

SIMPLEAIR, INC. v. GOOGLE LLC, Appeal No. 2016-2738 (Fed. Cir. March 12, 2018).  
Before Lourie, Reyna, and Chen. Appealed from E.D. Tex. (Judge Gilstrap). (Claim Preclusion)

Background:

SimpleAir owns a family of patents directed to push notification technology. During prosecution, SimpleAir filed a terminal disclaimer in each child application to overcome an obviousness-type double patenting rejection over the parent patent. SimpleAir instituted a series of patent infringement lawsuits against Google, each case involving one or more of the family patents. The litigation thus far has resulted in three judgments of noninfringement. The present case arises from SimpleAir's fourth complaint ("*SimpleAir IV*"), asserting that Google infringed two continuation patents from the same family of patents.

The district court dismissed SimpleAir's fourth complaint under Rule 12(b)(6) as barred by claim preclusion. Although the district court never compared the claims of the patents at issue in this case to those previously adjudicated, the district court found that *SimpleAir IV* presented the same cause of action as *SimpleAir I-III*, and thus claim preclusion applied, because the terminal disclaimers constituted an admission that the patents in suit were patentably indistinct from the previously adjudicated patents. The district court also noted that the patents in suit shared the same title and specification as the previously adjudicated patents.

Issue/Holding:

Did the district court err in holding that claim preclusion bars SimpleAir's fourth suit, asserting terminally-disclaimed continuation patents from the same family of patents previously adjudicated? Yes, vacated and remanded.

Discussion:

The Federal Circuit found that assertions of a parent patent and a terminally-disclaimed continuation patent against the same product cannot be presumed to present the same cause of action based on the filing of a terminal disclaimer alone. Although the Federal Circuit stated that the filing of a terminal disclaimer to overcome a double patenting rejection is "a strong clue" that the claims in the continuation patent lack a patentable distinction over the parent patent, claim preclusion analysis requires a comparison of the patents' claims, along with other relevant transactional facts.

In this case, the district court erred in not analyzing the claims of any patent in concluding that the underlying invention in the patents previously adjudicated and those at issue is the same. In response to SimpleAir's arguments on appeal that the claims in the present patents are materially different from those previously litigated in *SimpleAir I-III*, the Federal Circuit stated that it could not see how the claims of the patents in suit are fundamentally different from the claims of the previously asserted patents. The Federal Circuit also agreed with Google that there is substantial overlap between *SimpleAir IV* and *SimpleAir I-III*. However, because the district court failed to analyze any of the patent claims, the Federal Circuit found that the evidence of record is not sufficient to sustain the district court's holding of claim preclusion.

Therefore, the Federal Circuit remanded the case to the district court to compare the claims of the patents in suit with the claims of the previously adjudicated patents to determine if the new claims give rise to a different cause of action.