

No. 2023-1367

**IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

INGENICO INC.,
Plaintiff / Counterclaim Defendant-Appellee,

INGENICO CORP., INGENICO GROUP S.A.,
Counterclaim Defendants-Appellees
v.

IOENGINE, LLC,
Defendant / Counter-Claimant-Appellant.

Appeal from the United States District Court for the District of Delaware,
No. 1:18-cv-00826-WCB, Judge William C. Bryson

**APPELLANT IOENGINE, LLC'S CORRECTED
COMBINED PETITION FOR REHEARING AND REHEARING EN BANC**

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LANGUAGE OF THE PATENT CLAIMS AT ISSUE

Under FCR 32(a)(3), the following is the language of a patent claim at issue.

Claims 1-3 of U.S. Patent No. 9,059,969 (“the ’969 Patent”), Appx169:

1. A portable device configured to communicate with a terminal comprising a processor, an input component, an output component, a network communication interface, and a memory configured to store executable program code, including first program code which, when executed by the terminal processor, is configured to present an interactive user interface on the terminal output component, and second program code which, when executed by the terminal processor, is configured to provide a communications node on the terminal to facilitate communications to the portable device and to a communications network node through the terminal network communication interface, the portable device comprising:

- (a) an external communication interface configured to enable the transmission of communications between the portable device and the terminal;
- (b) a processor; and
- (c) a memory having executable program code stored thereon, including:
 - (1) third program code which, when executed by the portable device processor, is configured to provide a communications node on the portable device to coordinate with the communications node on the terminal and establish a communications link between the portable device and the terminal, and facilitate communications to the terminal and to a communications network node through the terminal network communication interface; and
 - (2) fourth program code which is configured to be executed by the portable device processor in response to a communication received by the

portable device resulting from user interaction with the interactive user interface;
wherein the portable device is configured to facilitate communications through the communication node on the terminal and the terminal network interface to a communications network node.

2. The portable device according to claim 1, wherein the fourth program code which, when executed by the portable device processor, is configured to cause a communication to be transmitted to the communication network node.

3. The portable device according to claim 2, wherein the communication caused to be transmitted to the communication network node facilitates verification of the portable device.

Claims 55-56 of U.S. Patent No. 9,774,703 (“the ’703 Patent”), Appx135:

55. A method implemented on a portable device comprising a processor, a memory having executable program code stored thereon, and an external communication interface for enabling the transmission of a plurality of communications between the portable device and a terminal, the terminal comprising a processor, an input component, an output component, a network communication interface, and a memory configured to store executable program code, including first program code which, when executed by the terminal processor, is configured to affect the presentation of an interactive user interface by the terminal output component, and second program code which, when executed by the terminal processor, is configured to provide a communications node on the terminal to facilitate communications to the portable device and to a communications network node through the terminal network communication interface, the method comprising:

(a) causing the terminal to execute the first program code to affect the presentation of an interactive user interface by the terminal output component;

- (b) executing third program code stored on the portable device memory to provide a communications node on the portable device configured to coordinate with the communications node on the terminal and establish a communications link between the portable device and the terminal, and to facilitate communications to the terminal and to a communications network node through the terminal network communication interface;
- (c) executing, in response to a communication received by the portable device resulting from user interaction with the interactive user interface, fourth program code stored on the portable device memory to cause a communication to be transmitted to a communications network node; and
- (d) facilitating communications through the terminal network communication interface to a communications network node.

56. The method according to claim 55, wherein the step of executing fourth program code stored on the portable device memory causes a communication to be transmitted to the communications network node to facilitate verification of the portable device.

CERTIFICATE OF INTEREST

Under Federal Circuit Rule 47.4, counsel for the Appellant IOENGINE, LLC certifies the following:

Under FCR 47.4(a)(1), the full name of every entity represented in this case by Appellant's counsel is:	IOENGINE, LLC
Under FCR 47.4(a)(2), the names of every real party in interest (if the real party named in the caption is not the real party in interest) represented by me are:	None.
Under FCR 47.4(a)(3), all parent corporations and any publicly held companies that own 10 percent or more of the stock of the entities represented by me in this case are:	None.
Under FCR 47.4(a)(4), the names of all law firms, partners, and associates that appeared for the entity now represented by me in the lower tribunal or are expected to appear in this court, other than those who have already entered an appearance in this Court, are:	Eve H. Ormerod, Smith, formerly of Katzenstein, & Jenkins LLP; Neal C. Belgam, Smith, Katzenstein, & Jenkins LLP; Judah Bellin, Dechert LLP; Luke M. Reilly, Dechert LLP; Derek Brader, Flaster Greenberg PC, formerly of Dechert LLP.
Under FCR 47.4(a)(5), other than the originating case numbers, the title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal:	<i>IOENGINE, LLC v. Ingenico, Inc.</i> , No. 2021-1227 (Fed. Cir.) (lead case, consolidated with Nos. 2021-1331, 2021-1332, 2021-1375, 2021-1376); <i>Ingenico, Inc. v. IOENGINE, LLC</i> , No. IPR2019-00879 (PTAB); <i>Ingenico, Inc. v. IOENGINE, LLC</i> , No. IPR2019-00929 (PTAB); <i>IOENGINE, LLC v. PayPal Holdings, Inc.</i> , Civ. No. 1:18-452 (D. Del.).

Under FCR 47.4(a)(6), information regarding organizational victims in criminal cases and debtors and trustees in bankruptcy cases:	Not applicable.
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Date: July 7, 2025

By: /s/ Noah M. Leibowitz

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STATEMENT OF RELATED CASES

Pursuant to Federal Circuit Rule 47.5(a), IOENGINE, LLC (“IOENGINE”) states that no appeal in or from the same civil action was previously before this or any other appellate court.

Under FCR 47.5(b), other than the originating case number, the following cases are known to counsel to be pending in this or any other court or agency that may directly affect or be directly affected by this court’s decision in the pending appeal because they also involve U.S. Patent No. 9,059,969 (“the ’969 Patent”) and U.S. Patent No. 9,774,703 (“the ’703 Patent”) (collectively, the “patents-in-suit”):

- *IOENGINE, LLC v. PayPal Holdings, Inc.*, Civ. No. 1:18-452 (D. Del.);
- *IOENGINE, LLC v. Ingenico, Inc.*, No. 2021-1227 (Fed. Cir.) (lead case, consolidated with Nos. 2021-1331, 2021-1332, 2021-1375, 2021-1376).

Under FCR 47.5(b)(2), the following parties, law firms, partners, and associates, other than those who have entered an appearance in this case, have appeared in those cases:

- PayPal Holdings, Inc.;
- Jared Bobrow, Alyssa M. Caridis, Jacob Heath, Travis Jensen, Robert Manhas, Tyler Miller, Parth Sagdeo, Robert L. Uriarte, Orrick, Herrington & Sutcliffe LLP;
- Jack B. Blumenfeld, Brian P. Egan, Morris, Nichols, Arsht & Tunnell LLP;

- Neal C. Belgam, Smith, Katzenstein, & Jenkins LLP;
- Eve H. Ormerod, formerly of Smith, Katzenstein, & Jenkins LLP;
- Robert W. Ashbrook Jr., Judah Bellin, Luke M. Reilly, Dechert LLP;
- Jacob Ryan Porter, formerly of Dechert LLP;
- Derek Brader, Flaster Greenberg PC, formerly of Dechert LLP;
- Christine Dealy Haynes, Richards, Layton & Finger;
- Robert M. Asher, Lawrence M. Green, Joel R. Leeman, Timothy Michael Murphy, Lisa M. Tittlemore, Sunstein LLP; and
- Beth Ann Swadley, Young, Conaway, Stargatt & Taylor LLP

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STATEMENT OF COUNSEL UNDER
FEDERAL CIRCUIT RULE 40(c)

Based on my professional judgment, I believe this appeal requires an answer to the following precedent-setting questions of exceptional importance:

Whether 35 U.S.C. § 315(e)(2) allows the petitioner in an *inter partes* review (“IPR”) that has resulted in a final written decision to avoid estoppel in a civil action by relabeling patents or printed publications that reasonably could have been raised as a “ground” in the IPR.

Whether 35 U.S.C. § 311(b) limits “a ground that could be raised under section 102 or 103” to only certain subparts of 35 U.S.C. §§ 102 or 103.

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States or the precedents of this Court: *California Institute of Technology v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022).

Date: July 7, 2025

By: /s/ Noah M. Leibowitz

Noah M. Leibowitz

REASONS FOR GRANTING THE PETITION

1. This is a case of exceptional importance to patent owners and petitioners involved in parallel *inter partes* reviews (“IPRs”) and civil litigation. One study by the USPTO found that “the vast majority of petitioners (about 80% or higher) have been sued by patent owners in another venue prior to filing their petitions,” *see* PTAB Parallel Litigation Study, available at https://www.uspto.gov/sites/default/files/documents/ptab_parallel_litigation_study_20220621_.pdf, and so this case presents a potentially systemic impact to IPR practice and related patent litigation.

2. As the panel recognized, this case presents an issue of first impression in this Court, on which district courts have split. *See Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1364 (Fed. Cir. 2025) (*citing Prolitec Inc. v. ScentAir Techs., LLC*, No. 20-984-WCB, 2023 WL 8697973, at *21-23 (D. Del. Dec. 13, 2023)) (collecting cases). Eschewing the caution of district courts on both sides of the issue, and stretching far beyond the arguments advocated by the parties in their briefing below, the panel’s sweeping holding allows petitioners to categorically escape IPR estoppel on identical patents or printed publications that were or could have been raised in IPR simply by relabeling that art under, *e.g.*, the “known or used by others” subclause of pre-AIA § 102(a):

IPR estoppel does not preclude a petitioner from relying on the same patents and printed publications as evidence in asserting a

ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use.

Ingenico, 136 F.4th at 1366. In effect, the panel has defined the scope of IPR estoppel out of existence.

3. This incongruous result was reached through a hyper-textualist statutory construction of the term “ground” that is inconsistent with both Congressional intent in providing robust estoppel as a protection for patent owners against the harassment of repeated litigation and administrative attacks on their patents, and, ironically, with the text of the America Invents Act (“AIA”) itself.

4. The panel decision is also inconsistent with this Court’s previous decision in *California Institute of Technology v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022) (“*CalTech*”), which overruled *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293 (Fed. Cir. 2016). In *CalTech*, this Court affirmed the district court’s summary judgment of no invalidity based on IPR estoppel. Defendants’ estopped invalidity arguments in *CalTech*, which this Court affirmed, included arguments under the “known or used” prong of § 102(a). *See California Inst. of Tech. v. Broadcom Ltd.*, No. CV 16-3714 GW (AGRX), 2018 WL 7456042, at *3-10 (C.D. Cal. Dec. 28, 2018), *aff’d*, 25 F.4th 976 (Fed. Cir. 2022); *id.* at *16 (“[I]n general the Court is not persuaded by Defendants’ argument that it is shielded

from statutory IPR estoppel by its references to the ‘known or used’ prong of § 102(a).”).

5. The full Court should thoughtfully reconsider the panel’s treatment of IPR estoppel. IPR petitioners should not be permitted to “simply swap[] labels for what is otherwise a patent or printed publication invalidity ground in order to ‘cloak’ its prior art ground and ‘skirt’ estoppel.” *Cal. Inst. of Tech. v. Broadcom Ltd.*, No. CV 16-3714, 2019 WL 8192255, at *7 (C.D. Cal. Aug. 9, 2019), *aff’d*, 25 F.4th 976 (Fed. Cir. 2022).

6. In the instant case, Ingenico’s¹ trial presentation was simply a disguised printed publication ground. Ingenico did not substantively rely on any physical device or system at trial, but rather relied entirely on *documents* describing a device and a firmware upgrader, which it could have relied on at IPR. *See* Appx11177-11182; Appx9792-9795, 796:14-797:8, 798:18-799:6; Appx10438, 1359:4-15; Appx9804-9816, 808:16-820:2; Appx9822-9823, 826:6-827:2. Ingenico should have been precluded by IPR estoppel from challenging the validity of the asserted claims on this basis, regardless of whether it labeled its challenge as coming under the “known or used” or “in public use or on sale” prongs of § 102.

¹ Ingenico Inc., Ingenico Corp., and Ingenico Group SA (collectively “Ingenico”).

STATEMENT OF THE CASE

This case stems from a prior action in which IOENGINE sued PayPal Holdings, Inc. (“PayPal”). *IOENGINE, LLC v. PayPal Holdings, Inc.*, Civ. No. 1:18-452 (D. Del. Mar. 23, 2028). Certain of the accused PayPal products were supplied by Ingenico and subject to indemnification, leading Ingenico to file a declaratory judgment action. *See* Appx206-207 ¶¶ 5-9. PayPal and Ingenico filed twelve IPRs challenging IOENGINE’s patents, of which three of Ingenico’s were instituted and proceeded to final written decision. IPR2019-00416; IPR2019-00879; IPR2019-00929. Following the IPRs, the case proceeded on claims that had been confirmed as not unpatentable.

At summary judgment, the district court found that Ingenico was restricted from relying on “documentation related to [the] DiskOnKey [firmware] upgrade software and numerous other Western Digital Documents.” Appx115 and n.21. (“Ingenico does not suggest any reason to believe that it could not have raised those documents in the IPR proceeding.”). Ingenico was permitted to rely on those documents at trial only “to the extent ... that they form part of a substantively different combination of references that could not reasonably have been raised in the IPRs,” but could not raise a ground “relying on device art” that was simply “a printed publication invalidity theory in disguise.” Appx115, Appx118.

Nonetheless, Ingenico’s invalidity case at trial relied exclusively on those

same DiskOnKey and firmware upgrader documents. *See* Appx9776-9777, 780:25-781:14; Appx9789, 793:17-20. Ingenico’s central evidence consisted of a 6-page “Readme” document (Appx11177-11182) that Ingenico argued was distributed publicly. *See, e.g.*, Appx9792-9793, 796:14-797:8 (discussing Appx11174-11176); Appx9794-9795, 798:18-799:6; Appx10438, 1359:4-15. Specifically, Ingenico’s element-by-element claim analysis focused on the firmware upgrader and DiskOnKey, *entirely* as depicted by the documents. *See* Appx9823-9855, 827:4-859:14. Even though Ingenico had a supposed copy of the firmware upgrader and a DiskOnKey, the device was never run or even plugged in. *See* Appx9822-9823, 826:6-827:2. Ultimately, Ingenico’s invalidity arguments at trial relied on the very same documents it could have presented at IPR.

On appeal to this Court, IOENGINE challenged the district court’s failure to apply IPR estoppel to preclude Ingenico’s invalidity case. Appellant’s Brief, at 62-66. The panel held as a matter of first impression that because petitioners in IPR cannot assert invalidity on the “grounds” that the claimed invention was “known or used by others, on sale, or in public use,” IPR estoppel did not apply here:

Ingenico challenged that the DiskOnKey System was known or used by others, on sale, or in public use. These are grounds that could not have been raised during the IPR. ... IPR estoppel did not preclude Ingenico from relying on the DiskOnKey System with related printed publications at trial to prove the claimed invention was known or used by others, on sale, or in public use.

Ingenico, 136 F.4th at 1367.

ARGUMENT

I. The Panel Decision Destroys the Balance Congress Struck by Coupling IPRs with Broad Civil Action Estoppel

When Congress enacted the AIA, it coupled the creation of IPRs with broad civil action estoppel, codified at 35 U.S.C. § 315(e)(2):

(2) Civil actions and other proceedings. The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not assert either in 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 that the claim is invalid *on any ground that the petitioner raised or reasonably could have raised during that inter partes review*.

35 U.S.C. § 315(e)(2) (all emphases added unless otherwise noted).

Congress recognized that in the absence of meaningful estoppel, patent owners would face harassment by repeated attacks on the validity of their patents, frustrating both their right to quiet title in their patents and the purpose of IPRs. As the House Judiciary Committee report accompanying the AIA explains:

The Committee recognizes the importance of quiet title to patent owners to ensure continued investment resources. While this amendment is intended to remove current disincentives to current administrative processes, the changes made by it are not to be used as tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent. Doing so would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation. Further such activity would divert resources from the research and development of inventions.

H. REP. NO. 112–98, 40, 48 (2011) (Report of House Judiciary Committee).

Similarly, during hearings, then-Director Kappos testified as follows:

I believe there are significant advantages for patentees who successfully go through the post-grant system ... because of those estoppel provisions. Those estoppel provisions mean that your patent is largely unchallengeable by the same party.

America Invents Act: Hearing on H.R. 1249 Before the House Comm. on the Judiciary, 112th Cong. 52-53 (2011).

This Court confirmed the broad scope of § 315(e)(2) estoppel in *CalTech*, overruling *Shaw Industries*, 817 F.3d 1293 (Fed. Cir. 2016). *CalTech* clarified that “estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the petition.” *CalTech*, 25 F.4th at 991.

The panel decision here eviscerates the balance struck by Congress to protect patent owners from repeated and vexatious litigation. Allowing a litigant (or its privy) to relabel identical art that could have been raised in IPR under the façade of a different “ground” effectively eliminates IPR estoppel. It permits petitioners to relitigate the same issues and “frustrate the purpose” of IPRs “as providing quick and cost effective alternatives to litigation.” H. REP. NO. 112–98, at 48.

Prior to the panel decision, district courts had split on the issue of whether purportedly invalidating device art presented in litigation is sufficiently different

from a ground that was or could have been raised in IPR to avoid estoppel. *See Prolitec Inc. v. ScentAir Techs., LLC*, No. 20-984-WCB, 2023 WL 8697973, at *21-23 (D. Del. Dec. 13, 2023) (citing cases).

District courts on both sides of the issue, however, recognized that allowing petitioners to simply relabel prior art in order to skirt IPR estoppel—as the panel decision now permits—is dangerously irreconcilable with the Congressional intent behind IPR estoppel. *See Cal. Inst. of Tech. v. Broadcom Ltd.*, No. CV 16-3714, 2019 WL 8192255, at *7 (C.D. Cal. Aug. 9, 2019), *aff'd*, 25 F.4th 976 (Fed. Cir. 2022) (Petitioners cannot be permitted to “simply swap[] labels for what is otherwise a patent or printed publication invalidity ground in order to ‘cloak’ its prior art ground and ‘skirt’ estoppel.”); *Singular Computing LLC v. Google LLC*, No. 19-12551, 2023 WL 2839282 (D. Mass. Apr. 6, 2023) (“[T]he court is mindful of the risk that parties may raise a system invalidity theory as ‘a patent or printed publication theory in disguise,’ ... To allow a party to present the same evidence styled as a different ‘theory’ of invalidity would permit a party challenging a patent to make a complete end-run around the estoppel bar.”); *Milwaukee Elec. Tool Corp. v. Snap-On Inc.*, 271 F. Supp. 3d 990, 1032 (E.D. Wis. 2017) (Defendant should not be allowed to “skirt” estoppel “by purporting to rely on a device without actually relying on the device itself.”); *Clearlamp, LLC v. LKQ Corp.*, No. 12-C-2533, 2016 WL 4734389, at *8 (N.D. Ill. Mar. 18, 2016) (“While LKQ seeks to cloak its reliance

upon UVHC3000 as a product, so as to avoid § 315(e)(2) estoppel, such an argument is disingenuous as it is the UVHC3000 datasheet upon which LKQ relies to invalidate the asserted claims.”); *Wasica Fin. GmbH v. Schrader Int’l, Inc.*, 432 F. Supp. 3d 448, 454-55 (D. Del. 2020) (“[T]he Court does also share Wasica’s concern that endorsing [d]efendants’ position could ‘gut the estoppel provision entirely. In future litigation, defendants will simply swap out publications that were available through a diligent search with the same prior art, only in a slightly different format or in a version that could not have been found in a search....’”); *Biscotti Inc. v. Microsoft Corp.*, No. 2:13-CV-01015 JRG-RSP, 2017 WL 2526231, at *8 (E.D. Tex. May 11, 2017) (“If, however, [defendant’s] purported system prior art relies on or is based on patents or printed publications that [defendant] would otherwise be estopped from pursuing at trial ... then [defendant] should be estopped from presenting those patents and printed publications at trial.”); *SiOnyx, LLC v. Hamamatsu Photonics K.K.*, 330 F. Supp. 3d 574, 602, 603-04 (D. Mass. 2018) (Plaintiff has not “carried its burden to show that publicly available materials are the ‘real’ references that defendants are now trying to pass off as the product itself.”). *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15-C-1067, 2019 WL 861394, *10 (N.D. Ill. Feb. 22, 2019) (Where “a petitioner had reasonable access to printed publications corresponding to or describing a product that it could have

proffered during the IPR process, it cannot avoid estoppel simply by pointing to its finished product (rather than the printed materials) during litigation.”).

II. The Panel Decision Conflicts with the Text of the AIA

The panel reached its decision by applying a hyper-textualist statutory construction to the term “ground” in § 315(e)(2), holding that whether a claimed invention was known or used by others, on sale, or in public use are “grounds that could normally be raised under §§ 102 or 103, but Congress excluded in IPR proceedings.” *Ingenico*, 136 F.4th at 1365. Ironically, the panel’s interpretation of “ground” cannot be squared with the plain text of the AIA.

Congress mirrored the term—“ground”—in the estoppel provision that it used to define the scope of IPR proceedings:

(b) Scope. A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only *on a ground that could be raised under section 102 or 103* and only on the basis of prior art consisting of patents or printed publications.

35 U.S.C. § 311(b).² The statute thus explicitly defines the scope of IPRs to include any “ground that could be raised under section 102 or 103.” The text does not fragment §§ 102 and 103 into subparts, and certainly does not exclude certain subdivisions of those sections (*e.g.*, “known or used by others”; “in public use or on

² § 315(e)(2) goes further, of course, estopping not only a “ground” that was actually raised, but also any “ground” that the petitioner “*reasonably could have raised*” in IPR.

sale”) from constituting permissible “ground[s]” in IPR. *Accord, SAS Institute Inc. v. Iancu*, 584 US 357, 361 (2018) (referring to §§ 102 and 103 without subdivision and explaining that “[t]he petition ‘may request to cancel as unpatentable 1 or more claims of the patent’ on the ground that the claims are obvious or not novel. § 311(b); see §§ 102 and 103.”).

Rather, while explicitly authorizing an IPR petition to include any “ground that could be raised under section 102 or 103,” the statute goes on to limit the type of *evidence* that may constitute “the basis” for the “ground,” to “prior art consisting of patents or printed publications.” The distinction between a “ground” and the evidentiary “basis” supporting a “ground” is clear enough from the face of § 311(b). And it is confirmed by the very next section. § 312 discusses the requirements of an IPR petition, and provides in relevant part:

(a) Requirements of Petition. A petition filed under section 311 may be considered only if ...

(3) the petition identifies, in writing and with particularity, each claim challenged, ***the grounds*** on which the challenge to each claim is based, and ***the evidence that supports the grounds*** for the challenge to each claim, including—

(A) ***copies of patents and printed publications that the petitioner relies upon in support of the petition***; and

(B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions;

35 U.S.C. § 312(a).

At the end of § 311(b), therefore, Congress limited the type of evidence that a petitioner may use to support any “ground that could be raised under section 102 or

103” to “prior art consisting of patents or printed publications.” Congress did not, in *sub silentio* contradiction of the explicit statutory text, exclude certain subparts of §§ 102 and 103 as permissible “grounds” in IPR. There is absolutely nothing in the statutory text that forecloses a petitioner from relying on prior art patents or printed publications to challenge a claimed invention in IPR on the ground that it was “known or used by others” or “in public use or on sale.”

Notably, the panel recognized the distinction between a “ground” and the prior art “evidence that support[s] a ground” when it came to applying its reasoning to what § 315(e)(2) precludes. *See Ingenico*, 136 F.4th at 1366 (“while patents and printed publications are evidence that support a ground that the claimed invention was patented or described in a printed publication, they are not coextensive with a ground”); 1365-66 (“IPR estoppel does not preclude a petitioner from asserting the same prior art raised in an IPR in district court, but rather precludes a petitioner from asserting grounds that were raised or reasonably could have been raised during an IPR.”). But the panel inexplicably failed to recognize that this same distinction refutes the central premise of its holding that § 311(b)’s limitation to prior art patents and printed publications restricts the “grounds” that can be raised under §§ 102 and 103 in IPR—rather than the evidence that can be relied on to support those grounds.

The panel’s reliance on *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367 (Fed. Cir. 2022) and *Lynk Labs, Inc. v. Samsung Elecs. Co.*, 125 F.4th 1120 (Fed. Cir. 2025)

does not support its holding. *Qualcomm*'s explanation that Congress intended IPRs to be "streamlined" proceedings "by restricting the 'prior art' which may form a basis of a ground to prior art documents" matches § 311(b)'s text and does not limit the subparts of §§ 102 or 103 that may form an IPR "ground," but rather the "basis," or evidence, that can be used to support a "ground." *Lynk Labs* referenced the 1980 legislative history behind *ex parte* reexamination to interpret common statutory language of "printed publications." But the panel ignores that the term "ground" does not appear in §§ 301 or 302 (reexamination). Congress deliberately chose different language for § 311(b), reflecting its intent that IPRs can include any "ground" that could be raised under §§ 102 or 103.

III. The Panel Decision is Contrary to this Court's Precedent

In *California Inst. of Tech. v. Broadcom Ltd.*, after the PTAB rejected defendants' IPR challenges to certain asserted claims, the Central District of California granted summary judgment of no invalidity based on IPR estoppel. No. CV 16-3714 GW (AGRX), 2018 WL 7456042, at *16 (C.D. Cal. Dec. 28, 2018), *aff'd*, 25 F.4th 976 (Fed. Cir. 2022). In so doing, the district court estopped the *CalTech* defendants from litigating invalidity challenges that were not part of the instituted IPRs, including challenges made under the "known or used" prong of § 102(a), which were the central issue litigated below. Indeed, the district court's

decisions on summary judgment and reconsideration referenced defendants' invalidity theories under the "known or used" prong of § 102(a) over 80 times.

As the district court explained, "the Court is not persuaded by [d]efendants' argument that it is shielded from statutory IPR estoppel by its references to the 'known or used' prong of § 102(a)." 2018 WL 7456042, at *16. *See also, id.* at *3-10. On reconsideration, the district court reiterated its decision, explaining that "[d]efendants did not persuasively explain ... what timely-disclosed evidence beyond the four corners of the prior art documents that is germanely, substantively different from the documents themselves would support their purported known or used invalidity theories. Ultimately, the Court finds that [d]efendants failed to show that estoppel should not be applied as to [d]efendants' obviousness invalidity theories for the asserted claims that were addressed in IPR proceedings in final written decisions." *California Inst. of Tech. v. Broadcom Ltd.*, No. CV 16-3714-GW(AGRX), 2019 WL 8192255, at *14 (C.D. Cal. Aug. 9, 2019), *aff'd*, 25 F.4th 976 (Fed. Cir. 2022).

On appeal, the *CalTech* defendants challenged the district court's application of IPR estoppel. This Court affirmed, overruling *Shaw Industries* and holding that IPR "estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the

petition.” *CalTech*, 25 F.4th at 991. This Court’s decision in *CalTech*, affirming the judgment of no invalidity on the basis of IPR estoppel—including with respect to challenges made under the “known or used” prong of § 102(a)—is irreconcilable with the panel decision in this case holding that “IPR estoppel does not preclude a petitioner from asserting that a claimed invention was known or used by others, on sale, or in public use in district court. These are different grounds that could not be raised during an IPR.” *Ingenico*, 136 F.4th at 1367.

IV. Ingenico Should Have Been Estopped Under § 315(e)(2) From Presenting Its Invalidity Challenges

IPR estoppel should have foreclosed the invalidity judgment in this case. After challenging the patents-in-suit in IPR, Ingenico was nonetheless allowed to proceed to trial with an invalidity presentation that was simply a disguised printed publication ground.

Ingenico did not rely on any physical DiskOnKey device or system at trial. Instead, it relied on documents describing the DiskOnKey and firmware upgrader, which it could have raised at IPR. *See supra*, at 5-6. The district court concluded at summary judgment that Ingenico reasonably could have raised “documentation related to [the] DiskOnKey upgrade software and numerous other Western Digital Documents,” which included documents describing the firmware upgrader. Appx115 and n.21 (“Ingenico does not suggest any reason to believe that it could not have raised those documents in the IPR proceeding.”). Ingenico’s element-by-element

claim analysis at trial focused on the DiskOnKey and firmware upgrader *entirely* as described by those documents. *See* Appx9823-9855, 827:4-859:14.

Accordingly, Ingenico should have been precluded by IPR estoppel from challenging the validity of the asserted claims at trial. It should not have been allowed to avoid IPR estoppel by simply swapping labels to litigate what would have been a precluded printed publication challenge under the guise of the “known or used by others” or “in public use or on sale” prongs of § 102.

The panel’s decision affirmed the judgment and refused to apply IPR estoppel on the basis that petitioners in IPR cannot assert invalidity on the “grounds” that the claimed invention was “known or used by others, on sale, or in public use.” As explained above, the panel’s decision conflicts with the text of the AIA, Congressional intent, and this Court’s precedent and should be reconsidered.

CONCLUSION

For the foregoing reasons, IOENGINE requests that the Court grant this petition for rehearing or rehearing *en banc* to (i) address an issue of exceptional importance to IPR petitioners and patent owners, (ii) reconsider the panel’s sweeping abrogation of IPR estoppel, and (iii) reverse the invalidity judgment below.

Date: July 7, 2025

Respectfully submitted,

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ADDENDUM

United States Court of Appeals for the Federal Circuit

INGENICO INC.,
Plaintiff/Counterclaim Defendant-Appellee

INGENICO CORP., INGENICO GROUP S.A.,
Counterclaim Defendants-Appellees

v.

IOENGINE, LLC,
Defendant/Counter-Claimant-Appellant

2023-1367

Appeal from the United States District Court for the
District of Delaware in No. 1:18-cv-00826-WCB, Circuit
Judge William C. Bryson.

Decided: May 7, 2025

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for plaintiff/counterclaim defendant-appellee and counter-
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sented by GREGORY CHUEBON; MICHAEL A. FISHER, Phila-
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Before DYK, PROST, and HUGHES, *Circuit Judges*.

HUGHES, *Circuit Judge*.

This is an appeal from the judgment issued by the United States District Court for the District of Delaware pursuant to a jury verdict and the subsequent denial of motion for judgment as a matter of law and motion for a new trial. Judgment, *Ingenico, Inc. v. IOENGINE, LLC*, No. 18-826-WCB (D. Del. July 25, 2022), ECF No. 506. IOENGINE appeals a jury verdict that found claim 3 of U.S. Patent No. 9,059,969 and claims 56, 90, 101, 105, and 124 of U.S. Patent No. 9,774,703 invalid as anticipated and rendered obvious by the prior art. In the alternative, IOENGINE appeals the district court's jury instructions and decision to allow Ingenico to introduce prior art at trial. Because substantial evidence supports the jury verdict, and because the district court did not abuse its discretion in denying a new trial, we affirm.

I

The patents-at-issue are directed to a portable device, such as a USB thumb drive, which includes a processor that causes communications to be sent to a network server in response to user interaction with an interface on a terminal. '969 patent, Abstract; '703 patent, Abstract.

On March 23, 2018, IOENGINE filed an action in the District of Delaware alleging PayPal Holdings, Inc.'s accused products infringed various patents, a subset of which are at issue in this appeal. Complaint, *IOENGINE, LLC v. PayPal Holdings, Inc.*, No. 18-452-WCB (D. Del. Mar. 23, 2018), ECF No. 1. Because it supplied PayPal's accused products, Ingenico filed a declaratory judgment action against IOENGINE. Complaint, *Ingenico Inc. v. IOENGINE LLC*, No. 18-826-WCB (D. Del. June 1, 2018), ECF No. 1.

Prior to trial, Ingenico filed IPR petitions challenging IOENGINE's asserted patents, which resulted in final written decisions that held most of the challenged claims of the '969 and '703 patents unpatentable. *Ingenico Inc. v. IOENGINE, LLC*, IPR2019-00879 (PTAB Mar. 25, 2019); *Ingenico Inc. v. IOENGINE, LLC*, IPR2019-00929 (PTAB Apr. 4, 2019). At summary judgment, IOENGINE moved to preclude Ingenico from relying on "documentation related to DiskOnKey Upgrade software" under 35 U.S.C. § 315(e)(2) because Ingenico reasonably could have been expected to raise it during the IPR proceedings. J.A. 115 n.21. The district court ruled that "Ingenico will be estopped from relying on those documents [to prove invalidity] except to the extent . . . that they form part of a substantively different combination of references that could not reasonably have been raised in the IPRs." J.A. 115.

A five-day jury trial concerning Ingenico's infringement of the asserted claims began on July 11, 2022. At trial, Ingenico introduced evidence of a prior art USB device known as the DiskOnKey (DiskOnKey Device). The DiskOnKey Device was manufactured and sold in the early 2000s by M-Systems Flash Disk Pioneers Ltd. The DiskOnKey Device was offered with various software applications, including a Firmware Upgrader, and was equipped with capabilities described in a Software Development Kit (together the DiskOnKey System). Ingenico argued that the DiskOnKey System invalidated the asserted claims as anticipated or obvious because it was either "on sale" or "in public use" under 35 U.S.C. § 102(b) (pre-AIA), or "known or used by others . . . before the date of the invention" under 35 U.S.C. § 102(a) (pre-AIA).

In relevant part, the jury returned a general verdict finding the claims-at-issue in this appeal were infringed, but invalid as anticipated and obvious. The district court subsequently entered judgment, and IOENGINE timely filed a renewed motion for JMOL of no invalidity under

Federal Rule of Civil Procedure 50(b) or, alternatively, for a new trial under Federal Rule of Civil Procedure 59(a). The district court denied IOENGINE's motions. This appeal followed.

II

On appeal, IOENGINE does not challenge the jury's finding that the DiskOnKey System invalidates the claims-at-issue as anticipated or obvious if the DiskOnKey System is prior art. Instead, IOENGINE challenges the jury's implicit finding that the Firmware Upgrader portion of the DiskOnKey System was either "on sale" or "in public use" under 35 U.S.C. § 102(b) (pre-AIA), or "known or used by others . . . before the invention" under 35 U.S.C. § 102(a) (pre-AIA).

Alternatively, IOENGINE argues it is entitled to a new trial because it alleges the district court provided various legally erroneous jury instructions and failed to instruct on the presumption of validity, and because IPR estoppel should have precluded Ingenico from introducing the Firmware Upgrader at trial.

A

We review a district court's denial of JMOL under the regional circuit law. *Summit Tech., Inc. v. Nidek Co.*, 363 F.3d 1219, 1223 (Fed. Cir. 2004). The Third Circuit standard is "whether there is evidence upon which a reasonable jury could properly have found its verdict." *TransWeb, LLC v. 3M Innovative Props. Co.*, 812 F.3d 1295, 1301 (Fed. Cir. 2016) (quoting *Gomez v. Allegheny Health Servs.*, 71 F.3d 1079, 1083 (3d Cir. 1995)). JMOL "should be granted only if, viewing the evidence in the light most favorable to the nonmovant and giving it the advantage of every fair and reasonable inference, there is insufficient evidence from which a jury reasonably could find for the nonmovant." *Id.* (quoting *Lightning Lube, Inc. v. Witco Corp.*, 4 F.3d 1153, 1166 (3d Cir. 1993)).

Under the pre-AIA public use bar, “[a] person shall be entitled to a patent unless . . . the invention was . . . in public use . . . in this country, more than one year prior to the date of the application for patent in the United States.” 35 U.S.C. § 102(b) (pre-AIA). “The public use bar is triggered ‘where, before the critical date, the invention is [(1)] in public use and [(2)] ready for patenting.’” *Minerva Surgical, Inc. v. Hologic, Inc.*, 59 F.4th 1371, 1377 (Fed. Cir. 2023) (quoting *Polara Eng’g Inc v. Campbell Co.*, 894 F.3d 1339, 1348 (Fed. Cir. 2018)) (alterations in original).

On appeal, IOENGINE disputes whether the Firmware Upgrader portion of the DiskOnKey System was “in public use.” The “in public use” element of the public use bar is met if the invention “‘was accessible to the public or was commercially exploited’ by the inventor.” *Id.* (quoting *Delano Farms Co. v. Cal. Table Grape Comm’n*, 778 F.3d 1243, 1247 (Fed. Cir. 2015)).

Here, substantial evidence supports finding that the Firmware Upgrader was accessible to the public. At trial, Ingenico introduced a July 2002 email that M-Systems sent to its employees, including those in California, announcing the launch of the Firmware Upgrader. This email was accompanied by the DiskOnKey “Readme” user guide, which disclosed important details about the Firmware Upgrader’s functionality. The email encouraged the employees to “pass this information along to your partners, customers, reps and distributors, and indicated that the application and user guide could “be downloaded from [the DiskOnKey] web site . . . starting from [July 10, 2002].” J.A. 15 (alteration in original) (citation omitted).

Ingenico also introduced a July 11, 2002, press release issued by M-Systems in Fremont, California. The press release promoted the launch of the Firmware Upgrader, explained the application’s benefits, and touted the Firmware

Upgrader as a major differentiator from other storage devices. *See* J.A. 11041.

Ingenico further introduced an archived M-Systems website page from 2002, from which the Firmware Upgrader was available for download. J.A. 11305. Ingenico's expert testified that "there would be . . . many people that would think they need to upgrade the firmware and would be downloading the firmware [upgrade application]" and the Readme file from the M-Systems website. J.A. 10177, 1142:15–25.

IOENGINE does not dispute this evidence, but contends it is insufficient to establish public use because it does not prove "**actual use** by someone at some point." Appellant's Opening Br. 32 (emphasis in original) (quoting *Minn. Mining & Mfg. Co. v. Chemque, Inc. (3M)*, 303 F.3d 1294, 1307 (Fed. Cir. 2002)). IOENGINE argues "the only evidence here is that the Firmware Upgrader was available for download, not that anyone in this country (or anywhere) ever actually downloaded it and used it." *Id.* at 33 (emphasis omitted).

It is true that public use requires actual use. But circumstantial evidence is not second-class to direct evidence. *See Medtronic, Inc. v. Teleflex Innovations S.A.R.L.*, 70 F.4th 1331, 1340 (Fed. Cir. 2023) ("Nor is circumstantial evidence second-class to direct evidence."). "Circumstantial evidence is not only sufficient, but may also be more certain, satisfying and persuasive than direct evidence." *Id.* (quoting *Michalic v. Cleveland Tankers, Inc.*, 364 U.S. 325, 330 (1960)). Thus, "[e]ither direct or circumstantial evidence corroborating public use may be sufficient for a party to meet its burden of proof." *TransWeb, LLC v. 3M Innovative Props. Co.*, 16 F. Supp. 3d 385, 393 (D.N.J. 2014), *aff'd*, 812 F.3d 1295 (Fed. Cir. 2016). Here, there is substantial circumstantial evidence that would allow a reasonable jury to conclude that a user downloaded

and actually used the Firmware Upgrader with the DiskOnKey Device.

IOENGINE relies on *3M* to argue that there is insufficient evidence of public use. In *3M*, the defendant sent samples of the accused product as a two-part composition that needed to be mixed prior to use. 303 F.3d at 1307. The asserted claims also required applying the mixed composition to a “signal transmission device.” *Id.* But “absent from the record [was] testimony or evidence about what disclosure was actually sent with the samples” that would allow a person of ordinary skill in the art “to make the claimed invention.” *Id.* at 1306. The failure of proof, therefore, hinged on a lack of evidence that the product was used in a way that met or disclosed the claim requirements.

Here, M-Systems’ employees were encouraged to inform their partners, customers, reps, and distributors about the Firmware Upgrader. Those customers had access to a user guide that informed them about the beneficial functionality of the Firmware Upgrader. In contrast to *3M*, where there was a lack of evidence that the products were used in a way that met the claim requirements, customers were encouraged to download the Firmware Upgrader and were instructed on how to use it. And it is not in dispute that a single download of the Firmware Upgrader results in a system that meets the patents-at-issue’s claim requirements. Thus, there is substantial evidence to support the jury’s finding that the DiskOnKey System, including the Firmware Upgrader, was in public use.

The jury returned a general verdict finding the claims-at-issue in this appeal were invalid as anticipated and obvious. “A general jury verdict of invalidity should be upheld if there was sufficient evidence to support any of the alternative theories of invalidity.” *Cordance Corp. v. Amazon.com, Inc.*, 658 F.3d 1330, 1339 (Fed. Cir. 2011). Thus, we need not reach whether substantial evidence supports a jury verdict that the Firmware Upgrader was “on sale”

under 35 U.S.C. § 102(b) (pre-AIA), or “known or used by others . . . before the invention” under 35 U.S.C. § 102(a) (pre-AIA).

Because substantial evidence supports the jury’s verdict finding that the Firmware Upgrader was in public use, we affirm.

B

In the alternative, IOENGINE argues it is entitled to a new trial. “This court applies regional circuit law in reviewing the denial of . . . a motion for a new trial.” *Seachange Int’l, Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1367–68 (Fed. Cir. 2005). “The Third Circuit reviews a denial of a motion for new trial for abuse of discretion.” *Id.* at 1368 (citing *Rinehimer v. Cemcolift, Inc.*, 292 F.3d 375, 383–84 (3d Cir. 2002)).

In contesting the district court’s denial of its motion for a new trial, IOENGINE takes issue with (1) the district court’s jury instructions, and (2) the district court’s decision to allow Ingenico to rely on prior art at trial. We address each issue in turn.

1

IOENGINE argues that the district court’s conception and diligence, public use, and on sale instructions were erroneous, and that the district court also erroneously failed to instruct the jury on the presumption of validity. “The question of whether a jury instruction on an issue of patent law is erroneous is a matter of Federal Circuit law and is reviewed de novo.” *Sulzer Textil A.G. v. Picanol N.V.*, 358 F.3d 1356, 1363 (Fed. Cir. 2004). A jury verdict will be set aside if the instructions were “legally erroneous” and “the errors had prejudicial effect.” *Id.* (quoting *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000)).

First, IOENGINE argues that the district court’s jury instruction on conception and diligence incorrectly flipped the legal burden. The district court instructed the jury that “Ingenico has the burden of proving invalidity by clear and convincing evidence, which as I’ve said before, means evidence that must leave you with a clear conviction or belief that the claims in question are invalid.” J.A. 10372, 1293:9–12. The district court then instructed the jury that:

IOENGINE’s contention is that the date of the invention is no later than July 26th, 2001. Ingenico’s contention is that the date of the invention was March 23, 2004 [A]ny product or method that was first publicly known or used in the United States after [the invention] date wouldn’t be regarded as coming before the invention [A]ny product or method that was known to or used by others in this country before [the invention] date would be prior art to the invention Whatever the date of invention, Ingenico must prove by clear and convincing evidence that the prior art item predated the claimed invention.

J.A. 10375–76, 1296:20–1297:16.

The district court’s instruction was based on *Mahurkar v. C.R. Bard, Inc.*, which specifies that the patent challenger “must persuade the trier of fact by clear and convincing evidence that the [purported prior art item] was published prior to [the inventor’s] invention date.” 79 F.3d 1572, 1578 (Fed. Cir. 1996). The district court clearly and consistently communicated to the jury that Ingenico had the burden of proving the prior art predated the claimed invention. We see no error in the district court’s instruction.

Second, IOENGINE argues that the district court’s public use instruction was legally erroneous because the district court failed to appreciate that different rules apply to prior use by the inventor versus an unrelated third

party. IOENGINE claims the district court should have instructed the jury that “public use may be found when the claimed features of the invention are discernible from a prior art product that is accessible to the public.” J.A. 10350, 1271:7–11. But “an invention is in public use if it is shown to or used by an individual other than the inventor under no limitation, restriction, or obligation of confidentiality.” *Am. Seating Co. v. USSC Grp., Inc.*, 514 F.3d 1262, 1267 (Fed. Cir. 2008) (citation omitted). That is what the district court instructed the jury. *See* J.A. 10377, 1298:10–13 (“Now, public use may be found when a prior art product is accessible to the public, commercially exploited, or otherwise used by the inventor or others with no restrictions or obligations of secrecy.”). We see no error in the district court’s instruction.

Third, IOENGINE argues that the district court’s on sale instruction was legally erroneous. IOENGINE proposed the district court inform the jury that “only an offer that the other party could make into a binding contract simply by accepting it constitutes an offer for sale.” J.A. 10351, 1272:16–19. Alternatively, IOENGINE proposed including that “an advertisement is not an offer for sale.” J.A. 10351, 1272:19–20.

The district court did not include IOENGINE’s proposed instructions “[b]ecause the issue of validity turned not on whether particular conduct constituted an offer for sale, but instead on whether the DiskOnKey Devices sold in the United States contained the [F]irmware [U]pgrade[r] and the SDK capabilities.” J.A. 48. Additionally, the district court concluded that IOENGINE’s proposed instructions were more likely to confuse than help the jury. J.A. 48–49. We see no error in the district court’s instruction.

Lastly, IOENGINE argues that the district court erred in refusing IOENGINE’s request to instruct the jury on the presumption of validity. We have held that a district court

does not reversibly err by not instructing the jury on the presumption of validity if the jury has otherwise been properly instructed on the clear and convincing evidentiary standard required to prove invalidity. *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1258–59 (Fed. Cir. 2004). Here, the district court properly and repeatedly instructed the jury on the clear and convincing standard. Thus, there was no error in declining to instruct the jury on the presumption of validity.

2

IOENGINE argues that under 35 U.S.C. § 315(e)(2), Ingenico should have been estopped from presenting the Firmware Upgrader at trial. Ingenico relied on the DiskOnKey Device operating the Firmware Upgrader—device art that Ingenico could not have raised during the IPR—to challenge that the claimed invention was known or used by others, on sale, or in public use. IOENGINE claims that IPR estoppel applies because the Firmware Upgrader was entirely cumulative and substantively identical to the Readme instructions and screenshots—which, according to IOENGINE, are printed publications that reasonably could have been raised during the IPR.

Whether Ingenico should be estopped depends on the proper interpretation of the term “ground” used in 35 U.S.C. § 315(e)(2). We have not previously interpreted the term’s meaning, and there is a split among district courts about its proper interpretation. *See Prolitec Inc. v. ScentAir Techs., LLC*, No. 20-984-WCB, 2023 WL 8697973, at *21–*23 (D. Del. Dec. 13, 2023) (collecting cases).

“Interpretation of the IPR estoppel statute, an issue unique to patent law, is a question of law we review de novo applying Federal Circuit law.” *Ironburg Inventions Ltd. v. Valve Corp.*, 64 F.4th 1274, 1296 (Fed. Cir. 2023) (emphasis and internal citations omitted). We begin our analysis by first looking to the statutory language. The estoppel statute provides:

(2) Civil actions and other proceedings. The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not assert either in 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 that the claim is invalid *on any ground that the petitioner raised or reasonably could have raised during that inter partes review*.

35 U.S.C. § 315(e)(2) (emphasis added). The Patent Act does not expressly define “ground.” *See* 35 U.S.C. § 100. However, 35 U.S.C. §§ 311 and 312 also use the term ground and may properly aid our understanding of its use in § 315. *See IBP, Inc. v. Alvarez*, 546 U.S. 21, 34 (2005) (“[T]he normal rule of statutory interpretation [is] that identical words used in different parts of the same statute are generally presumed to have the same meaning.”).

Under 35 U.S.C. § 311(b), the scope of an IPR is limited to “a ground that could be raised under section 102 or 103.” This makes clear that grounds are the theories of invalidity available to challenge a claim under §§ 102 and 103. But, instead of allowing a petitioner to challenge a claim under any theory of invalidity, Congress intentionally limited an IPR’s scope to invalidity challenges based on “prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). By design, a petitioner has no opportunity to challenge that the claimed invention was known or used by others, on sale, or in public use at IPR. *See Qualcomm Inc. v. Apple Inc. (Qualcomm I)*, 24 F.4th 1367, 1376 (Fed. Cir. 2022) (“[O]ur understanding [is] that Congress sought to create a streamlined administrative proceeding that avoided some of the more challenging types of prior art identified in 35 U.S.C. § 102, such as commercial sales and public uses, by restricting the ‘prior art’ which may form a

basis of a ground to prior art documents.”); *Lynk Labs, Inc. v. Samsung Elecs. Co.*, 125 F.4th 1120, 1128 (Fed. Cir. 2025) (“The stated intent for this limitation was to allow the PTO to evaluate ‘patents and printed materials, matters which are normally handled by patent examiners,’ while excluding ‘[c]hallenges to validity on other grounds (e.g., public uses or sales)[, which] would remain the province of the courts.’”) (quoting S. REP. NO. 96-617, at 2 (1980)) (alteration in original). These are grounds that could normally be raised under §§ 102 or 103, but Congress excluded in IPR proceedings.¹

¹ Comparing the IPR statutes to the post-grant review statutes further confirms both (1) that Congress deliberately excluded these grounds in an IPR and (2) our interpretation of the term ground. The PGR estoppel statute similarly states that “[t]he petitioner in a post-grant review . . . may not assert . . . that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that post-grant review.” 35 U.S.C. § 325(e)(2). Under 35 U.S.C. § 321(b), the PGR statute that corresponds to 35 U.S.C. § 311(b), “[a] petitioner in a post-grant review may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).” Thus, in a PGR, a petitioner may challenge the “[i]nvalidity of the patent or any claim in suit on *any ground specified in part II as a condition for patentability*,” on “any requirement of section 112, except . . . the failure to disclose the best mode,” or on “any requirement of section 251.” 35 U.S.C. § 282(b)(2)–(b)(3)(B) (emphasis added). This includes grounds that the claimed invention was known or used by others, on sale, or in public use. In contrast to PGRs, Congress intentionally limited IPRs to grounds that the claimed invention was patented or described in a printed publication.

Further, a ground is not the prior art asserted during an IPR. In drafting 35 U.S.C. § 315(e)(2), Congress could have precluded petitioners from asserting in district court that the claim is invalid on any *prior art* that the petitioner raised or reasonably could have raised during that inter partes review, but Congress chose not to. Instead, Congress precluded petitioners from asserting *grounds* in district court. Thus, IPR estoppel does not preclude a petitioner from asserting the same prior art raised in an IPR in district court, but rather precludes a petitioner from asserting grounds that were raised or reasonably could have been raised during an IPR. The only anticipation and obviousness challenges that a petitioner *can* make during an IPR are that the claims were patented or described in a printed publication. IPR estoppel precludes these challenges in district court if they were raised or reasonably could have been raised during the IPR. But IPR estoppel does not preclude a petitioner from relying on the same patents and printed publications as evidence in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use.

35 U.S.C. § 312(a)(3) provides additional support that prior art is evidence of a ground, not coextensive with a ground. “The petition . . . defines the scope of the IPR.” *Click-to-Call Techs. LP v. Ingenio, Inc.*, 45 F.4th 1363, 1368 (Fed. Cir. 2022) (quoting *California Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 990 (Fed. Cir. 2022)). Under § 312(a)(3) “the evidence that supports the grounds . . . include[s]—(A) copies of patents and printed publications that the petitioner relies upon in support of the petition.” Thus, while patents and printed publications are evidence that support a ground that the claimed invention was patented or described in a printed publication, they are not coextensive with a ground.

Lastly, this interpretation of ground is consistent with how we have previously interpreted 35 U.S.C. § 311(b). In

Qualcomm Inc. v. Apple Inc. (Qualcomm II), we considered whether applicant admitted prior art (AAPA), which was not a prior art patent or printed publication, could form the basis of an IPR ground if it is used in combination with one or more patents or printed publications. No. 23-1208, 2025 WL 1174161, at *7 (Fed. Cir. Apr. 23, 2025). We interpreted § 311(b) to “mean[] that ‘the basis’ of an IPR ground asserting unpatentability can ‘only’ include ‘prior art consisting of patents or printed publications.’” *Id.* at *8 (quoting 35 U.S.C. § 311(b)). We held that “because the basis can only include prior art consisting of patents or printed publications, and because AAPA is not a prior art patent or printed publication . . . , it follows that the plain meaning of § 311(b) does not permit the basis to include AAPA.” *Id.* But we noted “that an IPR petition may rely on AAPA for certain uses, so long as the AAPA is not the basis of a ground in violation of § 311(b).” *Id.* (citing *Qualcomm I*, 24 F.4th at 1375). This supports our interpretation that grounds are the theories of invalidity available to challenge a claim under 35 U.S.C. §§ 102 and 103, which are limited in an IPR to asserting that the claimed invention was patented or described in a printed publication (or would have been obvious only on the basis of prior art patents or printed publications). If prior art that is not a patent or printed publication, such as AAPA, was used in combination with patents or printed publications such that the “basis” of the ground included AAPA, the petitioner would no longer be asserting a ground that the claimed invention was patented or described in a printed publication.

Therefore, we hold that IPR estoppel applies only to a petitioner’s assertions in district court that the claimed invention is invalid under 35 U.S.C. §§ 102 or 103 because it was patented or described in a printed publication (or would have been obvious only on the basis of prior art

patents or printed publications).² IPR estoppel does not preclude a petitioner from asserting that a claimed invention was known or used by others, on sale, or in public use in district court. These are different grounds that could not be raised during an IPR.

Here, Ingenico challenged that the DiskOnKey System was known or used by others, on sale, or in public use. These are grounds that could not have been raised during the IPR. The Readme file and other printed publications that Ingenico relied upon were evidence to support these grounds. To the extent that Ingenico reasonably could have raised the Readme file during the IPR, it would only be to challenge that the claimed invention was described in a printed publication—a separate ground not raised at trial. Thus, a new trial is not warranted because IPR estoppel did not preclude Ingenico from relying on the DiskOnKey System with related printed publications at trial to prove the claimed invention was known or used by others, on sale, or in public use.

III

We have considered IOENGINE's remaining arguments and find them unpersuasive. We affirm.

AFFIRMED

² Of course, for IPR estoppel to apply, all other statutory requirements must be met, including that the IPR “results in a final written decision” and that the petitioner’s invalidity assertion in district court be a “ground that the petitioner raised or reasonably could have raised during that” IPR. 35 U.S.C. § 315(e)(2); *see Ironburg Inventions*, 64 F.4th at 1298 (holding that a petitioner “reasonably could have raised” a ground if “a skilled searcher conducting a diligent search reasonably could have been expected to discover” it).

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I hereby certify that on July 8, 2025, I electronically filed the foregoing with the Clerk of Court for the United States Court of Appeals for the Federal Circuit by using the CM/ECF system. I certify that all participants in the case are registered CM/ECF users and that service will be accomplished by the CM/ECF system.

Date: July 8, 2025

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