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Carmichael IP, PLLC 8607 Westwood Center Drive, Suite 270 Tysons, VA 22182			BASEHOAR, ADAM L	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

May 26, 2023

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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90019069  
PATENT NO. : 8484111  
ART UNIT : 3993

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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(For Third Party Requester)

*In re Frankland et al.* :  
U.S. Patent No. 8,484,111 : **DECISION**  
*Ex Parte* Reexamination Proceeding : **ON**  
Control No.: 90/019,069 : **PETITIONS**  
Filed: April 1, 2022 :

This decision addresses patent owner’s July 15, 2022 petition entitled “Patent Owner’s Petition for Suspension of the Rules and for Summary Termination of Reexamination, as a Matter of Law, Pursuant to 37 C.F.R. §§ 1.181, 1.182, and 1.183” and patent owner’s October 6, 2022 petition entitled “Patent Owner’s Petition to Expunge Third Party Requestor’s Opposition, Under 37 C.F.R. §§ 1.181, 1.182, and/or 1.183.” This decision also addresses requester’s July 29, 2022 paper entitled “Opposition to Patent Owner’s Petition for Suspension of the Rules and for Summary Termination of Reexamination, as a Matter of Law, Pursuant to 37 C.F.R. §§ 1.181, 1.182, and 1.183.”

Patent owner’s July 15, 2022 and October 6, 2022 petitions, requester’s July 29, 2022 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

**PERTINENT BACKGROUND**

- On July 9, 2013, U.S. Patent Number 8,484,111 (the ’111 patent) issued to Richard Frankland *et al.* with claims 1-18. The ’111 patent claims priority through a chain of continuations to U.S. Pat. No. 6,341,287, filed Dec. 18, 1998, and is currently assigned to Applications In Internet Time, LLC (AIT or patent owner). On June 2, 2020, a statutory disclaimer under 37 CFR 1.321 was published in the Official Gazette disclaiming claims 1-12 of the ’111 patent. The ’111 patent is currently expired.

**District Court Proceeding**

- On November 8, 2013, AIT filed a complaint in the U.S. District Court for the District of Nevada asserting the ’111 patent against Salesforce.com, Inc. (Salesforce).<sup>1</sup>

<sup>1</sup> See *Applications In Internet Time, LLC, v. Salesforce.com, Inc.*, 3:13-cv-00628 (D. Nev. Nov. 8, 2013). On March 10, 2023, the district court issued an order denying Salesforce.com’s motion to stay pending completion of the instant *ex parte* reexamination proceeding. See *id.*, Document 391.

## Prior PTAB Proceedings

### CBM2014-00162 (Salesforce)

- On August 1, 2014, Salesforce filed a petition for covered business method review (CBM), challenging claims 1-18 of the '111 patent. The CBM proceeding was assigned case number CBM2014-00162 (the '0162 CBM). The petition raised the following grounds:<sup>2</sup>

Claims of the '111 patent	Grounds
1-12	Ineligible under 35 U.S.C. 101
1-18	Anticipated by Peters <sup>3</sup>
1-18	Anticipated by Gordon <sup>4</sup>
1-18	Anticipated by Haverstock <sup>5</sup>
1-18	Anticipated by Bederson/Pad++ <sup>6</sup>
1-18	Obvious over Peters, Gordon, Haverstock and/or Bederson/Pad++
1-18	Obvious over Gordon, Peters, Haverstock and/or Bederson/Pad++
1-18	Obvious over Haverstock, Peters, Gordon and/or Bederson/Pad++
1-18	Obvious over Bederson/Pad++, Peters, Gordon and/or Haverstock

- On October 31, 2014, patent owner filed a statutory disclaimer under 37 CFR 1.321, disclaiming claims 1-12 of the '111 patent.
- On February 2, 2015, the Patent Trial and Appeal Board (PTAB) issued a decision denying institution of the '0162 CBM, finding that the information presented in the petition did not establish that the '111 patent with claims 13-18 qualifies as a covered business method patent under section 18 of the America Invents Act (AIA).<sup>7</sup>

### IPR2015-01750 (RPX)

- On August 17, 2015, RPX Corporation (RPX) filed a petition for *inter partes* review (IPR), challenging claims 13-18 of the '111 patent. The *inter partes* review proceeding was assigned case number IPR2015-01750 (the '1750 IPR). The petition raised the following grounds:<sup>8</sup>

Claims of the '111 patent	Grounds
13-18	Anticipated by Popp <sup>9</sup>
13-18	Anticipated by Kovacevic <sup>10</sup>
13-18	Obvious over Balderrama <sup>11</sup> and Java Complete <sup>12</sup>

<sup>2</sup> See *Salesforce.com, Inc. v. Applications In Internet Time LLC*, CBM2014-00162, Paper No. 2 (PTAB Aug. 1, 2014).

<sup>3</sup> Kathleen A. Peters, THE DESIGN OF A CHANGE NOTIFICATION SERVER FOR CLIENTS OF A PASSIVE OBJECT-ORIENTED DATABASE MANAGEMENT SYSTEM (Simon Fraser University 1992) (**Peters**).

<sup>4</sup> U.S. Patent No. 6,243,717 B1 to Gordon *et al.*, issued June 5, 2001 (**Gordon**).

<sup>5</sup> U.S. Patent No. 6,064,977 A to Haverstock *et al.*, issued May 16, 2000 (**Haverstock**).

<sup>6</sup> Petitioner cites two publications: Benjamin B. Bederson *et al.*, *Pad++: A Zoomable Graphical Sketchpad for Exploring Alternate Interface Physics*, 7 J. OF VISUAL LANGUAGES & COMPUTING 3 (1996), and Benjamin B. Bederson *et al.*, *A Zooming Web Browser*, in *Proceedings of SPIE Conference on Multimedia Computing and Networking* (1996) (**Bederson/Pad++**).

<sup>7</sup> See *Salesforce.com, Inc. v. Applications In Internet Time LLC*, CBM2014-00162, Paper No. 11 (PTAB Feb. 2, 2015).

<sup>8</sup> See *RPX Corporation v. Applications In Internet Time, LLC*, IPR2015-01750, Paper No. 1 (PTAB Aug. 17, 2015).

<sup>9</sup> U.S. Patent No. 6,249,291 B1 to Popp *et al.*, issued June 19, 2001 (**Popp**).

<sup>10</sup> Srdjan Kovacevic, *Flexible, Dynamic User Interfaces for Web-Delivered Training*, in AVI '96 PROCEEDINGS OF THE WORKSHOP ON ADVANCED VISUAL INTERFACES 108-18 (1996) (**Kovacevic**).

<sup>11</sup> U.S. Patent No. 5,806,071 A to Balderrama *et al.*, issued September 8, 1998 (**Balderrama**).

<sup>12</sup> *Java Complete!*, 42 DATAMATION Magazine 5, 28-49 (March 1, 1996) (**Java Complete**).

- Additional discovery was conducted regarding whether Salesforce is a real party in interest (RPI) and, on May 12, 2016, the PTAB issued a decision instituting the '1750 IPR. The PTAB determined that Salesforce had not been shown to be an RPI.<sup>13</sup>
- On December 28, 2016, the PTAB issued a final written decision in the '1750 IPR, concluding that AIT demonstrated, by a preponderance of the evidence, that claims 13-18 are unpatentable.<sup>14</sup>
- AIT appealed to the United States Court of Appeals for the Federal Circuit (Federal Circuit) and, on July 9, 2018, the Federal Circuit issued a decision, vacating the PTAB's final written decision and remanding for further proceedings.<sup>15</sup>
- On October 2, 2020, the PTAB issued a final decision on remand, terminating the '1750 IPR.<sup>16</sup>

### Present *Ex Parte* Reexamination Proceeding

90/019,069 (Salesforce)

- On April 1, 2022, Salesforce (requester) filed a request for *ex parte* reexamination of claims 13-18 of the '111 patent, which request was assigned Control No. 90/019,069 (the '069 reexamination or the present reexamination proceeding). The request proposed the following grounds of rejection:

Ground	Claims of the '111 patent	Proposed Rejection <sup>17</sup>
1	13-18	Anticipated by <b>Popp</b>
2	13-18	Anticipated by <b>Kovacevic</b>
3	13-18	Obvious over <b>Balderrama</b> and <b>Java Complete</b>
4	13-18	Anticipated by <b>Haverstock</b>
5	13-18	Obvious over <b>Popp</b> and Amati
6	13-18	Obvious over <b>Kovacevic</b> and Amati
7	13-18	Obvious over <b>Balderrama</b> , <b>Java Complete</b> , and Amati
8	13-18	Obvious over <b>Haverstock</b> , <b>Java Complete</b> , and Amati
9	13-18	Obvious over <b>Popp</b> and Kerschberg
10	13-18	Obvious over <b>Kovacevic</b> and Kerschberg
11	13-18	Obvious over <b>Balderrama</b> , <b>Java Complete</b> , and Kerschberg
12	13-18	Obvious over <b>Haverstock</b> , <b>Java Complete</b> , and Kerschberg

- On May 13, 2022, the Central Reexamination Unit (CRU) issued a decision ordering reexamination, finding that the request raises a substantial new question of patentability (SNQ) affecting claims 13-18 of the '111 patent (the order).<sup>18</sup>
- On July 15, 2022, patent owner filed a petition entitled "Patent Owner's Petition for Suspension of the Rules and for Summary Termination of Reexamination, as a Matter of Law, Pursuant to 37 C.F.R. §§ 1.181, 1.182, and 1.183" (the petition).

<sup>13</sup> See *RPX Corporation v. Applications In Internet Time, LLC*, IPR2015-01750, Paper No. 60 (PTAB May 12, 2016).

<sup>14</sup> See *RPX Corporation v. Applications In Internet Time, LLC*, IPR2015-01750, Paper No. 80 (PTAB Dec. 28, 2016).

<sup>15</sup> See *Applications in Internet Time, LLC v. RPX, Corp.*, 897 F.3d 1336 (Fed. Cir. 2018). The Federal Circuit concluded "that the Board applied an unduly restrictive test for determining whether a person or entity is a 'real party in interest' within the meaning of § 315(b) and failed to consider the entirety of the evidentiary record in assessing whether § 315(b) barred institution of [the IPR]." *Id.* at 1338.

<sup>16</sup> See *RPX Corporation v. Applications In Internet Time, LLC*, IPR2015-01750, Paper No. 128, 40 (PTAB Oct. 2, 2020).

<sup>17</sup> A bolded reference indicates Salesforce or RPX knew about the reference at the time of the '1750 IPR.

<sup>18</sup> See "Order Granting Request for *Ex Parte* Reexamination," Control No. 90/019,069 (May 13, 2022).

- On July 29, 2022, requester filed a paper entitled “Opposition to Patent Owner’s Petition for Suspension of the Rules and for Summary Termination of Reexamination, as a Matter of Law, Pursuant to 37 C.F.R. §§ 1.181, 1.182, and 1.183” (the opposition).
- On October 6, 2022, patent owner filed a petition entitled “Patent Owner’s Petition to Expunge Third Party Requestor’s Opposition, Under 37 C.F.R. §§ 1.181, 1.182, and/or 1.183” (the petition to expunge).

### STATUS OF THE CLAIMS

The ’111 patent issued with claims 1-18. Claims 1-12 were cancelled by statutory disclaimer. Claims 13-18 are subject to reexamination.

### DECISION

#### I. Patent owner’s petitions

##### A. Patent owner’s petition under 37 CFR 1.183 to waive 37 CFR 1.540

In the July 15, 2022 petition, patent owner requests waiver of the provisions of 37 CFR 1.540 under 37 CFR 1.183 to permit entry and consideration prior to examination of patent owner’s concurrently-filed petition requesting termination of the ’069 reexamination.<sup>19</sup>

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 order granting *ex parte* reexamination in the ’069 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. Likewise, permitting patent owner to call attention to potential issues involving 35 U.S.C. 325(d) serves an important purpose in ensuring that proper consideration was given on whether to exercise discretion to move forward with an otherwise meritorious request for reexamination. In view of the specific facts and circumstances of the present proceeding, patent owner’s petition under 37 CFR 1.183 to waive 37 CFR 1.540 for consideration of the patent owner’s petition requesting termination of the ’069 reexamination is **granted**. The provisions set forth in the second sentence of 37 CFR 1.540 are hereby waived. Patent owner’s petition requesting termination of the ’069 reexamination has been entered and considered as set forth in section IV of this decision.

##### B. Patent owner’s petition requesting termination of the 90/019,069 proceeding

In the July 15, 2022 petition, patent owner requests termination of the ’069 reexamination on several bases. Patent owner’s petition is taken as a petition under 37 CFR 1.181, requesting that the Director exercise supervisory authority and vacate the decision to order reexamination. Patent owner requests termination pursuant to 35 U.S.C. 315(e)(1) on the basis that the requester Salesforce was a real party in interest of petitioner RPX in the ’1750 IPR, the grounds raised in the instant request were raised or reasonably could have been raised in the ’1750 IPR, and the ’1750 IPR resulted in a final written decision

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<sup>19</sup> Petition at 21-22.

under 35 U.S.C. 318(a).<sup>20</sup> Thus, patent owner asserts that requester's certification pursuant to 37 CFR 1.510(b)(6) is improper.<sup>21</sup> Patent owner also requests termination pursuant to 35 U.S.C. 325(d) and *In re Vivint*, 14 F.4th 1342 (Fed. Cir. 2021);<sup>22</sup> as *ultra vires* because the Director failed to serve patent owner with a copy of the reexamination request;<sup>23</sup> and as *ultra vires* because the '111 patent is expired.<sup>24</sup>

### C. Patent owner's petition to expunge the opposition

In response to patent owner's petition requesting termination of the 90/019,069 proceeding, requester filed an opposition, which was entered and considered, as set forth below in section II. In response to the requester's opposition, patent owner filed the October 6, 2022 petition to expunge the opposition. After an opposition to a patent owner's 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's opposition paper is improper and will not be considered. There is a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination. See MPEP § 2267. The October 6, 2022 patent owner's petition to expunge the opposition addresses the merits of requester's opposition; therefore, the October 6, 2022 patent owner paper is an **improper paper**, and it will not be made of record in the file of the present reexamination proceeding.

### II. Requester's opposition

Requester's July 29, 2022 paper is taken as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.540 prior to the issuance of a non-final action on the merits for entry and consideration of requester's arguments in opposition to the patent owner's petition requesting termination of the '069 reexamination. Requester is permitted to file a paper in opposition to the patent owner's petition requesting termination of the '069 reexamination, 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. See, e.g., MPEP § 2246, subsection II. Moreover, the opposition is solely directed to opposing the patent owner's arguments regarding termination of the '069 reexamination and does not include arguments regarding the patentability of the claims at issue in the present reexamination proceeding. For these reasons, the opposition has a right of entry in the present reexamination proceeding. Accordingly, requester's petition under 37 CFR 1.183 to permit consideration of the opposition **is moot**. The opposition has been entered and considered to the extent it addresses patent owner's arguments regarding termination of the '069 reexamination.

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

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.

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<sup>20</sup> Petition at 6-15.

<sup>21</sup> Petition at 15-16.

<sup>22</sup> Petition at 4-6.

<sup>23</sup> Petition at 16-18.

<sup>24</sup> Petition at 18-21.

## A. Analysis of the estoppel elements

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:<sup>25</sup>

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 ground(s) that were raised or reasonably could have been raised by the requester during the *inter partes* review.

### 1. 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. The requester of the present reexamination proceeding is Salesforce. In the '1750 IPR, the PTAB determined that Salesforce is a real party in interest of RPX.<sup>26</sup> Thus, the record shows that the requester, Salesforce, is a real party in interest of RPX, the petitioner of the '1750 IPR. The requester does not contest in the opposition that Salesforce is a real party in interest of RPX. Accordingly, the record shows that element 1 has been satisfied.

### 2. 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.<sup>27</sup> Claims 13-18 of the '111 patent are requested to be reexamined in the present reexamination proceeding. The record shows that claims 13-18 of the '111 patent were under review in the '1750 IPR.<sup>28</sup> Accordingly, the record shows that element 2 has been satisfied.

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<sup>25</sup> The four elements set forth in this decision are found in the language of the statute, 35 U.S.C. 315(e).

<sup>26</sup> See *RPX Corporation v. Applications In Internet Time, LLC*, IPR2015-01750, Paper No. 128, 2-3 (PTAB Oct. 2, 2020) (“[W]hen considering the entirety of the evidentiary record, including evidence relating to RPX’s business model and RPX’s relationship with Salesforce. . . as well as equitable and practical considerations, we determine that Salesforce is a real party in interest of RPX.”).

<sup>27</sup> The Federal Circuit has specifically held that 35 U.S.C. 315(e)(1) applies on a claim-by-claim basis. See *Credit Acceptance v. Westlake Servs.*, 859 F.3d 1044, 1052-53 (Fed. Cir. 2017), where the Federal Circuit explained (emphasis in italics in 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.

<sup>28</sup> See *RPX Corporation v. Applications In Internet Time, LLC*, IPR2015-01750, Paper No. 80, 2 (PTAB Dec. 28, 2016).



### 3. 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 final written decision pursuant to 35 U.S.C. 318(a) regarding claims 13-18 of the '111 patent was rendered by the PTAB in the '1750 IPR on December 28, 2016.<sup>29</sup> The Federal Circuit subsequently vacated the PTAB's final written decision and remanded to the PTAB for further proceedings.<sup>30</sup>

Requester argues that courts have "uniformly held" that estoppel does not apply following vacatur of final written decisions.<sup>31</sup> Requester's argument is not persuasive. The three, non-Federal Circuit decisions cited by requester do not support its position. *3<sup>rd</sup> Eye Surveillance* does not address § 315;<sup>32</sup> *General Access Solutions* does not address the relevant statutory language;<sup>33</sup> and *Power Integrations* is a non-binding district court decision.<sup>34</sup> Further, the district court decision in *Power Integrations* is in tension with guidance from the Federal Circuit. In *Intuitive Surgical, Inc. v. Ethicon LLC*, 25 F.4th 1035 (Fed. Cir. 2022), the Federal Circuit held 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.<sup>35</sup> *Intuitive Surgical* explains that the plain language of § 315(e) cannot be ignored based on other circumstances.<sup>36</sup> Therefore, the fact that the Federal Circuit vacated the PTAB's final written decision and remanded to the PTAB for further proceedings in the '1750 IPR does not negate the § 315(e)(1) estoppel effect resulting from the final

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<sup>29</sup> See *RPX Corporation v. Applications In Internet Time, LLC*, IPR2015-01750, Paper No. 80, 36 (PTAB Dec. 28, 2016).

<sup>30</sup> See *Applications in Internet Time, LLC v. RPX, Corp.*, 897 F.3d 1336, 1358 (Fed. Cir. 2018).

<sup>31</sup> See *opposition*, pages 16-19.

<sup>32</sup> In *3<sup>rd</sup> Eye Surveillance, LLC v. United States*, 145 Fed. Cl. 200, 205 (2019), the plaintiff filed suit alleging patent infringement under 28 U.S.C. 1498 in the Court of Federal Claims. The Court granted plaintiff's motion for leave to amend its complaint to address claims initially found to be unpatentable in a PTAB final written decision that was subsequently vacated over common law *res judicata* principles. The Court declined to apply *res judicata* based on differences between the PTAB and the court, including evidentiary standards. The Court did not address statutory estoppel under 35 U.S.C. 315(e)(2). Further, 35 U.S.C. 315(e)(2) only applies to "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" and therefore was not applicable to the § 1498 action involved there.

<sup>33</sup> 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.

<sup>34</sup> 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.

<sup>35</sup> 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.").

<sup>36</sup> 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 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.

written decision on claims 13-18. Requester's reliance on *Rumsfeld v. Freedom NY, Inc.*<sup>37</sup> for the proposition that "a vacated judgment 'has no preclusive force either as a matter of collateral or direct estoppel or as a matter of the law of the case'"<sup>38</sup> is also not persuasive, at least because *Rumsfeld* addresses the common law estoppel effect of vacated contract law judgments as opposed to the statutory estoppel provisions of 35 U.S.C. § 315.<sup>39</sup>

Thus, requester's arguments that courts have uniformly held that estoppel does not apply following vacatur of final written decisions are not persuasive. Therefore, the record shows that element 3 has been satisfied because the '1750 IPR resulted in a final written decision on claims 13-18.

#### **4. 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 ground(s) that were raised or reasonably could have been raised by the requester during the prior *inter partes* review.<sup>40</sup> The record shows that the grounds raised by the requester against claims 13-18 in the present reexamination proceeding were not previously raised in the prior *inter partes* review. Therefore, this element turns on whether the grounds reasonably could have been raised by the requester during the prior *inter partes* review.

##### **i. "Reasonably could have 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."<sup>41</sup> 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 distinguishes the meaning of the language "reasonably could have raised" from an interpretation which would have required a "scorched-earth search":<sup>42</sup>

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*

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<sup>37</sup> 329 F.3d. 1320, 1332 (Fed. Cir. 2003)

<sup>38</sup> See opposition, page 19.

<sup>39</sup> In contrast, *Intuitive Surgical* and *Click-To-Call* are Federal Circuit decisions that specifically address the provisions of 35 U.S.C. 315.

<sup>40</sup> 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, pages 14-16, for a discussion of Office policy.

<sup>41</sup> See 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).

<sup>42</sup> 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).

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.” See *Praxair Distribution, Inc. et al. v. INO Therapeutics, LLC*, IPR2016-00781, Paper No. 10 (PTAB August 25, 2016), page 9.

## **ii. All grounds in the present request reasonably could have been raised in the ’1750 IPR**

The Office has determined that each of the grounds reasonably could have been raised in the ’1750 IPR. As set forth above, the record demonstrates that Haverstock, Popp, Kovacevic, Balderrama and Java Complete were known to Salesforce and RPX at the time of the ’1750 IPR.<sup>43</sup> Moreover, as set forth below, the record as a whole demonstrates that a skilled searcher conducting a diligent search reasonably could have been expected to discover the remaining prior art in the underlying reexamination request here (Kerschberg and Amati).

In view of the number of commercial databases available to the public, most patents and printed publications may, in general, be expected to be discovered by a skilled searcher conducting a diligent search. Kerschberg and Amati are widely accessible and in the same technical field as the other references.<sup>44</sup> It is uncontested that Kerschberg and Amati are available in commercial databases, including *inter alia* Google Scholar.<sup>45</sup> Requester does not provide any evidence, or even argue, that Kerschberg and Amati would not have been discovered by a skilled searcher conducting a diligent search. It is also apparent that a “scorched-earth search” would not have been required to uncover the prior art applied in the grounds in the request. Consequently, the record does not show that Kerschberg and Amati are obscure documents that are unlikely to be discovered upon a reasonably diligent search of the relevant prior art at the time of filing the ’1750 IPR.

Therefore, the proposed grounds in the present request based on the Haverstock, Popp, Kovacevic, Balderrama, Java Complete, Kerschberg and Amati references reasonably could have been raised in the prior ’1750 IPR, and the record shows that element 4 has been satisfied.

## **B. The estoppel provisions of 35 U.S.C. 315(e)(1) apply**

The record sufficiently shows that the estoppel provisions of 35 U.S.C. 315(e)(1) apply with respect to claims 13-18 of the ’111 patent. As stated above, the record shows that the third party requester of the present reexamination proceeding (Salesforce) is a real party in interest of the petitioner of the ’1750 IPR (RPX), and that IPR resulted in USPTO issuance of a final written decision pursuant to 35 U.S.C. 318(a) regarding claims 13-18. Further, the proposed grounds in the present request reasonably could have been raised by Salesforce and RPX in the prior ’1750 IPR. The Haverstock, Popp, Kovacevic, Balderrama and Java Complete references were known to Salesforce and RPX at the time of the ’1750 IPR. Moreover, it is uncontested that a skilled searcher conducting a diligent search reasonably could

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<sup>43</sup> Haverstock was raised by Salesforce in the ’0162 CBM; Popp, Kovacevic, Balderrama and Java Complete were raised by RPX in the ’1750 IPR.

<sup>44</sup> See request, pages 32-41, 110, 112-113, 115, 119-120, 122, and 124 (stating that Kerschberg and Amati, as well as the other prior art references, are directed to the same field of information processing).

<sup>45</sup> See Declaration of Sylvia D. Hall-Ellis, PH.D., filed April 1, 2022, pages 24-29 and 34-39 (requester’s expert) and Declaration of Terry W. Kramer, Esq., filed July 15, 2022, pages 3-6 (patent owner’s expert).

have been expected to discover Kerschberg and Amati at the time of the '1750 IPR. Accordingly, under the particular facts and circumstances in this instance, the requester is estopped under 35 U.S.C. 315(e)(1) from requesting reexamination of claims 13-18 of the '111 patent on the grounds raised in the request.

#### **IV. Requester's certification pursuant to 37 CFR 1.510(b)(6) is improper and the 90/019,069 reexamination proceeding is terminated**

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.

As set forth in section III of this decision, requester is estopped under 35 U.S.C. 315(e)(1) from requesting reexamination of claims 13-18 of the '111 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 '069 reexamination proceeding is hereby **terminated**.

Patent owner's July 15, 2022 petition under 37 CFR 1.181(a) requesting that the Office vacate the reexamination order of May 13, 2022 pursuant to 35 U.S.C. 315(e)(1) is **granted**. The order granting reexamination mailed on May 15, 2022, and other communications issued by the Office in the '069 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 Image File Wrapper (IFW) to create a record. Because the '069 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.

#### **V. Patent owner's remaining bases for requesting termination are moot**

Because the Office finds that the estoppel provisions of 35 U.S.C. 315(e)(1) apply to the requester under the particular facts and circumstances in this instance, as set forth in section III of this decision, and terminated the '069 reexamination proceeding, as set forth in section IV of this decision, the Office need not address patent owner's other asserted bases for termination of the '069 reexamination proceeding.

### **CONCLUSION**

1. Patent owner's July 15, 2022 petition under 37 CFR 1.181(a) requesting that the Office vacate the reexamination order of May 13, 2022 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 claims 13-18 of the '111 patent. As a result, the present reexamination proceeding is hereby **terminated**.
3. The order granting reexamination mailed on May 13, 2022 is **vacated**.
4. All other papers of record which were issued by the Office in the '069 reexamination proceeding, as a whole, are **vacated**.
5. **All papers**, including the request papers, previously issued Office communications including the May 13, 2022 order granting reexamination, 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 Nicole D. Haines, Senior Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717, or Andrea S. Grossman, Legal Advisor, at (571) 270-3314.

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May 25, 2023