



Patent Owner Precluded from Asserting in Litigation Claims Obtained Through Ex Parte Reexamination

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In 2014, Plaintiffs sued Defendants in district court for infringement of a patent directed to “mobile tethering” technology. In response, Defendants sought IPR, challenging the patentability of each of the claims that Plaintiffs asserted in their infringement contentions. The court then stayed the patent infringement action pending the Board’s resolution of the IPR. Ultimately, the Board found all challenged claims unpatentable except for one. Plaintiffs appealed the Board’s decision to the Federal Circuit. While their appeal was pending, Plaintiffs sought *ex parte* reexamination of the patent at issue in the IPR, and successfully obtained new claims through the reexamination process. With their new claims in hand, Plaintiffs sought leave from the court to amend their infringement contentions to add the newly acquired claims.

The court, applying a local rule that requires a party to show “good cause” to amend infringement contentions, denied Plaintiffs’ request. In doing so, the court explained that it had stayed the infringement action because of the possibility of “substantially streamlin[ing]” the case if the Board found unpatentable some or all of the claims at issue in the IPR. And that is exactly what happened. The IPR resulted in all but one claim surviving. The court found that allowing Plaintiffs to “re-expand the scope of the case, dramatically, by asserting what could be [numerous] claims generated in the reexamination” would render the stay “essentially pointless”—a result the court did not intend.

In analyzing whether “good cause” exists for Plaintiffs to amend their infringement contentions, the court determined that the two factors—namely, (1) whether the moving

party was diligent in moving to amend its contentions, and (2) whether the non-moving party would suffer prejudice if leave to amend were granted—both weighed against allowing the amendment. Regarding diligence, the court first explained that Plaintiffs are not automatically entitled to amend their contentions simply because they obtained new claims through reexamination. The court further noted that, because Plaintiffs failed to present to the court the new infringement contentions they are seeking to add, the court cannot ascertain how the new contentions differ from the initial contentions or when any newly-accused products entered the market. The court also found that Defendants would be unduly prejudiced by the amendment because they will have to “devote extensive time and resources to litigate [numerous] new claims” after the case had already been “substantially and successfully narrowed through years of PTAB proceedings.” The court noted that “judicial economy” weighs against allowing Plaintiffs to essentially start the case over with “scores of new claims.”

Practice Tip: Because *ex parte* reexamination does *not* reset the one-year deadline for filing a petition for IPR, new claims obtained through reexamination may be immune from IPR attacks. See *Apple Inc., v. IXI IP, LLC*, IPR2019-00124, -00125, -00139, -00140, -00141, -00181 (PTAB June 3, 2019) (Tierney) which we covered in an [earlier post](#) in IP Newsflash. However, patent owners seeking to add claims obtained through reexamination to a district court litigation must recognize that amendment of infringement contentions is not automatic and instead carries a burden that may not be easily met.

IXI Mobile (R&D) Ltd. et al. v. Samsung Electronics Co., Ltd. et al., 4:15-cv-03752 (N.D. Cal. October 11, 2019) (Haywood S. Gilliam, Jr.)

Categories

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