

No. 2022-1016

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

CLICK-TO-CALL TECHNOLOGIES LP,

Plaintiff-Appellant

v.

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

Defendants-Appellees

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

**DEFENDANTS-APPELLEES' COMBINED PETITION FOR PANEL REHEARING
AND REHEARING EN BANC**

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CERTIFICATE OF INTEREST

Counsel for Defendants-Appellees certifies the following:

1. **Represented Entities.** The full names of all entities represented by undersigned counsel are:

Ingenio, Inc.

Thryv, Inc.

Ether, a division of Ingenio, Inc.

Ingenio, Inc. d/b/a Keen

2. **Real Party in Interest.** The full names of all real parties in interest for the entities is:

Thryv Holdings, Inc.

3. **Parent Corporations and Stockholders.** The full names of all parent corporations for the entities and all publicly held companies that own 10 percent or more of the stock in the entities:

Thryv Holdings, Inc.

4. **Legal Representatives.** The names of all law firms, partners and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities are:

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5. **Related Cases.** The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47.4(a)(5) and 47.5(b).

Not applicable.

6. **Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

Not applicable.

Date: September 16, 2022

/s/ Mitchell G. Stockwell

Mitchell G. Stockwell

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STATEMENT OF COUNSEL

Based on my professional judgment, I believe the panel decision is contrary to these precedents: *Cal. Inst. Of Tech. v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022); *Intuitive Surgical, Inc. v. Ethicon LLC*, 25 F.4th 1035 (Fed. Cir. 2022); *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293 (Fed. Cir. 2016), *overruled by California Institute of Technology v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022).

Based on my professional judgment, I believe this appeal requires answers to the following precedent-setting question of exceptional importance:

1. Whether 35 U.S.C. § 315(e)'s IPR estoppel provision applies only to claims addressed in the final written decision, as consistent with the holdings in *Shaw*, and *Intuitive Surgical*, and whether that interpretation remains correct after *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

Date: September 16, 2022

/s/ Mitchell G. Stockwell

Mitchell G. Stockwell

**POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED BY
THE COURT**

In overturning the district court’s ruling and holding that IPR estoppel applied to a claim that was not part of the IPR’s final written decision, this Court misapprehended the plain language of 35 U.S.C. § 315(e)(2) and this Court’s precedent in *Cal. Inst. Of Tech. v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022) and *Intuitive Surgical, Inc. v. Ethicon LLC*, 25 F.4th 1035 (Fed. Cir. 2022). The Court also misapprehended or overlooked Thryv’s ability to seek a post-SAS remand where this Court had no jurisdiction to entertain such a remand, and the director of the Patent and Trademark Office had announced it would apply a now-vacated rule that would have caused it to dismiss Thryv’s IPR without consideration of the merits.

INTRODUCTION

The Panel's decision explicitly contradicts 35 U.S.C. § 315(e)(2). The statute applies only to those claims included in the *final written decision*, but the Panel effectively rewrote the statute to apply to all claims raised in the *petition*. The Panel did so without proper deference to the interplay between this case's unique status as a pre-*SAS*, partially instituted IPR and the statutory language. While post-*SAS* the claims in the petition and the claims in any final written decision will be the same, that is not this case. Here, Claim 27 was not part of, or addressed by, the final written decision, despite its inclusion in the petition. Thus, statutory IPR estoppel did not attach and the Panel erred in rewriting the statute to apply to claims never addressed in the final written decision.

The Panel also incorrectly asserted that Thryv "reasonably could have raised" Claim 27 through a request for post-*SAS* remand. But that is not the case. The Supreme Court itself confirmed that this Court had no jurisdiction over the patentee's appeal and ordered dismissal. Thus, by the time *SAS* issued, the appeal then pending was before a court that lacked jurisdiction and had no power to remand the matter for the Board to reconsider its years old final and unreviewable decision. Likewise, even though the Supreme Court vacated this Court's reversal of the Board's approach to determining time bars under Section 315(b), the Director has nonetheless chosen to follow this Court's now-vacated decision. That

policy change meant that any post-*SAS* petition to the Board would have been futile. In short, the Panel's focus on Thryv's theoretical ability to raise Claim 27 by requesting a remand was inappropriate and inapplicable in light of the Supreme Court's dismissal and the Board's actual practices.

Rehearing is therefore necessary and the decision below should be affirmed.

BACKGROUND

Click-to-Call Technologies LP ("Click-to-Call") sued Defendants-Appellees ("Thryv") for infringement of U.S. Patent No. 5,818,836 (the "'836 Patent"). Appx30 (No. 1). Thryv petitioned for *inter partes* review ("IPR"), which was granted-in-part in 2013. Appx1539-40; Appx1567-68. The petition urged invalidity under the Dezonno and Freeman references, addressing Claim 27 in its discussion of Freeman, but not Dezonno reference. Appx1547. The Patent Trial and Appeal Board (the "PTAB" or "Board") instituted review only as to Dezonno, meaning that review of Claim 27 was *not* instituted. Appx1567-68. In 2014, the PTAB issued a final written decision finding all instituted claim invalid. Appx1597.

Click-to-Call appealed based solely on whether the time bar under 35 U.S.C. § 315(b) precluded institution. Appx1320. That appeal was dismissed for lack of appellate jurisdiction, after which Click-to-Call successfully petitioned for certiorari and the Supreme Court remanded the case for further consideration in light of recent case law. Appx1320. On remand, this Court again dismissed the

appeal. *Id.* Click-to-Call petitioned for rehearing, and this Court ordered rehearing *en banc* in January 2018. Appx1320-21.

In August 2018, approximately four months after the *SAS* decision, this Court held—in a split decision—that dismissal of the prior complaint without prejudice did not impact whether the time bar applied under § 315(b), meaning that Thryv’s IPR should be vacated and dismissed. Appx1321, Appx1333-95. Thryv petitioned for certiorari on two questions—whether 35 U.S.C. § 314(d) permits appeal of the PTAB’s decision to institute IPR upon finding that the time bar did not apply and whether that time bar precluded an IPR when the previous complaint had been dismissed without prejudice. The Solicitor General opposed the petition stating, as to the second question, that after this Court’s merits “decision in *Click-to-Call*, ‘the Director of the USPTO has reconsidered the agency’s interpretation of Section 315(b) in light of that decision, and has determined that the court of appeals’ reading reflects the better view of Section 315(b).”” *Microsoft Corp. v. Parallel Networks Licensing, LLC*, Nos. IPR2015-00483, IPR2015-00485, 2020 WL 5803053, at *3 (P.T.A.B. Sept. 29, 2020) (citation omitted). The Board follows that same policy today. *Id.*

The Supreme Court granted certiorari on Thryv’s first question and ruled in its favor, thereby upholding the PTAB’s determination of invalidity. Notably, the

Supreme Court concluded its opinion with instructions to this Court to dismiss for lack of appellate jurisdiction. Appx1409-10.

Thereafter, the district court lifted the stay of this case and, on summary judgment, found that only Claim 27 remained in the case, and that it, too, is invalid. Appx3-19. On appeal, Click-to-Call argued that, if *SAS* had been decided before Thryv's IPR petition was filed, Claim 27 would have been included in the final written decision, so IPR estoppel should apply even though that claim did not **actually** appear in the final written decision. Blue Br. 13-18. In its reply brief, Click-to-Call relied heavily on *Caltech California Institute of Technology v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022) ("*Caltech*"), *petition for cert. docketed*, No. 22-203 (Sept. 7, 2022), to support its position that IPR estoppel should apply because Claim 27 was in the petition, even though it was absent from the final decision. Yellow Br. 1-4.

The Panel agreed and ruled that IPR estoppel applied to Claim 27. Its basis for doing so was largely the *Caltech* decision and its interpretation of *SAS*. *Click-to-Call Techs. LP v. Ingenio, Inc.*, No. 2022-1016, 2022 WL 3443656, at *4-5 (Fed. Cir. Aug. 17, 2022). The Panel further faulted Thryv for not seeking a "*SAS* remand" to try to force the PTAB to issue a ruling on Claim 27. *Id.* at *5. Despite these findings, the Panel did acknowledge that, according to the statute, IPR

estoppel applies on a claim-by-claim basis to those claims included in the final written decision. *Id.* at *4.

ARGUMENT AND AUTHORITY

I. The Panel’s Opinion Improperly Contradicts the Plain Language of the Statute.

35 U.S.C. § 315(e)(2) is clear that when there is “inter partes review of *a claim* in a patent [] that *results in a final written decision*,” the petitioner may not assert that “*the claim* is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.” (emphasis added). In other words, IPR estoppel only applies to claims that result in, and are addressed by, a final written decision. Indeed, the Panel recognized that the statute requires IPR estoppel to be applied on a claim-by-claim basis, and only to those claims that reach final written decision. *Click-to-Call*, 2022 WL 3443656 at *4.

But the Panel did not apply that plain language and hold that Claim 27 was not subject to IPR estoppel. The Panel instead concluded that IPR estoppel applies to Claim 27 by, first, focusing on the petition as defining the scope of the IPR, and, second, by focusing on *claims* that Thryv reasonably could have raised post-SAS. Both of these rationales are improper; each contradict the statute and prior precedent.

A. The Panel’s Focus on the Petition, Rather than the Final Written Decision, Improperly Rewrites the Statute and Cannot be Justified by *Caltech*.

The Panel relied on *Caltech* and *SAS* to hold that the petition defines the scope of the IPR, and therefore IPR estoppel applies to any claim raised in the *petition*, without regard to whether that claim was addressed in the *final written decision*. See *Click-to-Call*, 2022 WL 3443656 at *4. This was error.

In drafting the IPR estoppel statute, “Congress spoke to [the] matter” of what claims the estoppel applies to: claims that reach a final written decision. *In re Doyle*, 293 F.3d 1355, 1363 (Fed. Cir. 2002). And courts “may not rewrite the statute based on [their] own view of the proper outcome.” *Id.* But that is precisely what the Panel did. It thereby revised the statute as follows to bar the “petitioner in ~~an~~ petition for inter partes review of a claim in a patent under this chapter ~~that results in a final written decision under section 318(a)~~” from asserting “that the claim is invalid on any ground that the petitioner raised or reasonably could have raised ~~during that inter partes review~~ in the petition.”

The Panel justified its action by citing *Caltech* for the proposition that “it is the petition, not the institution that defines the scope of the IPR.” *Click-to-Call*, 2022 WL 3443656 at *4 (quoting *Caltech*, 25 F.4th at 990). But that application of *Caltech* is incorrect and ignores vital context. *Caltech* was explicitly discussing the scope of the IPR in the context of a post-*SAS* case and, therefore, all petitioned

claims were addressed in the final decision. 25 F.4th at 990-91. Because *SAS* held that the Board was required to institute on all claims raised in the petition, or none of them, post-*SAS*, any claim raised in a petition that was instituted would necessarily be included in the final written decision. *Id.* But this case was pre-*SAS*, and not all claims raised in the petition were included in the final written decision.

The Panel glossed over the drastically different positioning of this case from *Caltech*. The statement relied on by the Panel simply summarizes what the Supreme Court decided in *SAS*. See *Caltech*, 25 F.4th at 990. It is not an affirmative statement that IPR estoppel applies to any claim raised in the petition, even if it is not addressed in the final written decision.

Indeed, *Caltech* explicitly stated in footnote 5 that it was *not* addressing the facts at issue in this case, where “the Board declined to institute on all grounds and issued its final written decision pre-*SAS*.” *Id.* at 991 n.5. *Caltech* thus intentionally left the door open for the Court to “decide the scope of preclusion” in such cases. *Id.* The Panel neither mentioned footnote 5 nor even acknowledged the significant procedural differences between this case and *Caltech* with respect to the timing of the *SAS* opinion. Instead, it applied a single quote from the *Caltech* opinion, divorced from any of the necessary context, to reach a result that is *at odds* with the statute without ever grappling with those inconsistencies.

Rehearing is thus necessary to allow this Court to definitively weigh in on the question it intentionally and explicitly left open in footnote 5 of the *Caltech* decision.

B. The Panel Improperly Considered Whether Thryv Reasonably Could Have Raised Certain *Claims*, Rather than Certain *Grounds* Post-*SAS*.

In the second portion of its opinion on IPR estoppel, the Panel focuses on what it characterizes as “Ingenio’s choice to leave unremedied the Board’s mistake [in partially instituting the IPR].” *Click-to-Call*, 2022 WL 3443656 at *5. In particular, the Panel found that, although Claim 27 was *not* addressed in the final written decision, because Thryv “was not helpless to remedy the Board’s institution error,” yet “never sought a *SAS* remand directing the Board to address its non-instituted claims and grounds,” Thryv should be treated as though Claim 27 *were* in the final written decision. *Id.* The Panel went on to specify that, because Thryv could theoretically have sought post-*SAS* review, it reasonably could have raised Claim 27’s invalidity under *Dezonno* during the IPR. *Id.*

Recognizing that Claim 27 was never part of the final written decision—and thus not part of the IPR in a pre-*SAS* world—the Panel has improperly expanded IPR estoppel to bar not only *grounds* that reasonably could have been included in the IPR, as the statute plainly reads, but also to *claims* that reasonably could have included in the IPR. The Panel thus effectively rewrote the statute a second time,

this time barring the petitioner from asserting invalidity based on “any claim or ground that the petitioner raised or reasonably could have raised during that inter partes review.” But Congress knew that a distinction existed between the commonly understood words in the art of “claim”—meaning a patent’s claim—and a “ground”—meaning a basis of invalidity.

Section 315(e)(2) makes clear that “claim” does not mean argument or cause of action as it might in non-patent law contexts; rather, it means the claim of a patent: “The petitioner in an inter partes review *of a claim in a patent* under this chapter that results in a final written decision . . .” The Supreme Court clearly recognized that “claim” in Section 315 referred to the claim in a patent. *SAS*, 138 S. Ct. at 1355. The Panel, however, has ignored the distinction drawn in Section 315(e)(2) between a “claim” subject to a Final Written Decision, to which estoppel applies, and a “ground that the petitioner raised or reasonably could have raised.”

The Panel’s decision not only conflicts with the statute but also conflicts with both the *Caltech* decision and *Intuitive Surgical*, 25 F.4th 1035, each of which took pains to recognize the “claim-by-claim” nature of estoppel.

The Court’s errata in *Caltech* clarified that IPR estoppel only bars a petitioner from later raising *grounds* it reasonably could have raised in the IPR, not *claims* it reasonably could have raised. The original *Caltech* opinion stated that IPR estoppel applies to “all *claims and grounds* not in the IPR but which

reasonably could have been included.” Errata at 1 (emphasis added). That is essentially what the panel ruled: Claim 27 could have been included in the IPR and is therefore subject to IPR estoppel. But, on February 22, 2022, this Court entered an errata to its *Caltech* opinion. This Court rejected that principle when it entered an errata **deleting** the portion of the *Caltech* opinion barring claims which reasonably could have been raised. *Id.* at 1-2. In replacing that language, the errata clarified that IPR estoppel applies to “all **grounds** not stated in the petition but which reasonably could have been asserted against the claims included.” *Id.* *Caltech* thus definitively indicated that IPR estoppel only bars **grounds** that reasonably could have been raised, not **claims** that reasonably could have been in the IPR, but were not.

Indeed, *Intuitive Surgical* has independently recognized this very point. That case upheld the PTAB’s decision to estop the petitioner from proceeding on a third petition after the Board had already resolved two other petitions that addressed the same claims. In affirming, this Court explained that the petitioner could have better managed its challenges, including by basing the petitions on only a subset of claims. This Court expressly held “[a] petitioner may also file multiple petitions where each petition focuses on a separate, manageable subset of the claims to be challenged—as opposed to subsets of grounds—as Section 315(e)(1) estoppel applies on a claim-by-claim basis.” 25 F. 4th at 1041-42. In other words, a

petitioner could strategically choose to challenge certain claims and not others in a given petition without any risk of estoppel on the unchallenged claims.

The Panel's decision directly conflicts with *Intuitive Surgical*, which plainly holds that "Section 315(e)(1) applies on a claim-by-claim basis." 25 F. 4th at 1041-42. Thryv accordingly would have been free to entirely omit claim 27 from its original petition and it would not be estopped. Likewise, Thryv's post-SAS failure to ask this Court to remand for the Board to reconsider its decision to not institute as to Claim 27 should make no difference in whether estoppel attaches under *Intuitive Surgical* and the statute. The Panel's contrary holding estopping Thryv for failing to seek a post-SAS remand to address Claim 27 contradicts prior precedent and the statute, creates estoppel when this Court has made clear none applies and improperly penalizes Thryv for what the Panel characterized as the **Board's** legal error.

Allowing the Panel's contrary decision to stand would not only overrule and undercut prior panel decisions but lead to undesirable consequences. According to the Panel, because Thryv could have added Claim 27 as a claim that is invalid under Dezonno, IPR estoppel applies to Claim 27. But by this logic, if a petitioner challenges **a single claim** of a patent in an IPR petition, it reasonably could have challenged **every other claim** of that patent, because it undeniably knew of those other claims and the references cited in the petition. This effectively creates an all-

or-nothing approach to IPRs, requiring petitioners to challenge all claims in IPR or none, lest estoppel otherwise apply. That outcome is not part of the statutory scheme. To the contrary, the statute explicitly states that IPR estoppel applies only to claims that are part of the final written decision, as *Intuitive Surgical* explains.

C. The Panel Erred in Theorizing Thryv Could Have Reasonably Raised the Validity of Claim 27 Via Post-SAS Remand.

The Panel’s treatment of this case illustrates the far-reaching, and negative consequences of departing from the clear statutory mandate of applying estoppel to only claims addressed in the final written decision. Here, the Panel reasoned that “[t]he fact that the Board, due to a legal error corrected by *SAS*, failed to include claim 27 in its final written decision does not absolve Ingenio of the estoppel triggered by its choice to challenge claim 27 at the Board,” despite the statutory wording. *Click-to-Call*, 2022 WL 3443656 at *4. The Panel asserted that “[d]ue to the long appellate history of the IPR proceeding, the appeal of Ingenio’s IPR was still pending at the time *SAS* issued,” Ingenio “could have” then sought to address claim 27, but instead Ingenio “forewent the route taken by many other parties post-*SAS* to have the Board address all claims and all grounds in their petitions.” *Id.* at *5.

This theoretical possibility of a *SAS* remand upon which the Panel grounded its analysis is dubious in the extreme. It is axiomatic that “[w]ithout jurisdiction the court cannot proceed at all in any cause. Jurisdiction is power to declare the law,

and when it ceases to exist, the only function remaining to the court is that of announcing the fact and dismissing the cause.” *Steel Co. v. Citizens for a Better Env’t*, 523 U.S. 83, 94 (1998) (quoting *Ex parte McCardle*, 7 Wall. 506, 514 (1868)). Indeed, “[t]he requirement that jurisdiction be established as a threshold matter ‘spring[s] from the nature and limits of the judicial power of the United States’ and is ‘inflexible and without exception.’” *Id.* at 94-95 (quoting *Mansfield, C. & L.M.R. Co. v. Swan*, 111 U.S. 379, 382 (1884)). The long appellate history the Panel referenced ended when the Supreme Court found no jurisdiction over Click-to-Call’s original appeal and, specifically “remand[ed] the case with instructions to dismiss for lack of appellate jurisdiction.” *Thyrv, Inc. v. Click-to-Call Techs., LP*, 140 S. Ct. 1367, 1377 (2020).

Those “instructions to dismiss” gave *no* leeway for a post-*SAS* remand.¹ And, because there was no jurisdiction over the appeal, this Court had no power to entertain a post-*SAS* remand request. Thus, the PTAB’s decision was final as of the October, 2014 issuance of the final written decision – years before *SAS*. Even setting aside absence of jurisdiction, the PTAB itself would not have entertained any post-*SAS* request to consider claim 27. That is because even after the Supreme

¹ This is reinforced by the fact the PTAB was divested of jurisdiction over the matter as soon as Click-to-Call filed its Notice of Appeal and elected to improperly challenge only the PTAB’s decision to institute. *See, e.g.*, Order Denying petitioner’s Request for a Stay of Reissue Application Proceeding at 2-3, *Smart Microwave Sensors GmbH v. Wavetronix LLC*, No. IPR2016-00488, Paper 59 (P.T.A.B. Aug. 24, 2017).

Court this Court's merits decision, the PTAB has elected to follow that now-vacated decision and dismiss any IPR filed more than one year after even a complaint dismissed without prejudice. *See, e.g., Microsoft*, 2020 WL 5803053. The PTAB has followed such a policy even when the case has been final for years and remanded on other issues. *See Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.*, No. IPR2015-00826, 2021 WL 202800 (P.T.A.B. Jan. 20, 2021), *appeal dismissed*, 33 F.4th 1348 (Fed. Cir. 2022). Thus, any theoretical post-*SAS* remand request would have been directed to a court without jurisdiction, and addressed a decision finalized years earlier and over which the agency lacked any jurisdiction. Worse, even absent the jurisdictional problems, the agency's announced policy would have been to dismiss the matter as barred under its new interpretation of Section 315(b).

Setting aside the dubious possibility of a post-*SAS* remand, Ingenio, like other parties, relied on the clear language of the statute and then-extant law, under none of which would estoppel apply. More critically here, the Court should also consider the full implications of the Panel's reasoning.

Under that reasoning so long as a petitioner "could" have addressed a claim within a petition, estoppel must apply to all such claims. As a practical matter, petitioners must now put up all arguments against *all* claims or risk estoppel as to unchallenged claims, rather than petitioning to address only a limited set of claims

and grounds. As explained, such a result contradicts the statute and prior precedent. By contrast, a claim-focused approach is entirely consistent with *SAS*'s reasoning that "the statute tells us that the petitioner's contentions, not the Director's discretion, define the scope of the litigation all the way from institution through to conclusion." 138 S. Ct. at 1357. Post-*SAS*, petitioners can control the scope of the petition by focusing on the specific claim(s) to challenge. And, while estoppel may reach beyond a specific ground raised as to that claim, it may not reach unchallenged claims. Indeed, such a desire to focus disputes is consistent with the goals of inter partes reexamination and litigation generally and only by correcting the Panel's decision can this Court ensure advancement of such wise policy.

II. This Case Presents the Proper Vehicle to Address Whether *Caltech*'s Overruling of *Shaw* Was Proper.

Independently, rehearing should also consider whether *Shaw* remains good law. Unlike other decisions, this case plainly addresses the factual circumstances *Caltech* specifically did not consider as reflected in its footnote 5. And, on the merits, *Shaw* should be reaffirmed as good law.

Under the plain statutory language and *Shaw*, IPR estoppel does not apply to non-instituted grounds, as the IPR did not begin until institution. *See* 35 U.S.C. § 315(e)(2); *Shaw*, 817 F.3d at 1300. That principle was repeatedly upheld by this Court. *See, e.g., In re IPR Licensing, Inc.*, 942 F.3d 1363, 1369 (Fed. Cir. 2019); *HP Inc. v. MPHJ Tech. Invs., LLC*, 817 F.3d 1339, 1347 (Fed. Cir. 2016).

The *Caltech* panel incorrectly relied on *SAS* to overturn *Shaw*. *SAS* did not itself overturn *Shaw*, and in fact analyzed a different statute entirely (35 U.S.C. § 318(a) vs. § 315(e)(2)). Nonetheless, the Panel held that, because *Shaw*'s reasoning rested on the assumption that partial institutions were permissible, *SAS*'s elimination of partial institutions required *Shaw* to be overruled. *Caltech*, 25 F.4th at 991. But that is incorrect. *Shaw* was not limited to the particular facts of its case, but instead held that the plain language of § 315(e)(2) prohibits IPR estoppel from attaching to grounds that were not part of the IPR, which began at institution. *SAS* did not undermine or challenge the validity of *Shaw* as a textual construction of § 315(e)(2).

To hold otherwise would be to suggest that Section 315(e)(2) changes meaning depending on whether a matter was pre- or post-*SAS*. This form of statutory morphism has no precedent in statutory construction. As such, this case presents the ideal vehicle for the Court as a whole to address the impact of *SAS*, if any, on *Shaw* and whether that precedent has or need be overruled.

III. CONCLUSION

For the foregoing reasons, the Court should grant rehearing and affirm the judgment below.

DATED: September 16, 2022.

Respectfully submitted,

KILPATRICK TOWNSEND &
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ADDENDUM

**United States Court of Appeals
for the Federal Circuit**

CLICK-TO-CALL TECHNOLOGIES LP,
Plaintiff-Appellant

v.

INGENIO, INC., DBA KEEN, ETHER, THRYV, INC.,
Defendants-Appellees

2022-1016

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

Decided: August 17, 2022

DANIEL J. SHIH, Susman Godfrey LLP, Seattle, WA, ar-
gued for plaintiff-appellant. Also represented by BRIAN
MELTON, MAX LALON TRIBBLE, JR., Houston, TX.

AMANDA N. BROUILLETTE, Kilpatrick Townsend &
Stockton LLP, Atlanta, GA, argued for defendants-appel-
lees. Also represented by DAVID CLAY HOLLOWAY,
MITCHELL G. STOCKWELL.

Before STOLL, SCHALL, and CUNNINGHAM, *Circuit Judges*.
STOLL, *Circuit Judge*.

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

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

This case thus requires us to consider the application of 35 U.S.C. § 315(e)(2) under a rather unusual set of facts. The Board instituted pre-SAS and did not institute on all grounds. And when given the opportunity to do so post-

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

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

BACKGROUND

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

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

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

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

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

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

The Board issued its final written decision on October 28, 2014. The Board found all claims challenged on the Dezonno grounds to be unpatentable. J.A. 1597. Click-to-

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

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

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

granted summary judgment of invalidity. J.A. 3–6. Final judgment issued on September 2, 2021. J.A. 1–2.

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

DISCUSSION

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

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

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

I

We first turn to Click-to-Call’s argument that the district court erred in refusing to estop Ingenio from arguing that claim 27 is anticipated by Dezonno. We agree that the district court erred by not addressing the actual basis of

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

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

We turn now to the merits of Click-to-Call's estoppel argument. We hold that IPR estoppel applies here as a matter of law and precludes Ingenio from arguing that claim 27 is anticipated by Dezonno. Ingenio's IPR petition included a challenge to claim 27 (based upon Freeman, but not Dezonno) and included unpatentability challenges to other claims based on Dezonno (including an anticipation

challenge to claim 1 on which claim 27 depends), evidencing its awareness of the Dezonno reference. Accordingly, anticipation of claim 27 in view of Dezonno—the invalidity challenge the district court accepted—is a ground that Ingenio “reasonably could have raised” in the IPR. Ingenio’s arguments to the contrary based on the language of § 315(e)(2) and *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293 (Fed. Cir. 2016), are unpersuasive.

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

(e) ESTOPPEL.— . . .

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

35 U.S.C. § 315(e)(2) (emphases added); *see* Appellees’ Br. 8–9. Ingenio argues that as a result of this language, IPR estoppel is applied on a claim-by-claim basis and is

limited to only those claims that were “subject to a final written decision.” Appellees’ Br. 8–9.

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

As described in the Background, Ingenio crafted its petition to challenge claim 27 only on the alternative Freeman-based ground, rather than Dezonno. The Board, consistent with its practice at the time in 2013, instituted only on the Dezonno-based grounds, thus leaving claim 27 unaddressed. This partial-institution practice, however, was inconsistent with the IPR statute and was overruled by the Supreme Court in *SAS*. 138 S. Ct. at 1359–60. The Court explained that “the statute tells us that the petitioner’s contentions, not the Director’s discretion, define the scope of the litigation all the way from institution through to conclusion.” *Id.* at 1357. Our court has also recognized the primacy of a petitioner’s contentions, specifically in the context of IPR estoppel. In *Caltech*, we noted that “it is the petition, not the institution decision, that defines the scope of the IPR.” *Caltech*, 25 F.4th at 990 (citing *SAS*, 138 S. Ct. at 1357–58). Thus, it is the “petitioner’s contentions” that define “the scope of the [IPR] litigation” and thus the extent of the estoppel (so long as the IPR ends in a final written decision). Here, the scope of the IPR as

defined in the petition included claim 27 and Dezonno, even if it did not include a challenge to claim 27 based upon Dezonno.

Furthermore, unlike pre-SAS petitioners whose partially instituted proceedings went final before SAS issued, Ingenio was not helpless to remedy the Board's institution error. Due to the long appellate history of the IPR proceeding, the appeal of Ingenio's IPR was still pending at the time SAS issued in 2018. Ingenio, however, never sought a SAS remand directing the Board to address its non-instituted claims and grounds. *See* Appellant's Reply Br. 3 (noting Ingenio's failure to request SAS remand); Oral Arg. at 18:30–19:10, https://oralarguments.cafc.uscourts.gov/default.aspx?fl=22-1016_06092022.mp3 (Ingenio conceding it “could have” sought SAS remand to address claim 27 but did not because its Dezonno ground was successful). Ingenio thus forewent the route taken by many other parties post-SAS to have the Board address all claims and all grounds in their petitions. *See, e.g., Adidas AG v. Nike, Inc.*, 894 F.3d 1256, 1258 (Fed. Cir. 2018) (granting SAS remand); *BioDelivery Scis. Int'l, Inc. v. Aquestive Therapeutics, Inc.*, 898 F.3d 1205, 1208 (Fed. Cir. 2018) (citing cases where remand was granted). Ingenio's choice to leave unremedied the Board's mistake does not shield it from estoppel as to a claim it included in its IPR petition.

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

instituted ground. *Id.* at 1297. The Board did not address the non-instituted grounds, including Payne. *Id.*

The petitioner sought a writ of mandamus from our court to instruct the Board to reconsider its redundancy decision and to institute IPR on the Payne ground. One argued basis for the writ was that the petitioner “may be estopped from arguing the [Payne] ground in any future proceedings.” *Id.* at 1299. Our court denied the request for mandamus, agreeing with the PTO (who intervened in that case) that “the denied ground never became part of the IPR.” *Id.* at 1300. Accordingly, the denied ground was not raised nor could it have been reasonably raised “during” the IPR—i.e., after institution—and thus the petitioner would not be estopped. *Id.* *Shaw*, therefore, held that unpatentability grounds that were in a petition but rejected by the Board at institution were not subject to IPR estoppel.

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

We recently overruled *Shaw*. *Caltech*, 25 F.4th at 991. In *Caltech*, we relied on SAS’s abrogation of the Board’s practice of partial institutions as undermining *Shaw*’s rationale. To give effect to the language “reasonably could have raised,” we held that “estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the petition.” *Id.* at 991. Here, claim 27 was “included in the petition” and there is no reasonable argument that Ingenio could not have raised Dezonno against that claim. And under SAS, Ingenio was entitled to have *all* of its claims and grounds considered after institution. *See SAS*, 138 S. Ct. at 1355

(“Much as in the civil litigation system it mimics, in an inter partes review the petitioner is master of its complaint and normally entitled to judgment on all of the claims it raises, not just those the decisionmaker might wish to address.”); see also *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (“We will treat claims and grounds the same in considering the SAS issues currently before us.”).² Thus, Ingenio’s reliance on *Shaw* is out of date and IPR estoppel applies.³

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

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

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

II

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

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

Ingenio then moved to stay the district court case the following month. J.A. 1260; J.A. 39 (D.I. 144). The district court granted the stay. *Click-to-Call Techs. LP v. Ingenio, Inc.*, Case No. A-12-CA-465-SS, 2013 WL 11311782 (W.D. Tex. Dec. 5, 2013). One rationale that the district court provided for granting the stay was that the IPR would "simplify the issues in th[e] case" because "a[ll] but one of the claims to be asserted at trial in this case" were at issue in the IPR. *Id.* at *2. Clearly, the district court did not envision adding other claims to the case following the IPR. And Click-to-Call has not, on appeal, pointed us to any

briefing or statements before the district court where it hinted at such an addition before the stay.

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

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

The district court addressed this terse request from Click-to-Call in an equally short denial, determining “Click-to-Call failed to provide good cause to amend its notice of claims selected for trial.” J.A. 5. The district court also adopted the magistrate judge’s recommendation, which reasoned that “[c]ourts generally refuse to reopen what has been decided previously” and recommended denying Click-to-Call’s request to amend. J.A. 14. Like the district court, the magistrate judge found “Click-to-Call has not provided good cause for leave to amend nearly eight years after its original selection of claims for trial.” *Id.* We

see no abuse of discretion in this decision by the district court.

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

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

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

Second, Click-to-Call argues the district court abused its discretion in denying Click-to-Call's proposed amendment by failing to consider the factors enumerated in *S&W Enterprises*. Appellant's Br. 31–34. But, as we described above, Click-to-Call's request to amend consisted of a two-sentence paragraph that did not even cite *S&W Enterprises*, let alone analyze the factors therein. J.A. 1721. We will not fault the district court for failing to apply a case that Click-to-Call did not even present to the district court.

And we refuse to find an abuse of discretion in the district court's short analysis, considering the minimal effort Click-to-Call put into making its argument. *Cf. Novartis AG v. Torrent Pharms. Ltd.*, 853 F.3d 1316, 1328 (Fed. Cir. 2017) (refusing to fault the lower tribunal for “arguably limited treatment” of arguments that were only tersely made). Nor will we analyze those factors *de novo* in the first instance, as Click-to-Call would have us do. Appellant's Br. 32–34 (analyzing the factors for the first time on appeal).

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

CONCLUSION

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

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

COSTS

No costs.

**United States Court of Appeals
for the Federal Circuit**

CLICK-TO-CALL TECHNOLOGIES LP,
Plaintiff-Appellant

v.

**INGENIO, INC., DBA KEEN, ETHER, THRYV,
INC.,**
Defendants-Appellees

2022-1016

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

JUDGMENT

THIS CAUSE having been considered, it is

ORDERED AND ADJUDGED:

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

FOR THE COURT

August 17, 2022
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

CERTIFICATE OF COMPLIANCE

Pursuant to Fed. R. App. P. 32(g), the undersigned certifies that this brief complies with the type-volume limitations of Fed. R. App. P. 32(a)(7)(B), exclusive of the portion exempted by Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b). This brief has been prepared using a proportionally-spaced typeface, and contains 3,896 words, relying on the word count of the word-processing system used to prepare the brief.

Dated: September 16, 2022.

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CERTIFICATE OF SERVICE

I certify that I filed the foregoing document with the Clerk of the United States Court of Appeals for the Federal Circuit via the CM/ECF system and thereby served a copy on counsel of record by electronic means this 16th day of September, 2022.

/s/ Mitchell G. Stockwell

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