# United States Court of Appeals for the Federal Circuit

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**CLICK-TO-CALL TECHNOLOGIES LP,**
*Plaintiff-Appellant*

**v.**

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

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2022-1016

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

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Decided: August 17, 2022

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DANIEL J. SHIH, Susman Godfrey LLP, Seattle, WA, argued 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-appellees. Also represented by DAVID CLAY HOLLOWAY, MITCHELL G. STOCKWELL.

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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-

*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 Dezonno 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 Dezonno 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

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[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.

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