coburn) (comparing AIA proceedings to the pre-AIA system that "typically takes three or four years before the PTO decides an inter partes reexamination," and "the decision can then be appealed, which can make the process last from 5 to 8 years."); 157 Cong. Rec. S1376 (Mar. 8, 2011) (Sen. Kyl) (noting that "the AIA's eliminat[ion of] administrative appeals" will "substantially accelerate the resolution of inter partes cases").

[62] 157 Cong. Rec. S936, S952 (daily ed. Feb. 28, 2011) (statement of Sen. Grassley).

[63] Compare the pre-AIA § 315(c) language of "any claim finally determined to be *valid and patentable*" (emphasis added) to the § 315(e)(1) statute that does not contain such language; *see also SiOnyx, LLC v. Hamamatsu Photonics K.K.*, 330 F. Supp. 3d 574, 600 (D. Mass. 2018) ("Defendants contend that they should not be estopped from raising grounds that were successful, because the appeal of the PTAB's decision is still pending and the estoppel provisions are meant to prevent only duplicative *abusive* challenges. But the statute makes no distinction between successful and unsuccessful grounds.").

[64] *See Facebook, Inc. v. Uniloc USA, Inc.*, IPR2017-01427, Paper 30 (PTAB May 29, 2018) (applying § 315(e)(1) bar based on final written decision in IPR2017-00225 during period for rehearing); *Apple Inc. v. Personalized Media Communications LLC*, 2018 WL 922376, at *2 (PTAB Feb. 15, 2018) (applying § 315(e)(1) bar based upon a separate final written decision for which a rehearing request had been filed and was "being determined concurrently"); *Valve Corp. v. Ironburg Inventions Ltd.*, 2018 WL 575390, at *1 n.4 & *4 (PTAB Jan. 25, 2018) (applying § 315(e)(1) bar based on separate final written decision with pending rehearing request); *see also Emerson Elec. Co. v. IP Co., LLC*, 2017 WL 2390705, at *1-3 (PTAB May 31, 2017) (precluding institution based on separate final written decision that was on appeal).

[65] *See* request, pp. 25-26; *see also* opposition, pp. 3-4.

support to requester's arguments. *Animal Legal Def. Fund* does not address § 315;[66] *General Access Solutions* does not address the relevant statutory language;[67] and *Power Integrations* is a non-binding district court decision.[68] Further, the district court decision in *Power Integrations* is in tension with the Federal Circuit's holding in *Intuitive Surgical* that the estoppel provisions of 35 U.S.C. 315(e)(1) are effective once an IPR concludes with *issuance* of a final written decision, as discussed above.

Moreover, the PTAB decisions cited by requester to support its argument that finality does not attach to a vacated final written decision for the purposes of § 315(e)(1) are unavailing. In *Ebates Performance Mktg.*, the PTAB determined a final written decision in a first IPR that was vacated by the Federal Circuit could not serve as the basis for collateral estoppel in a second IPR,[69] but the *Ebates* decision did not address § 315(e)(1) estoppel. In *OpenSky Indus.*, the Director determined that petitioner OpenSky Industries, LLC "abused the [IPR] process in an attempt to extract payment from both [the patent owner] and Petitioner Intel, who was joined to the proceeding."[70] The Director had "previously dismissed OpenSky from this proceeding, subject to the Director, Board, and USPTO retaining authority over the issuance of sanctions."[71] The Director vacated that previous decision dismissing OpenSky, restored OpenSky as a petitioner in the proceeding, and assessed sanctions against OpenSky for misconduct. Thus, the *OpenSky Indus.* decision only addressed vacating an order dismissing a petitioner from the proceeding, and did not specifically address the effect of vacating a final written decision on estoppel under § 315(e)(1).

Thus, requester's arguments that estoppel under § 315(e)(1) does not apply following the Director's vacatur of the final written decision and remand to the PTAB panel for further proceedings in this instance are not persuasive. Therefore, the record shows that element 3 has been satisfied because the '1045 IPR and the '1089 IPR resulted in a final written decision on claims 1-13 of the '208 patent.[72]

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[66] In *Animal Legal Def. Fund v. Veneman*, 490 F.3d 725, 726 (9th Cir. 2007), the Animal Legal Defense Fund (ALDF) filed suit alleging that the United States Department of Agriculture's (USDA) decision not to adopt certain policies regarding the treatment of nonhuman primates under the Animal Welfare Act was arbitrary, capricious, and an abuse of discretion. The district court granted USDA's motion to dismiss, and ALDF timely appealed; a panel of the Court of Appeals for the Ninth Circuit reversed the district court. *Id.* Subsequently, a majority of the Ninth Circuit judges voted to rehear the case en banc, and ordered "[t]he three-judge panel opinion shall not be cited as precedent by or to this court or any district court of the Ninth Circuit, except to the extent adopted by the en banc court." *Animal Legal Def. Fund v. Veneman*, 482 F.3d 1156 (9th Cir. 2007). ALDF then filed a motion to dismiss, which was granted, and the en banc court ordered the opinion of the three-judge panel to be vacated. *Animal Legal Def. Fund v. Veneman*, 490 F.3d 725, 726 (9th Cir. 2007).

[67] In *Gen. Access Sols., Ltd. v. Sprint Spectrum L.P.*, No. 2:20-CV-00007, 2020 WL 12572917, at *2 (E.D. Tex. Dec. 1, 2020), defendant apparently did not dispute that the relevant IPR was "only partially final because the Federal Circuit reversed-in-part the PTAB's [final written decision] of invalidity and remanded for further [ongoing] proceedings." Thus, the Court did not address the statutory language.

[68] In *Power Integrations, Inc. v. ON Semiconductor Corp.*, 396 F.Supp.3d 851, 880 (N.D. Cal. 2019), the trial court concluded that an IPR petitioner was not estopped under 35 U.S.C. 315(e)(2) from later filing a civil action where the PTAB's final written decisions in the prior IPRs were vacated.

[69] *Ebates Performance Mktg., Inc. v. Int'l Bus. Machs. Corp.*, IPR2022-00646, Paper 56, p. 7-11 (PTAB Oct. 11, 2023) (*Ebates Performance Mktg.*).

[70] *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 127, p. 2 (PTAB Feb. 3, 2023) (*OpenSky Indus.*).

[71] IPR2021-01064, Paper 127, p. 3 (PTAB Feb. 3, 2023).

[72] Patent owner argues that element 3 is also satisfied because the '1045 IPR and the '1089 IPR resulted in a final written decision on remand regarding claims 1-13 that issued on August 13, 2024. Petition, pp. 12-14. Because the Office finds that element 3 is satisfied based on the December 20, 2023 final written decision, patent owner's arguments regarding the August 13, 2024 final written decision need not be addressed.

D. The record sufficiently shows that element 4 is satisfied

To satisfy element 4, the record must sufficiently show that the ground(s) raised in the reexamination proceeding are the same ground(s) that were raised or reasonably could have been raised by the requester during the prior *inter partes* review.[73] The record shows that the grounds raised by the requester to challenge claims 1-13 of the '208 patent in the present reexamination proceeding were not previously raised in the prior '1045 IPR and '1089 IPR with regard to claims 1-13. Therefore, this element turns on whether the grounds reasonably could have been raised by the requester during the prior *inter partes* review proceedings.

1. "Reasonably could have been raised"

As an initial matter, the issue of what prior art reasonably could have been raised need not be further addressed if the record provides evidence, for example, that a reference was known to the requester at a time when it could have been raised in the *inter partes* review. The issue of what prior art reasonably could have been raised in an earlier *inter partes* review, however, is not limited to the actual knowledge of the requester. The legislative history of the AIA defines "reasonably could have raised" as "prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover."[74] In view of the number of commercial databases available to the public, most patents and printed publications, particularly U.S. patents and U.S. patent application publications, may, in general, be expected to be discovered by a skilled searcher conducting a diligent search.

A requester may, however, provide evidence that a skilled searcher conducting a diligent search reasonably could not have been expected to discover the reference. The legislative history of the AIA clarifies that "reasonably could have raised" does not require a "scorched-earth search":[75]

> The present bill also softens the could-have-raised estoppel that is applied by *inter partes* review against subsequent civil litigation by adding the modifier "reasonably." It is possible that courts would have read this limitation into current law's estoppel. Current law, however, is also amenable to the interpretation that litigants are estopped from raising any issue that it would have been physically possible to raise in the *inter partes* reexamination, even if only a scorched-earth search around the world would have uncovered the prior art in question. Adding the modifier "reasonably" ensures that the could-have-raised estoppel extends only to that prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover.

The requester may show, for example, that a reference is an "obscure text[] unlikely to be discovered upon a reasonably diligent search of the relevant prior art."[76]

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[73] *See also* "Decision *Sua Sponte* Vacating *Ex Parte* Reexamination Request Filing Date and Dismissing Petition as Moot," issued September 10, 2020 in 90/014,535, pp. 14-16, for a discussion of Office policy regarding element 4.
[74] *See* 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).
[75] 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).
[76] *See Praxair Distribution, Inc. et al. v. INO Therapeutics, LLC*, IPR2016-00781, Paper 10, p. 9 (PTAB Aug. 25, 2016).

2. All grounds in the present request reasonably could have been raised in the prior IPR

In its opposition, requester does not present arguments to rebut patent owner's position that the grounds raised in the present reexamination proceeding reasonably could have been raised by requester during the prior '1045 IPR and '1089 IPR. Rather, requester states "Patent Owner's analysis [regarding element 4] is moot because estoppel had not attached when the Request was filed, and [element 4] only becomes relevant after estoppel attaches."[77] Accordingly, there is no evidence of record to show any of the references presented are an "obscure text[] unlikely to be discovered upon a reasonably diligent search of the relevant prior art."[78]

Further, as patent owner alleges, each of the grounds raised in the present reexamination proceeding reasonably could have been raised by requester during the prior '1045 IPR and '1089 IPR.[79] Regarding the Sands reference, requester knew or should have known of Sands when it filed the '1045 IPR and the '1089 IPR, because Sands was of record in the Apple IPRs and requester listed the Apple IPRs as a related matter in the '1045 IPR and the '1089 IPR.[80] The record shows that the patent resulting from the Sands U.S. Patent Application Publication No. US 2004/0148526 A1 was cited by Apple in IPR2022-00601.[81] Thus, the record sufficiently shows that the Sands reference could have been raised in the prior IPRs.

Each of the remaining references, Catalano, Ikegami, Siegel, and Fitzgibbon, are a U.S. patent or U.S. patent application publication with a publication year of 2001 or later. As discussed above, "reasonably could have raised" means "prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover." Here, because each of the proposed grounds of the present reexamination request are based on a U.S. patent and U.S. patent application publications, a skilled searcher conducting a diligent search reasonably could have been expected to discover the Catalano, Ikegami, Siegel, and Fitzgibbon references when initially filing the petitions in the '1045 IPR and the '1089 IPR.

Therefore, the proposed grounds asserting a substantial new question of patentability in the present request based on Catalano, Ikegami, Sands, Siegel, and/or Fitzgibbon reasonably could have been raised in the prior '1045 IPR and '1089 IPR, and the record shows that element 4 has been satisfied.

E. All four elements of the 35 U.S.C. 315(e)(1) estoppel provisions are satisfied

The record sufficiently shows that the estoppel provisions of 35 U.S.C. 315(e)(1) apply to requester with respect to claims 1-13 of the '208 patent. As stated above, the record shows that the third party requester of the present reexamination proceeding, HID Global Corporation, is a petitioner of the '1045 IPR and the '1089 IPR, and those IPRs resulted in the USPTO issuing a final written decision pursuant to 35 U.S.C. 318(a) regarding claims 1-13. Further, the proposed grounds in the present request reasonably could have been raised by HID Global Corporation in the prior '1045 IPR and '1089 IPR. Accordingly, under the particular facts and circumstances in this instance, the requester

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[77] Opposition, p. 7 n.2.
[78] *See Praxair Distribution, Inc. et al. v. INO Therapeutics, LLC, IPR2016-00781*, Paper 10, p. 9 (PTAB August 25, 2016).
[79] Petition, p. 18-27.
[80] *Id.* at 18-19.
[81] *See* IPR2022-00602, Exhibit 1025 (U.S. Patent No. 7,404,086 B2 to Sands *et al.*, issued July 22, 2008).

is estopped under 35 U.S.C. 315(e)(1) from requesting reexamination of claims 1-13 of the '208 patent on the grounds raised in the request.

V. Requester's certification pursuant to 37 CFR 1.510(b)(6) is improper and the 90/019,617 reexamination proceeding is terminated

As set forth in section IV of this decision, requester is estopped under 35 U.S.C. 315(e)(1) from requesting reexamination of claims 1-13 of the '208 patent on the grounds raised in the request. Thus, requester's certification pursuant to 37 CFR 1.510(b)(6), which was submitted with its request for *ex parte* reexamination in the present reexamination proceeding, is **improper**. Accordingly, the present reexamination proceeding is hereby **terminated**.

Patent owner's January 3, 2025 petition under 37 CFR 1.181(a) requesting that the Office vacate the reexamination order of November 4, 2024 pursuant to 35 U.S.C. 315(e)(1) is **granted**. The order granting reexamination mailed on November 4, 2024, and other communications issued by the Office in the present reexamination proceeding, are hereby **vacated**.

The deposited request papers, previously issued Office communications, and any other papers deposited by the parties in the present reexamination proceeding, were scanned into the electronic IFW to create a record. Because the present reexamination proceeding is terminated, **all papers**, including the request papers, previously issued Office communications, and any other papers deposited by the parties in the present reexamination proceeding, **will be expunged** by marking the papers "closed" and "non-public," and will not constitute part of the public record.

The present decision will, however, **remain open to the public**, to provide a record of the action being taken.

CONCLUSION

1. Patent owner's January 3, 2025 petition under 37 CFR 1.181(a) requesting that the Office vacate the reexamination order of November 4, 2024 pursuant to 35 U.S.C. 315(e)(1) is **granted**.

2. Requester's certification pursuant to 37 CFR 1.510(b)(6) is improper. The estoppel provisions of 35 U.S.C. 315(e)(1) apply to requester with respect to claims 1-13 of the '208 patent. As a result, the present reexamination proceeding is hereby **terminated**.

3. The order granting reexamination mailed on November 4, 2024 is **vacated**.

4. All other papers of record which were issued by the Office in the present reexamination proceeding, as a whole, are **vacated**.

5. **All papers**, including the request papers, previously issued Office communications including the November 4, 2024 order granting reexamination, patent owner's February 7, 2025 improper paper, and all other papers deposited by the parties in the present reexamination proceeding, **will be expunged** by marking the papers "closed" and "non-public," and will not constitute part of the public record.

6. The present decision **will remain open to the public** to provide a record of the action being taken.

7. Inquiries concerning this decision should be directed to Steven J. Fulk, Legal Advisor, Office of Patent Legal Administration, at (571) 270-0072, or the undersigned at (571) 272-7717.

/Nicole D. Haines/
Nicole D. Haines
Senior Legal Advisor
Office of Patent Legal Administration May 27, 2025