

Issue Preclusion Can Apply to Prior Inter Partes Reexamination Determinations

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In [*SynQor, Inc. v. Vicor Corp.*, No. 2019-1704 \(Fed. Cir. Feb. 22, 2021\)](#), a panel majority found that issue preclusion could apply to prior *inter partes* reexamination determinations, and that, in view of issue preclusion, the PTAB erred in holding unpatentable claims involved in a later *inter partes* reexamination. Judge Dyk dissented.

In 2011, SynQor asserted several patents against Vicor, including U.S. Patent 7,564,702 ('702 patent), 8,023,290 ('290 patent), and 7,072,190 ('190 patent), which are part of the same family. Vicor requested *inter partes* reexamination of all three, asserting that their claims were obvious in view of two references: Steigerwald and Cobos. In the '702 and '290 proceedings, the claims were held not unpatentable. The PTAB reasoned that Steigerwald and Cobos disclosed circuits operating at incompatible frequencies and their disclosures would not have been combined by a POSA. These determinations were affirmed by the Federal Circuit in earlier appeals. In the '190 proceeding, the PTAB came to the opposite conclusion: Steigerwald and Cobos did not disclose incompatible frequencies, and the '190 patent claims were unpatentable. SynQor appealed from that determination.

The panel majority vacated the PTAB's determination in the '190 proceeding. It first reasoned that the statutory scheme governing *inter partes* reexaminations showed no intent to foreclose issue preclusion. It then found the procedural mechanisms used in *inter partes* reexaminations, including the participation of the requester to provide both argument and evidence, made *inter partes* reexaminations sufficiently "adversarial" to justify the application of issue preclusion. In applying issue preclusion, the panel majority found that the PTAB's earlier determination that a POSA would not have combined Steigerwald and Cobos had preclusive effect, and the PTAB could not come to a different conclusion in the '190 proceeding.

Judge Dyk dissented. In his view, issue preclusion does not apply to *inter partes* reexaminations because they "are examinational (or inquisitorial) rather than adjudicatory, do not include court-like adjudicatory procedures, and do not satisfy the requirements in *B&B Hardware, Inc.* . . . for application of collateral estoppel." Judge Dyk found "of critical importance" the lack of the "third-party requester's ability to cross-examine the witness."

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