

Dismissing an Appeal, Thereby Making the Underlying Decision Final, Can Lead to Issue Preclusion in a Separate Appeal

MAY 23, 2019

Papst Licensing Gmbh & Co. Kg, v. Samsung Electronics America, Inc., No. 2018-01777 (Fed. Cir. May 23, 2019)

The patentee brought suit alleging infringement of several patents in the same family involving an interface device for communication between a data device and a host computer. The alleged infringer filed several *inter partes* review (IPR) petitions challenging the validity of the patents. The Patent Trial and Appeal Board (PTAB) found several claims of the patents invalid, and the patentee filed separate appeals in each case, all of which were scheduled for oral argument on the same day. Shortly before oral argument, the patentee voluntarily dismissed its appeals regarding two of the patents, but continued with the appeal on the third patent. However, the patents at issue in the dismissed appeals involved “materially identical” claim terms and obviousness issues with the remaining case.

The Federal Circuit affirmed the PTAB’s obviousness finding, relying in the alternative on both issue preclusion and also on the merits of the obviousness analysis and claim construction. The court held that a tribunal’s resolution of an issue that is only one part of an ultimate legal claim can preclude the loser on that issue from later contesting, or continuing to contest, the same issue in a separate case. Further, issue-preclusion principles apply even when the first “action” was before an agency such as the PTAB. The patentee also failed to justify denying issue preclusion by failing to assert inadequate representation or an impaired opportunity to litigate the earlier IPRs. Nor did the patentee present any allegation of a legally significant disparity in incentives between the present IPR and the two prior IPRs. Thus, the patentee was precluded from relitigating the issues decided in the earlier cases and the PTAB’s decision was therefore affirmed.

[A copy of the opinion can be found here.](#)

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