

**FEDERAL CIRCUIT SUMMARY FOR WEEK ENDING OCTOBER 25, 2019****Wilson v. Martin, No. 2018-1980 (October 21, 2019); (nonprecedential); Patent No. 8,809,044****Key point(s):**

- Relying upon expert testimony in determining §102(b) anticipation is not prohibited as a matter of law.
- Judicial estoppel is not required where a party relies upon different facts in post grant proceeding that appear to contradict statements made during prosecution.

**Facts/Background:** The '044 Patent is directed to methods of using gas-permeable devices to culture animal cells. Martin provoked an interference between claim 2 of patent '044 and Patent Appl. No. 14/814,267, filed by Corning Inc. Both the patent and the application were filed pre-AIA. Martin filed a motion that various claims by Wilson were anticipated under §102(b) by U.S. Patent No. 6,759,245 ("Toner"). The Board found that Toner read on the claim construction of "ambient gas" proffered by both Wilson and Martin. Acknowledging that Toner did not explicitly disclose the word "ambient," the Board found that the limitation was inherent or otherwise implicit, thus finding Toner anticipatory of Wilson under §102(b). The Board also relied upon extrinsic evidence from Corning's expert witness to conclude that Toner was anticipatory of '044.

Wilson unsuccessfully argued that Martin was judicially estopped from arguing that Toner discloses the "ambient gas" limitation, because Corning made statements during prosecution about Toner that were inconsistent with Martin's position during the interference. This appeal followed.

**Holding:** Affirmed. The Federal Circuit rejected application of judicial estoppel, concluding that the statements were not inconsistent. Corning's comments during prosecution were addressed to one embodiment of Toner's invention, while the Board and Martin relied upon a different embodiment to show anticipation during the interference. In addition, the Federal Circuit stated that the Examiner did not have the benefit of Corning's expert witness during prosecution.

The Board did not err, as a matter of law, in relying upon expert testimony, because the testimony was used to interpret a reference and shed light on what the reference would have meant to a person of ordinary skill in the art. Reviewing the Board's factual findings for "substantial evidence," the Federal Circuit explained that "[w]here two different conclusions may be warranted based on the evidence of record, the Board's decision to favor of one conclusion over the other is the type of decision that must be sustained by this court ...."

**Google LLC v. Koninklijke Philips N.V., No. 2018-2213, IPR2017-00437 (October 23, 2019); (nonprecedential) ; Patent No. 6,772,114**

**Key point(s):**

- Similarities in the resulting information resulting from a known modification do not convert a low-pass filter into a high-pass filter for purposes of anticipation.
- An argument appearing first in a reply brief may be untimely if the non-moving party is not given a fair and meaningful opportunity to respond.

**Facts/Background:** The ‘114 Patent generally relates to an encoding scheme for transmitting audio signals. Google filed an IPR against certain claims, which was instituted. The Board’s Final Decision concluded that Google failed to meet its burden of establishing that challenged claims 10–16, 20, and 21 of ‘114 are unpatentable as: (1) anticipated by PCT App. No. 98/52187 to Tucker, or (2) obvious over Tucker in view of known prior art. The Board construed the term “high-pass filter” in claim 10 to mean “transmits frequencies above a given cutoff frequency and substantially attenuates all others.” Google argued that Tucker’s low-pass filter and reflection steps, in combination, disclosed the claimed “high-pass filter.” Google argued that because Tucker’s steps collectively transmit the desired high-band portion of the input signal, and attenuate the low- band portion of the signal, Tucker anticipates patent ‘114. However, Google’s expert admitted that Tucker’s low-pass filter and reflection steps transmit the low-frequency content, and not the high frequency content. The Board determined that because Tucker’s process discards the high-band content of the input signal, similarities in the resulting information that is produced by Tucker’s system to what would have been produced if Tucker had actually employed a high-pass filter did not convert Tucker’s low-pass filter and reflection steps into a high-pass filter.

**Holding:** Affirmed. The Federal Circuit affirmed the Board’s decision that Tucker did not anticipate or render obvious Patent No. ‘114, because similarities in the resulting information resulting from a known modification, do not convert a low-pass filter into a high-pass filter, wherein the low pass filter does not transmit frequencies above a given cutoff frequency and does not substantially attenuate all other frequencies. Google further argued that the Board abused its discretion for failing to consider Google’s argument that it would have been obvious to exchange a high-pass filter for Tucker’s low pass filter and reflection process. Because this argument was raised for the first time in Google’s Reply briefing, the Federal Circuit held that the Board did not abuse its discretion by not considering Google’s untimely arguments. The Federal Circuit was unpersuaded by Google’s argument because Koninklijke did not have a fair and meaningful opportunity to respond to Google’s Reply briefing. The Board did not abuse its discretion by not considering an untimely argument outside of the scope of *inter partes* review, because the non-moving party must have a fair and meaningful opportunity to respond.