

HAFEMAN v. GOOGLE LLC, Appeal No. 2024-1600 (Fed. Cir. June 5, 2026). Before Dyk, Hughes, and Stoll. Appealed from PTAB.

Background:

Ms. Hafeman sued LG Electronics Inc., alleging that LG-made phones, tablets, and laptops with Google and Microsoft software infringe three of her patents. Google and Microsoft then filed IPR petitions against those patents, naming LG as a real party in interest. Ms. Hafeman opposed institution and argued that, pursuant to then-Director Vidal’s guidance, institution should be denied given the existence of a parallel district court proceeding involving the same patents and presenting overlapping issues.

After Ms. Hafeman filed her opposition, LG served in its litigation a “*Sotera*” stipulation in which it represented that, if any of the IPRs were to be instituted, LG would not pursue in the district court proceeding “any ground that [Google or Microsoft] raised or reasonably could have raised” in the IPRs. Partly in view of this stipulation, the Board instituted IPR proceedings on all three patents. Ms. Hafeman then belatedly requested rehearing of the Board’s institution decisions, arguing that rehearing was warranted in view of an intervening precedential Board decision and LG’s purported violation of the *Sotera* stipulation in the related litigation. The Board denied Ms. Hafeman’s request and issued three final written decisions, one for each patent, finding all challenged claims to be unpatentable over prior art. Ms. Hafeman appealed.

Issues/Holdings:

(1) Did the Board act arbitrarily by not considering Ms. Hafeman’s *Sotera*-related arguments? (2) Did the Board err by finding the challenged claims to be unpatentable? The Federal Circuit held that the first issue was unreviewable and affirmed for the second issue.

Discussion:

Ms. Hafeman argued that, because the Board instituted review of the challenged claims based on representations made in the *Sotera* stipulation, LG’s alleged post-institution violation of that same stipulation warranted terminating that review. Ms. Hafeman also argued, in reply to Google’s and Microsoft’s contention, that she is not challenging the institution decision but is rather “challenging how the IPR proceeded after institution” and the sufficiency of the Board’s final written decisions given the Board’s failure to address the alleged violation. The Federal Circuit was unconvinced, holding this to be a distinction without meaningful difference.

Citing caselaw, the Federal Circuit held that, while Ms. Hafeman purports to challenge the Board’s final written decisions, the heart of her challenge goes to institution. The court also found to be relevant the remedy sought by Ms. Hafeman, namely termination of the IPR proceedings because the *Sotera* stipulation was a consideration for their institution. The Federal Circuit thus held that this portion of Ms. Hafeman’s challenge is barred from judicial review.

Finally, the Federal Circuit held that the Board had not erroneously construed a claim limitation, as argued by Ms. Hafeman, and that substantial evidence supported the Board’s rejection of Ms. Hafeman’s allegedly strong secondary considerations of non-obviousness.

NON-FEDERAL CIRCUIT HIGHLIGHT FOR JUNE 24, 2026

I. Miscellaneous

- A. In an Order issued May 22, 2026, the USPTO denied ex parte reexamination of a patent because “Requester is the same challenger as in the prior *inter partes* review (IPR2025-00929). The current Request includes at least some of the same or substantially the same prior art or arguments previously presented to the Office. After considering the record, and in view of all relevant considerations, the request for reexamination is denied under 35 U.S.C. § 325(d).” The prior IPR had been discretionarily denied. Notably, the Office did not evaluate in the Order whether the prior art or arguments presented in the IPR raised a substantial new question of patentability.