

**Papst Licensing GMBH & Co. v. Samsung Elec. Am., Inc.**, 924 F.3d 1243 (Fed. Cir. 2019)

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*issue preclusion in  
general applies to  
PTAB decisions*

Samsung successfully petitioned for *inter partes* review (IPR) of several of Papst's patents, including U.S. Patent No. 9,189,437. Prior to the Patent Trial and Appeal Board (PTAB) finding the claims of the '437 patent unpatentable as obvious, however, it had found two related patents that shared the same specification unpatentable as well. Papst voluntarily dismissed its appeals on the two related patents before oral argument.

In the appeal on the '437 patent, the Federal Circuit held that Papst's arguments were barred by issue preclusion. Issue preclusion is a common law doctrine that prevents a party to a lawsuit or agency action from re-litigating an issue once it has been decided in a previous case. The rationale behind the doctrine is prevention of legal harassment and prevention of abuse of legal resources. The court first explained the general rule that "[w]hen an issue of fact or law is actually litigated and determined by a valid and final judgment, and the determination is essential to the judgment, the determination is conclusive in a subsequent action between the parties, whether on the same or a different claim."

Turning to the facts here, the Federal Circuit held that issue preclusion in general applies to PTAB decisions once those decisions become final if the other requirements of issue preclusion are met. The court then held that issue preclusion applied in the '437 patent appeal because the prior proceedings on the related patents resolved against Papst materially identical issues of claim construction as applied to identical prior art, and because those determinations were essential to the PTAB's prior decisions.

The *Papst* decision clarified that petitioners or patent-holders may wish to reconsider when and how they should dismiss IPRs on related patents in the future, if they want to avoid issue preclusion.