

## SynQor, Inc. v. Vicor Corp., 988 F.3d 1341 (Fed. Cir. 2021)

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SynQor, Inc. appealed the *inter partes* reexamination decision of the Patent Trial and Appeal Board (Board) holding un-patentable as obvious original claims 1–19, 28, and 31 of SynQor’s patent, U.S. Patent No. 7,072,190 as well as newly presented claims 34–38, which were proposed during the reexamination proceeding. The U.S. Court of Appeals for the Federal Circuit found that decisions the Board made in previous reexamination proceedings precluded finding claims 1–19, 28, and 31 obvious based on the grounds relied upon by the Board, and that the expiration of the ’190 patent rendered any appeal of the Board’s decision regarding claims 34–38 moot.

During a first reexamination of patent claims reciting a DC-to-DC voltage converter, the Board found that two prior art references could not be properly combined in an obviousness rejection because they operated at incompatible frequencies. This decision was appealed and the Federal Circuit affirmed. In a subsequent reexamination proceeding, the Board issued an obviousness rejection over these same two references, finding that the frequency differential did not defeat a motivation to combine the teachings. The above-captioned appeal followed.

The Federal Circuit held that the Board was collaterally estopped from now finding that an artisan would be motivated to combine two references that it previously found could not be properly combined. In doing so, the Federal Circuit clarified that Congress did not intend to foreclose issue preclusion from *inter partes* reexamination proceedings, which otherwise meet the elements of the common law doctrine. The statutory estoppel provisions applicable to *inter partes* reexaminations provide for grounds-based estoppel similar to the current *inter partes* review (IPR) estoppel provisions of 35 U.S.C. § 315(e) as well as fact-based estoppel in subsequent district court actions. Here,

**Collateral estoppel can arise from factual determinations made in prior U.S. Patent and Trademark Office proceedings involving the same patent.**

each party had a full and fair opportunity to argue the evidence. Even though reexamination proceedings do not have a formal adversarial structure, the *inter partes* reexamination requester was able to participate and present its positions and competing evidence.

The court noted that the unavailability of cross-examination through compulsory process in such proceedings weighed against issue preclusion, but was not dispositive in eliminating the applicability of the doctrine. It was also counterbalanced by the technical expertise of Board factfinders, which places less importance on the expert testimony that would have been tested through cross-examination. Having found that issue preclusion could legally apply to collaterally estop the Board from finding a motivation to combine, the court vacated and remanded the decision.

While this decision relates to *inter partes* reexaminations—a now-defunct proceeding that the America Invents Act replaced with IPR—the Federal Circuit’s holding nonetheless provides useful insight into the mechanics and scope of collateral estoppel as it applies to U.S. Patent and Trademark Office (USPTO) litigation, and even agency determinations more generally.