

In re Google Tech. Holdings LLC, 980 F.3d 858 (Fed. Cir. 2020)

BY KATHLEEN WILLIS

Google applied for a patent on video-on-demand systems. The Patent Trial and Appeal Board affirmed the examiner's rejection of the claims as obvious, stating that Google's responses to the examiner's rejections were "conclusory" and failed to include any construction of the contested terms.

Google appealed to the Federal Circuit. In analyzing whether Google was permitted to raise claim construction arguments on appeal, the court drew a distinction between the doctrines of waiver and forfeiture. The court acknowledged that it had used the terms "interchangeably at times," but also noted that "the two are really not the same, although our cases have so often used them interchangeably that it may be too late to introduce precision." Forfeiture is defined as the "failure to make the timely assertion of a right," while waiver is the "intentional relinquishment or abandonment of a known right." Having defined the doctrines, the Federal Circuit categorized Google's failure to raise its claim construction arguments before the Board as forfeiture. It also noted that Google didn't provide any reasonable explanation for why it failed to argue its construction of the disputed claim term before the examiner and the Board, so there were no "exceptional circumstances" justifying bringing it up on appeal.

The court held that allowing Google to raise these arguments on appeal would "deprive the Board, an expert body" of its role in reviewing patent application rejections. A party must argue construction during examination since "[t]he very word 'review' presupposes that a litigant's arguments have been raised and considered in the tribunal of first instance." This principle prevents "sandbagging." The court, however, noted that it maintains discretion to hear a claim that was not presented to the Board.

An applicant should use every opportunity to present arguments during the examination process that it may

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raise on appeal. If a party fails to raise an argument before the Board, however, the court may use its discretion to determine whether there exist exceptional circumstances that excuse any forfeiture.

RELATED CASE

- *In re Baxter Intern., Inc.*, 678 F.3d 1357, 1363 (2012) (Baxter waived claim construction arguments that it had not raised before the Board. Since Baxter did not address the examiner's rejection, the Board did not include an analysis of the term. The court found this was not enough to preserve the argument for appeal.)