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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD DITZIK

Appeal 2018-000087
Application 14/169,232¹
Patent 7,103,380
Technology Center 3900

Before CAROLYN D. THOMAS, BRUCE R. WINSOR, and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

ENGLE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 15, 16, 18–20, 22, 23, and 25–31, which are all of the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Technology

The application relates to wireless handset communication. Spec. Title. Claim 15 is illustrative and reproduced below with certain limitations at issue emphasized:

¹ According to Appellant, the real party in interest is NetAirus Technologies, LLC. App. Br. 2.

15. A method for handset unit communication comprising the following steps in any order:

a) transmitting first data via wireless communication to a local area communication base unit located at a distance from within the same room as the handset unit to a nearby room;

b) receiving second data via wireless communication from the local area communication base unit located at a distance from within the same room as the handset unit to a nearby room;

c) controlling said handset unit to communicate the first and second data to and from the local area communication base unit and to communicate third and fourth data to and from an external wide area network, wherein *each data is switched selectively under program control*, wherein the first, second, third and fourth data are not necessarily performed simultaneously, and wherein the external wide area network is a cellular telephone network;

d) wherein the transmit power level of the handset unit when transmitting to the local area communication base unit is lower than when transmitting to the external wide area network;

e) wherein *the first and second data include data formatted for computer e-mail*;

f) wherein said handset unit includes an embedded microprocessor and is *configured to permit PDA functions* in addition to handset unit communication functions;

g) and, in further combination: permitting recording with and communication of video data;

h) permitting Internet access;

i) *permitting email* and voice mail; and

j) allowing hands-free use through inclusion of a built-in speaker and microphone.

Rejections

Claims 15, 16, 18–20, 22, 23, and 25–31 stand rejected due to issue preclusion² from prior litigation. Final Act. 6.

Claims 15, 16, 18–20, 22, 23, and 25–31 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Final Act. 6.

ISSUE

Did the Examiner err in rejecting claims 15, 16, 18–20, 22, 23, and 25–31 based on issue preclusion from prior litigation?

BACKGROUND

Prosecution and Litigation History

The present application (14/169,232) seeks a reissue of U.S. Patent No. 7,103,380 (“the ’380 patent”). The ’380 patent issued with claims 1–14. The ’380 patent then went through one *ex parte* reexamination, two district court litigations (one of which was appealed), one *inter partes* review, and the present reissue proceedings.

After reexamination (90/011,882), a certificate issued on October 8, 2012, canceling claim 1, confirming claim 2, amending claims 3–7, and upholding claims 8–13 due to dependency. Claim 14 was not reexamined.

² For clarity, we use the term “issue preclusion” rather than “collateral estoppel” or “res judicata,” which the briefs sometimes use. *E.g.*, App. Br. 11; Ans. 2. “In older case law, courts sometimes spoke of *res judicata* in contrast to collateral estoppel. However, because *res judicata* can also be used in the sense of any preclusion of litigation arising from a judgment, including collateral estoppel, . . . courts . . . for clarity have substituted the terms ‘claim preclusion’ and ‘issue preclusion.’” *Foster v. Hallco Mfg. Co.*, 947 F.2d 469, 478 (Fed. Cir. 1991).

In the first litigation, a jury held claims 3, 7, and 9–12 invalid for lack of written description, and the district court denied the patent owner’s motions for a new trial and judgment as a matter of law. *NetAirus Techs., LLC v. Apple, Inc.*, No. 10-3257, 2014 WL 12558860, at *13–19 (C.D. Cal. Mar. 7, 2014) (hereinafter, “*NetAirus I*”). The Federal Circuit affirmed under Rule 36. *NetAirus Techs., LLC v. Apple Inc.*, 587 F. App’x 658 (Fed. Cir. 2014) (hereinafter, “*NetAirus Appeal*”). The Supreme Court denied the patent owner’s petition for writ of certiorari. *NetAirus Techs., LLC v. Apple, Inc.*, 136 S. Ct. 54 (2015).

In the second litigation (involving the same parties and district court but different claims), the district court held claims 2, 4–6, 8, and 13 unpatentable due to issue preclusion from the first litigation. *NetAirus Techs., LLC v. Apple Inc.*, No. 13-3780, 2016 WL 5898640, at *3 (C.D. Cal. Mar. 23, 2016) (hereinafter, “*NetAirus II*”). Appellant has not provided any evidence of appeal in the second district court litigation.

The ’380 patent also was at issue in an *inter partes* review (IPR2014-00030), although the parties jointly requested and were granted termination before a decision on institution. *See* Judgment, Paper 13 (Mar. 4, 2014).

In the present reissue application, Appellant canceled claims 2–14. *See* Remarks 12 (Apr. 7, 2016). Claims 17, 21, and 24 were subsequently canceled and claim 1 was canceled previously during reexamination, so only new claims 15, 16, 18–20, 22, 23, and 25–31 are pending. *See* Amendment 16 (Jan. 5, 2017). All pending claims stand rejected on both (1) issue preclusion due to the two earlier district court litigations resolving the same written description issues and (2) lack of written description on the merits. Final Act. 4–6 (issue preclusion), 6–25 (written description).

Illustrative Invalid Claim

Claim 2, which depended from claim 1, is illustrative of the claims held invalid for lack of written description in the district court litigations. Claims 1 and 2—now both canceled—are reproduced below with certain limitations emphasized.

1. A method for handset unit communication comprising the following steps in any order:

a) transmitting first data via wireless communication to a local area communication base unit a relatively short distance away;

b) receiving second data via wireless communication from the local area communication base unit a relatively short distance away;

c) *using said handset unit to communicate, selectively, the first and second data to and from the local area communication base unit and to communicate third and fourth data to and from an external wide area network, wherein the communication of the first, second, third and fourth data are not necessarily performed simultaneously, and wherein the transmit power level of the handset unit when transmitting to the local area communication base unit is lower than when transmitting to the external wide area network; and*

d) *wherein the first and second data include data formatted for computer e-mail.*

2. The method for handset unit communication as recited in claim 1, wherein *said handset unit is configured to a personal digital assistant (PDA) having PDA functions* in addition to handset unit communication functions.

ANALYSIS

Issue Preclusion

The Examiner invokes issue preclusion to prevent re-litigating issues of written description already litigated in the district court cases.

Under the doctrine of issue preclusion, also called collateral estoppel, a judgment on the merits in a first suit precludes relitigation in a second suit of issues actually litigated and determined in the first suit. Issue preclusion, as distinguished from claim preclusion, does not include any requirement that the claim (or cause of action) in the first and second suits be the same. Rather, application of issue preclusion centers around whether an issue of law or fact has been previously litigated. The underlying rationale of the doctrine of issue preclusion is that a party who has litigated an issue and lost should be bound by that decision and cannot demand that the issue be decided over again.

In re Freeman, 30 F.3d 1459, 1465 (Fed. Cir. 1994) (citations omitted).

The Supreme Court has explained that “[t]o preclude parties from contesting matters that they have had a full and fair opportunity to litigate protects their adversaries from the expense and vexation attending multiple lawsuits, conserves judicial resources, and fosters reliance on judicial action by minimizing the possibility of inconsistent decisions.” *Montana v. United States*, 440 U.S. 147, 153–54 (1979).

Issue preclusion is only appropriate, however, if the following conditions are met:

- (1) the issue is identical to one decided in the first action;
- (2) the issue was actually litigated in the first action;
- (3) resolution of the issue was essential to a final judgment in the first action; and
- (4) the party against whom estoppel is invoked had a full and fair opportunity to litigate the issue in the first action.

Innovad Inc. v. Microsoft Corp., 260 F.3d 1326, 1334 (Fed. Cir. 2001).

Though not neatly organized into the categories above, Appellant argues issue preclusion should not apply because (A) the standards of proof differ between a district court and the PTO; (B) the new claims differ from the invalidated claims; (C) Appellant provides new evidence; (D) incorrect trial testimony led to the district court and Federal Circuit reaching the wrong result; (E) Appellant did not have a full and fair opportunity to litigate; (F) the district court's judgments are not final; (G) the PTO was not a party to the prior litigations; and (H) the Board should use its discretion to provide expert guidance. We address each argument in turn below.

A) Standards of Proof

Appellant argues issue preclusion should not apply because “[t]he patent office uses a different standard than the courts.” App. Br. 11.

It is true that for invalidity, district courts apply a different standard of proof than the PTO.

In particular, a challenger that attacks the validity of patent claims in civil litigation has a statutory burden to prove invalidity by clear and convincing evidence. Should the challenger fail to meet that burden, the court will not find the patent “valid,” only that the patent challenger did not carry the burden of establishing invalidity in the *particular case* before the court. In contrast, in PTO [proceedings] the standard of proof—a preponderance of the evidence—is substantially lower than in a civil case and there is no presumption of validity in [PTO] proceedings.

In re Baxter Int’l, Inc., 678 F.3d 1357, 1364 (Fed. Cir. 2012) (quotations omitted); *see also Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144 (2016) (noting same difference in standards for *inter partes* review). District courts and the PTO also apply different standards for claim construction, and “the use of the broadest reasonable construction standard in [PTO

proceedings], together with use of an ordinary meaning standard in district court, may produce inconsistent results.” *Cuozzo*, 136 S. Ct. at 2146.

Nevertheless, the Supreme Court has held “issue preclusion is not limited to those situations in which the same issue is before two *courts*. Rather, where a single issue is before a court and an administrative agency, preclusion also often applies.” *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1303 (2015); *see also MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373, 1376 (Fed. Cir. 2018) (“The TTAB, at issue in *B & B Hardware*, and the Board, in this case, are indistinguishable for preclusion purposes.”). The Federal Circuit likewise has affirmed the Board’s application of issue preclusion based on prior district court determinations, including claim constructions. *E.g., Freeman*, 30 F.3d at 1365–69. Given such precedent, we are not persuaded that a difference in standards automatically prevents issue preclusion. “Granted, redetermination of issues is warranted if there is reason to doubt the quality, extensiveness, or fairness of procedures followed in prior litigation. But again, this only suggests that sometimes issue preclusion might be inappropriate, not that it always is.” *B & B Hardware*, 135 S. Ct. at 1309 (quotation and citations omitted). Here, there is no evidence that differences in standards of proof would change whether the issues are identical, whether the issues were actually litigated, or whether Appellant had a full and fair opportunity to litigate in the first forum.

In dismissing one recent appeal involving a final PTO decision and pending district court litigation, the Federal Circuit suggested that “[b]ecause the Board applies the broadest reasonable construction . . . , the issue of claim construction under *Phillips* to be determined by the district

court has not been actually litigated.” *SkyHawke Techs., LLC v. Deca Int’l Corp.*, 828 F.3d 1373, 1376–77 (Fed. Cir. 2016). Thus, if the *issue* were claim construction, then issue preclusion may or may not apply. *Compare id.*, with *Freeman*, 30 F.3d at 1365–69. But here, the issue is written description, and Appellant has not offered any evidence that differing claim construction standards affect the written description determination.

Appellant’s reliance on *Novartis* and *Baxter* is misplaced because the facts in those cases were the reverse of the present case. App. Br. 15 (citing *Novartis AG v. Noven Pharms. Inc.*, 853 F.3d 1289 (Fed. Cir. 2017); *Baxter*, 678 F.3d 1357). The Examiner correctly explains that in *Novartis* and *Baxter*, the party seeking to prove invalidity *failed* to meet the higher standard of proof in a district court, but that says nothing about whether the same evidence could meet a lower standard in the PTO. Ans. 5. Here, however, the party seeking to prove invalidity *succeeded* in meeting the higher standard of proof in district court, which typically means the same evidence should also meet the lower standard in the PTO. In the same way, winning a race when you were given a head start says nothing about whether you could win the same race without the head start, but if you lost a race even with a head start, then it is typically not worthwhile re-racing *without* the head start because it would not change the result. Thus, as the Examiner explained, “the different standards weigh even more in favor of res judicata [i.e., issue preclusion]” because “the differing standards makes it even easier to invalidate claims in the Office.”³ Ans. 3.

³ Appellant argues there should be equal treatment between patent owners and challengers. App. Br. 15; Reply Br. 21. But that is exactly what happens if the order of the proceedings is reversed. If a challenger *fails* to

Appellant has not explained why any difference in standards are relevant to this case, in which invalidity already was proven at a higher standard of proof. Given this record, we are not persuaded that any differences in standards affects whether the issues are identical, whether the issues were actually litigated, or whether Appellant already had a full and fair opportunity to litigate the issues in the district court litigation.

B) Differences in Claim Language

Appellant argues “[t]he claims in the Reissue Appeal have been amended relative to, and hence are different than, the claims that were previously litigated. Hence, res judicata should not apply.” App. Br. 14.

We agree with the Examiner, however, that “the difference in claims does not matter here, as the *issues* are what is important under the case law, and the written description *issues* here are the same as those present in the district court.” Ans. 3.

The Federal Circuit “does not limit collateral estoppel to patent claims that are identical. Rather, it is the identity of the *issues* that were litigated that determines whether collateral estoppel should apply.” *Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013). “If the differences between the unadjudicated patent claims and adjudicated patent claims do not materially alter the question of invalidity, collateral estoppel applies” because “the mere use of different words in these portions of the claims does not create a new issue of invalidity.” *Id.* at 1342, 1343.

meet the lower standard to prove invalidity in a PTO proceeding, then the same challenger typically is estopped from relying on the same arguments and evidence to prove invalidity in subsequent proceedings. *E.g.*, 35 U.S.C. § 315(e) (estoppel for IPR).

Here, Appellant argues the claims are “different” (App. Br. 14), yet we agree with the Examiner that Appellant has not identified any way in which the new language materially affects the written description issues litigated before the district court. Ans. 5. The new claims all contain terms that are the same or substantially the same as the terms found to lack written description in the prior litigations. Specifically, the prior litigations held “the ’380 Patent lacked a sufficient written description as to . . . (i) a handset that can send and receive mail; (ii) a handset that can selectively communicate; and (iii) a handset that can perform the functions of a PDA.” *NetAirus II*, 2016 WL 5898640, at *3. All three of these written description issues are also in the two new independent claims, as shown below:

Issued Claims (held invalid)	New Claims (on appeal)
<p><i>Claim 2 (via claim 1):</i> “using said handset unit to communicate . . . the first and second data . . . wherein the first and second data include data formatted for computer e-mail”</p> <p><i>Claim 7:</i> “said handset unit data includes data formatted for e-mail”</p>	<p><i>Claim 15:</i> “controlling said handset unit to communicate the first and second data . . . wherein the first and second data include data formatted for computer e-mail” AND “A method for handset unit communication comprising . . . permitting email”</p> <p><i>Claim 18:</i> “the handset data includes data formatted for computer e-mail” AND “said handset unit includes an embedded microprocessor . . . programmed to carry out . . . email . . . communications”</p>

Issued Claims (held invalid)	New Claims (on appeal)
<p><i>Claim 2 (via claim 1):</i> “using said handset unit to communicate, selectively, the first and second data to and from the local area communication base unit and to communicate third and fourth data to and from an external wide area network”</p>	<p><i>Claim 15:</i> “controlling said handset unit to communicate the first and second data to and from the local area communication base unit and to communicate third and fourth data to and from an external wide area network, wherein each data is switched selectively under program control”</p> <p><i>Claim 18:</i> “controlling said handset unit to communicate the first and second data to and from the local area network communication base unit and to communicate third and fourth data to and from an external wide area cellular network selectively under program control”</p>
<p><i>Claim 2:</i> “said handset unit . . . having PDA functions”</p>	<p><i>Claim 15:</i> “said handset unit . . . is configured to permit PDA functions”</p> <p><i>Claim 18:</i> “said handset unit . . . is programmed to carry out PDA functions”</p>

We note that in *NetAirus II*, as here, NetAirus argued the claims were “different” and contained “additional limitations.” *NetAirus II*, 2016 WL 5898640, at *3. Yet the district court dismissed such arguments because the claims still contained the same limitations found to lack written description in *NetAirus I*. *Id.* The same is true here. Just as in *Ohio Willow*, Appellant has not explained how any differences in claim language alter the written

description determination. 735 F.3d at 1343. Therefore, despite modifications to the claim language, Appellant has not persuaded us the Examiner erred in determining the written description issues are identical.

C) New Evidence

Appellant argues “Dr. Alon Konchitsky’s Declaration and Evidence Exhibits 1001-1004 . . . and [Mr. Richard] Ditzik’s Declaration and evidence Exhibits A to H . . . were not a part of . . . the previous *NetAirus v Apple* cases. Thus, key evidence is not the same.” App. Br. 14.

We agree with the Examiner, however, that Appellant has not shown how this new evidence is relevant to any issue preclusion analysis rather than merely seeking to re-litigate the same issue on the merits. Ans. 6. One factor the Supreme Court looks to in deciding issue preclusion is “whether without fault of his own the patentee was deprived of crucial evidence or witnesses in the first litigation.” *Blonder-Tongue Labs., Inc. v. Univ. of Illinois Found.*, 402 U.S. 313, 333 (1971). Here, however, Appellant has made no effort to show it did not have a full and fair opportunity to present this same evidence in the prior litigation.

Mr. Ditzik is the named inventor who already testified at trial. App. Br. 19. The district court further considered Mr. Ditzik’s trial testimony in post-trial motions. *NetAirus I*, 2014 WL 12558860, at *15 (“NetAirus attempted to establish written description support by having the inventor, Ditzik, testify as to the number of times the patent referenced the terms ‘PDA’ and ‘email’ [but] provided no basis to support the combination of those elements with a handset”). Appellant fails to explain whether Mr. Ditzik either presented or could have presented the same evidence in his previous trial testimony.

Similarly, Appellant had a different technical expert testify at trial. App. Br. 17–18 (“NetAirus’ Technical Expert was: Blackburn,” who testified on trial days 3 and 4). Appellant has made no effort to explain whether the substance of Dr. Konchitsky’s declaration and exhibits either was presented or could have been presented by its technical expert in the district court litigation.

Instead, Appellant appears to use the new evidence merely to re-litigate the same issues that were before the district court. Yet the mere existence of new evidence is insufficient to avoid issue preclusion without more, such as an explanation of why the substance of the new evidence could not have been used in the prior proceedings.

Appellant’s reliance on *Novartis* and *Baxter* is again unavailing. In both cases, the new evidence was “additional prior art.” *Novartis*, 853 F.3d at 1293 (quotation omitted); *Baxter*, 678 F.3d at 1365 (“prior art references that were not squarely at issue during the trial”). Appellant uses this to argue that patent challengers “have unlimited opportunities to find new evidence (prior art)” and “[e]qual justice should be symmetric to both prior plaintiffs and defendants.” Reply Br. 21. But in addition to Appellant’s “unlimited opportunities” argument being legally incorrect,⁴ the reason issue preclusion may not apply to new prior art is not merely because the art constitutes new *evidence* but rather because the art may raise new *issues* that were not previously litigated. *See, e.g.*, 35 U.S.C. § 325(d) (permitting

⁴ *E.g.*, 35 U.S.C. § 315(e) (providing estoppel on any ground an IPR petitioner raised or “reasonably could have raised”); *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, No. IPR2016-01357, 2017 WL 3917706 (PTAB Sept. 6, 2017) (precedential) (listing factors to consider given “[m]ultiple, staggered [IPR] petitions challenging the same patent”).

consideration of whether “the same or substantially the same prior art or arguments previously were presented”). Here, Appellant’s new evidence addresses the *same issue* actually litigated in the district court, and Appellant has not identified any way in which it did not have a full and fair opportunity to present the same material in the prior litigation.

As the Supreme Court has instructed for more than a hundred years, “[w]hatever is new in the evidence now before us, . . . [t]he application to consider that evidence is practically an application for a rehearing as to things directly determined in the former suits Such a course of procedure is wholly inadmissible under the settled rule of res judicata.” *S. Pac. R. Co. v. United States*, 168 U.S. 1, 65 (1897).

D) Alleged Errors in Trial Testimony

Appellant argues issue preclusion should not apply because “the [district] court’s judgment was based on faulty testimony and procedures” and “the Federal Circuit wrongly affirmed” because the case “was based on erroneous and faulty testimony and evidence. This produced a *faulty factual predicate*’ . . . [and] the court apparently did not consider the legitimacy of the testimony.” *Id.* at 11–12, 19.

Specifically, Appellant argues “the defense’s expert witness and attorney provided erroneous testimony and evidence to the court.” App. Br. 20. Appellant then identifies what it believes were the “inaccuracies” of the trial testimony of Apple’s expert witness regarding patent law or the ’380 patent, such as Apple’s expert focusing on isolated excerpts of the Specification and not considering the claims “in context” or from the perspective of a person having ordinary skill in the art. *Id.* at 20–27. Similarly, Appellant argues “claim terms were not interpreted consistently

during examination and litigation” (*id.* at 14), such as because Apple’s expert reached a different conclusion than the PTO examiners during the original prosecution and reexamination. *Id.* at 20–21.

Yet mere disagreement with the merits of an opposing witness’ testimony is insufficient because the losing party will always disagree with the opposing party’s expert. Instead, the proper inquiry is whether the party had a *full and fair opportunity* to counter such testimony (e.g., through cross-examination, objections, examination of one’s own witnesses, post-trial motions, and appeals). Here, Appellant does not dispute that it had the opportunity to cross-examine Apple’s expert, object as appropriate during Apple’s expert testimony, examine its own expert witness, examine the named inventor, move for judgment as a matter of law, move for a new trial, and appeal to the Federal Circuit. Ans. 7; App. Br. 17–19, 3–4.

Disagreement with the district court or the Federal Circuit likewise are no basis for avoiding issue preclusion. App. Br. 12, 19. “The fact that the [first tribunal] may have erred, however, does not prevent preclusion” because “issue preclusion prevents relitigation of wrong decisions just as much as right ones.” *B & B Hardware*, 135 S. Ct. at 1308 (quotation omitted). Thus, we agree with the Examiner that “Appellant had every opportunity during the litigation” to address errors in testimony and “again on appeal,” but having already litigated written description once, “the patent owner is estopped from continuing to litigate the issue in other forums.” Ans. 8–9.

E) Other Issues on a Full and Fair Opportunity to Litigate

Appellant in passing alludes to several other arguments regarding the trial proceedings, including the length of the trial, the jury not being

unanimous, and the health of lead counsel. App. Br. 17; Reply Br. 20. Yet we agree with the Examiner that Appellant has not explained whether and why any of these affected Appellant having a full and fair opportunity to litigate the written description issue. Ans. 7–8. Appellant concedes having at least six attorneys present at trial with at least five days of arguments and testimony and at least three days of jury deliberation. App. Br. 17–19. And just as in *Freeman*, “the fact that [the Federal Circuit] on appeal affirmed the district court’s conclusions . . . strongly suggests that the district court proceedings were not deficient.” *Freeman*, 30 F.3d at 1467. We therefore are not persuaded by Appellant’s additional arguments that it did not have a full and fair opportunity to litigate the written description issue.

F) Finality of Judgments

Appellant argues “[f]uture motion(s) for a new trial may still be made under Fed. R. Civ. P. 60(b) in both cases, so neither decision is, at this point, final.” App. Br. 13. We agree with the Examiner, however, that this argument is without merit. Ans. 4.

“Federal Rules of Civil Procedure 60(b) provides a procedure whereby, in appropriate cases, a party may be relieved of a *final* judgment.” *Liljeberg v. Health Servs. Acquisition Corp.*, 486 U.S. 847, 863 (1988) (emphasis added). Rule 60(b) is titled “Grounds for Relief from a *Final* Judgment, Order, or Proceeding.” Fed. R. Civ. P. 60(b) (emphasis added). The Rule states: “On motion and just terms, the court may relieve a party or its legal representative from a *final* judgment, order, or proceeding for the following reasons.” *Id.* (emphasis added). Thus, to invoke Rule 60(b), the judgment necessarily must be final. Rule 60(c)(2) also expressly states, “The motion does not affect the judgment’s finality or suspend its

operation.” Thus, the availability of motions under Federal Rule of Civil Procedure 60(b) does not prevent the application of issue preclusion; to the contrary, both issue preclusion and Rule 60(b) *require* that a decision be final.

Moreover, during the appeal of the first litigation, Appellant repeatedly told the Federal Circuit that the district court’s decision was final:

1. “This appeal is being taken from a *final* judgment entered in Apple’s favor following a trial . . . as well as the trial court’s denial of NetAirus’ post-trial motions relating to that *final* judgment.” *NetAirus Appeal*, Appeal Brief 2 (June 6, 2014) (emphasis added).
2. “Following a jury trial, the trial court entered *final* judgment on January 2, 2014.” *Id.* at 1 (emphasis added).
3. “A *final* judgment order was entered consistent with the jury’s findings.” *Id.* at 4 (emphasis added).

Similarly, during the appeal, Appellant argued the Federal Circuit “has jurisdiction under 28 U.S.C. §§ 1291 and 1295(a)(1).” *NetAirus Appeal*, Appeal Brief 2 (June 6, 2014). Section 1295(a)(1) requires a *final* decision: “The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction . . . of an appeal from a *final* decision of a district court of the United States . . . in any civil action arising under . . . any Act of Congress relating to patents.” 28 U.S.C. § 1295(a)(1) (emphasis added).

Having already completed appeals for the first litigation to both the Federal Circuit and the Supreme Court—and relied upon the finality of the district court’s judgment to do so—Appellant cannot reasonably dispute that the district court’s invalidity judgment is final.

G) PTO Not Being a Party to Prior Litigations

Appellant argues issue preclusion should not apply because “the parties are not the same” and “the PTO was not even a party to the earlier district court litigation and cannot be bound by its outcome.” Reply Br. 18–19. However, “[t]here is no requirement that the parties be the same in both instances; preclusion may be invoked in a case involving the same plaintiff and . . . a non-party to the first action.” *Freeman*, 30 F.3d at 1467. Instead, “only the party *against whom the plea of estoppel was asserted* had to have been in privity with a party in the prior action.” *Blonder-Tongue*, 402 U.S. at 322 (emphasis added) (eliminating requirement of mutuality of parties).

Here, the party against whom issue preclusion is asserted is Appellant, not the PTO. Appellant states NetAirus is both the real party in interest in this application (App. Br. 2) and the plaintiff in the district court litigations (App. Br. 11). Thus, NetAirus had an opportunity to litigate written description in the district court, and the PTO need not have been a party to the prior litigation in order to assert issue preclusion against NetAirus.

H) Board’s Discretion & Expert Guidance

Appellant asks the Board to use its discretion under *Blonder-Tongue* to not apply issue preclusion and instead “make an independent in-depth review . . . without consideration of the previous erroneous evidence and testimony.” App. Br. 13, 16. In *Blonder-Tongue*, the Supreme Court held that “as so often is the case, no one set of facts, no one collection of words or phrases, will provide an automatic formula for proper rulings on estoppel pleas. In the end, decision will necessarily rest on the trial courts’ sense of justice and equity.” *Blonder-Tongue*, 402 U.S. at 333–34.

It is true that “[t]he doctrine of issue preclusion is premised on principles of fairness. Thus, a court is not without some discretion to decide whether a particular case is appropriate for application of the doctrine.” *Freeman*, 30 F.3d at 1467. Yet the Supreme Court in *Blonder-Tongue* also held that “the requirement of determining whether the party against whom an estoppel is asserted had a full and fair opportunity to litigate is a most significant safeguard.” *Blonder-Tongue*, 402 U.S. at 329. Here, Appellant has not given us any reason why justice, equity, or fairness should permit Appellant to re-litigate an issue it already had every opportunity and incentive to litigate and appeal. *See id.* at 333 (providing non-exhaustive list of factors). “Allowing the same issue to be decided more than once wastes litigants’ resources and adjudicators’ time, and it encourages parties who lose before one tribunal to shop around for another. The doctrine of collateral estoppel or issue preclusion is designed to prevent this from occurring.” *B & B Hardware*, 135 S. Ct. at 1298–99.

D) Conclusion on Issue Preclusion

We agree with the Examiner that (1) the written description issues are identical to the ones decided in the prior district court litigation, (2) the written description issues were actually litigated in the district court, (3) resolution of the written description issues was essential to a final judgment in the district court action, and (4) NetAirus had a full and fair opportunity to litigate the written description issues in the district court. *See Innovad*, 260 F.3d at 1334. Therefore, given the record before us, we are not persuaded the Examiner erred in applying issue preclusion.

Accordingly, we sustain the Examiner’s rejection of claims 15, 16, 18–20, 22, 23, and 25–31 on the basis of issue preclusion.

Written Description

Because we hold that issue preclusion prevents Appellant from re-litigating issues of written description, we need not reach the merits of the Examiner’s written description rejection. To do otherwise would moot the benefits of judicial economy that issue preclusion is intended to promote. *B & B Hardware*, 135 S. Ct. at 1298–99.

Advisory Opinion on Canceled Claims

Although Appellant appeals only new claims 15, 16, 18–20, 22, 23, and 25–31 (*see* App. Br. 1), Appellant later asks the Board to “provide guidance as to the validity of claims 2-3.” App. Br. 42; Reply Br. 22. However, Appellant already canceled claims 2 and 3. Amendment 12 (Apr. 7, 2016) (“Claims 2 – 13 are herein cancelled.”). We decline to offer an advisory opinion on canceled claims.

DECISION

For the reasons above, we affirm the Examiner’s decision rejecting claims 15, 16, 18–20, 22, 23, and 25–31 on the basis of issue preclusion.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED