

Fed. Circ. Rejects Mandamus Bids To End Ex Parte Reexams

By **Britain Eakin**

Law360 (November 22, 2022, 5:34 PM EST) -- The Federal Circuit on Tuesday shot down a pair of mandamus petitions from patent owners seeking to end ex parte reexamination proceedings of their patents, ruling that both parties must wait until final decisions in their respective cases are issued before they can appeal.

Construction materials company Knauf Insulation Inc. and patent licensing company Sound View Innovations LLC had filed separate petitions asking the Federal Circuit to issue orders requiring the U.S. Patent and Trademark Office to terminate the proceedings, but a three-judge panel said neither party had shown "a clear and indisputable right" to end the reexams through the "extraordinary remedy" of mandamus.

Knauf and Sound View had their patents challenged in inter partes review after they separately accused Johns Manville Corp. and Dish Network LLC, respectively, of infringement in federal court. The Patent Trial and Appeal Board denied the petitions, after which Johns Manville and Dish sought ex parte reexaminations, with Johns Manville pursuing a second round of reexams after the board found the Knauf patents at issue here were not shown to be invalid.

Ex parte reexams differ from inter partes reviews in several key ways. For one thing, once the reexam is granted, the party that requested it doesn't actively participate like petitioners do in IPRs. Reexams are overseen by examiners rather than the PTAB and are only granted if the challenger is able to raise a substantial new question of patentability.

Both Knauf and Sound View asked the PTAB to terminate the reexams, arguing that they were based on substantially the same prior art and invalidity arguments that were in the IPR petitions the board had denied, and in the case of Knauf, the earlier reexams. After the PTAB declined, Knauf and Sound View filed the mandamus petitions, arguing that the Federal Circuit's 2021 *In re: Vivint Inc.* decision supported their bid to have the reexams terminated through mandamus relief.

In the *Vivint* case, the appeals court held that the USPTO can't institute an ex parte reexamination when "nearly identical" inter partes review petitions have been denied for making "abusive" repetitive arguments.

But here the appeals panel sided with the USPTO, which was a party to both appeals and had urged the appellate court to reject both petitions. The panel distinguished the Knauf and Sound View cases from *Vivint*, saying the USPTO "made a case-specific exercise of discretion" in declining to dismiss the

reexams after finding the prior art and invalidity arguments were not substantially similar to those in prior proceedings.

The Federal Circuit said that "does not create the same kind of clear, arbitrary departure from prior" USPTO determinations at issue in the Vivint case.

The panel made clear, however, that both Knauf and Sound View may have a case to make in a regular appeal, but said they fell short of meeting the high bar required to get mandamus relief now.

"Mandamus relief is unavailable because a post-final decision appeal is an adequate remedy by which Sound View may seek to obtain relief," the panel held, reaching the same conclusion in the Knauf case.

Counsel for Knauf and Johns Manville did not immediately return a request for comment. Counsel for Sound View declined to comment, as did the USPTO. Dish, meanwhile, was not a party to the Sound View appeal.

The Knauf patents at issue are U.S. Patent Nos. 9,464,207 and 9,926,464. The Sound View patent at issue is U.S. Patent No. 6,708,213.

U.S. Circuit Judges Alan D. Lourie, Richard G. Taranto and Leonard P. Stark sat on the panel for the Federal Circuit.

Knauf is represented by Joshua Larsen of Barnes & Thornburg LLP.

Johns Manville Corp. is represented by William H. Milliken and Jeremiah B. Frueauf of Sterne Kessler Goldstein & Fox PLLC.

Sound View is represented by Alan S. Kellman, Frederick J. Ding and Peter C. Magic of Desmarais LLP.

The USPTO is represented in-house by Kakoli Caprihan, Thomas W. Krause, Robert J. McManus and Farheena Yasmeeen Rasheed.

The cases are In re: Knauf Insulation Inc. et al., case number 22-166 and In re: Sound View Innovations LLC, case number 22-161, both before the U.S. Court of Appeals for the Federal Circuit.

--Editing by Dave Trumbore.