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CLIENT ALERT

Rule 36 Judgment Can Serve As Basis for Collateral Estoppel

DECEMBER 11, 2018

VirnetX Inc. v. Apple, Inc., Nos. 2017-2490 and 2017-2494 (Fed. Cir. Dec. 10, 2018)
The patentee appealed two final written decisions from the Patent Trial and Appeal Board (PTAB) finding certain claims of two patents were unpatentable. In the PTAB proceedings, the patentee argued that a specific article was not a printed publication. The PTAB, however, concluded the article was a printed publication, and accordingly found one patent unpatentable as obvious. The patentee appealed the finding that the article was a printed publication.

During the pendency of this appeal, the patentee separately appealed seven final written decisions also addressing the patentee's argument that the very same article was not a printed publication. In that earlier case, the PTAB had also found the article to be a printed publication. The Federal Circuit "summarily affirmed the PTAB's decisions pursuant to Federal Circuit Rule 36."

In this appeal, the petitioner argued that the patentee was collaratelly estopped by the Rule 36 judgment from arguing that the article was not a printed publication. The Federal Circuit agreed with the petitioner that the Rule 36 judgment in the earlier appeal collaterally estopped the patentee from relitigating the question of whether article was a printed publication. The court further determined the issue was necessary to the judgment in the earlier appeal because it was a threshold issue and, in three of the seven final written decisions appealed, was the only issue raised on appeal. By affirming all seven of the PTAB's decisions in the earlier appeal, the Federal Circuit "necessarily found" that RFC 2401 was a printed publication.
A copy of the opinion can be found here

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