

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK
OFFICE

ZYNGA INC.,
Petitioner,

v.

IGT,
Patent Owner.

IPR2022-00199
Patent 7,168,089 B2

Before KATHERINE K. VIDAL, *Under Secretary of Commerce for
Intellectual Property and Director of the United States Patent and
Trademark Office.*

DECISION
Granting *Sua Sponte* Director Review and Affirming the Decision on
Institution

The Office received a rehearing request and a request for Precedential Opinion Panel (POP) review challenging the Board’s June 14, 2022 Institution Decision (Paper 11, hereinafter “Decision”). *See* Paper 13; Ex. 3002. In its requests, Patent Owner argues that the Board improperly waived interference estoppel under 37 C.F.R. § 41.127(a)(1), to the extent it applied, to determine that Petitioner is not barred from pursuing *inter partes* review of U.S. Patent 7,168,089 B2. Paper 13, 6–14; *see* Decision. The Patent Owner cites the following language from the Decision:

Accordingly, to the extent Section 41.127(a)(1) applies, pursuant to 37 C.F.R. § 42.5(b), we waive the requirements of Section 41.127(a)(1) as applied to Zynga’s unpatentability challenges in this proceeding. *See* 37 C.F.R. 42.5(b) (“The Board may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.”).

Decision at 10. The Patent Owner asks the Precedential Opinion Panel to resolve the following issue which the Patent Owner submits is of precedential importance:

May the Board retroactively waive the scope and effect of a final judgment resulting from a prior interference proceeding?

Ex. 3002.

I have reviewed the Board’s Decision, the Papers, and the Exhibits of record in this proceeding. I determine that *sua sponte* Director review of the Board’s Decision is appropriate. *See Interim process for Director review*¹ § 10 (setting forth issues that may warrant Director review), § 22 (providing for *sua sponte* Director review of institution decisions in AIA proceedings and explaining that “the parties to the proceeding will be given notice” if

¹ Available at <https://www.uspto.gov/patents/patent-trial-and-appeal-board/interim-process-director-review>.

Director review is initiated *sua sponte*). Concurrent with this Order, the POP has dismissed the request for POP review.

Upon consideration of the requests and the record, I affirm the Board's result that Petitioner should not be barred from pursuing *inter partes* review based on interference estoppel. Because I find that interference estoppel does not apply, as discussed below, I need not reach the issue of whether the Board properly waived interference estoppel.

Title 37, Chapter I, Subchapter A, Part 42 of the Code of Federal Regulations governs trial practice, including preliminary proceedings, before the Board. 37 C.F.R. §§ 42.1(a), 42.2.² Part 42 incorporates certain sections of Part 1. *Id.* § 42.1(a). Specifically, Part 42 states that “Sections 1.4, 1.7, 1.14, 1.16, 1.22, 1.23, 1.25, 1.26, 1.32, 1.34, and 1.36 of this chapter also apply to proceedings before the Board, as do other sections of [P]art 1 of this chapter that are incorporated by reference into this part.” *Id.* Part 42, however, does not incorporate Part 41, or more specifically, the interference estoppel provisions of 37 C.F.R. § 41.127(a)(1). *See id.* As a result, § 41.127 does not apply to trial and preliminary proceedings before the Board.

Even if interference estoppel under 37 C.F.R. § 41.127(a)(1) applied to trial and preliminary proceedings before the Board, such estoppel would not apply here because the Board terminated the interference based on the threshold issue of written description. Ex. 2001, 2 (citing 37 C.F.R. § 41.201 (“*Threshold issue* means an issue that if resolved in favor of the movant would deprive the opponent of standing in the interference.”)). In

² Section 42.1(a) refers to “proceedings,” and Section 42.2 defines “[p]roceeding” as “a trial or preliminary proceeding.”

doing so, the Board dismissed as moot Petitioner's motions asserting unpatentability over prior art and did not authorize any motion or make any determination on unpatentability under 35 U.S.C. §§ 102–103. Ex. 2001, 2; *see also* Decision 9–10. As a result, interference estoppel would not apply because the Board's termination based on a threshold issue prevents the judgment from disposing of all issues that were, or by motion could have properly been, raised and decided. 37 C.F.R. § 41.127(a)(1). Because I affirm on alternative grounds, I need not reach the issue presented by Patent Owner as that issue is now moot.

Accordingly, based on the foregoing, it is:

ORDERED that *sua sponte* Director review is granted;

FURTHER ORDERED that Patent Owner's Request for Rehearing is dismissed as moot; and

FURTHER ORDERED that the matter is remanded to the original merits panel for further proceedings consistent with this opinion.

IPR2022-00199
Patent 7,168,089 B2

FOR PETITIONER:

K. Patrick Herman
T. Vann Pearce, Jr.
ORRICK, HERRINGTON & SUTCLIFFE LLP
P52ptabdocket@orrick.com
tvpptabdocket@orrick.com

FOR PATENT OWNER:

Jeffrey Lesovitz
Leif Sigmond
Jennifer Kurcz
Daniel Goettle
BAKERHOSTETLER
jlesovitz@bakerlaw.com
lsigmond@bakerlaw.com
jkurcz@bakerlaw.com
dgoettle@bakerlaw.com