

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA

GESTURE TECHNOLOGY PARTNERS,
LLC,

Plaintiff,

v.

KATHERINE K. VIDAL, in her official
capacity as Under Secretary of Commerce for
Intellectual Property and Director of the
United States Patent and Trademark Office,

Defendant.

CIVIL ACTION NO. 1:22-cv-622

**COMPLAINT FOR DECLARATORY
AND INJUNCTIVE RELIEF**

Administrative Procedure Act Case

ORIGINAL COMPLAINT

Plaintiff Gesture Technology Partners, LLC (“Plaintiff”) files this original complaint against Katherine K. Vidal, in her official capacity as Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO”) (hereafter “Defendant”) alleging, based on its own knowledge as to itself and its own actions, and based on information and belief as to all other matters, as follows:

JURISDICTION AND VENUE

1. This case arises under the Administrative Procedure Act (“APA”), 5 U.S.C. § 701 *et seq.* The Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338.
2. Venue is proper in this district pursuant to 28 U.S.C. § 1391(e) and 5 U.S.C. § 703.

PARTIES

3. Plaintiff is a limited liability company organized under the laws of the State of Ohio, with its principal place of business in Toledo, Ohio.

4. Defendant Katherine K. Vidal is the Under Secretary of Commerce for Intellectual Property and Director of the USPTO. The Director oversees the operations of the USPTO and is statutorily vested with authority to decide whether to institute an *inter partes* review (IPR) of a patent claim and whether to order an *ex parte* reexamination of a patent. 35 U.S.C. §§ 304 and 314. Defendant is being sued in her official capacity. Her principal place of business is in Alexandria, Virginia.

FACTUAL ALLEGATIONS

USPTO Jurisdiction Over Expired Patents

5. A U.S. patent is granted for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application under 35 U.S.C. § 120, from the date on which the earliest such application was filed. 35 U.S.C. § 154(2).

6. In *Oil States*, the Supreme Court explained that the “decision to *grant* a patent is a matter involving public rights—specifically, the grant of a public franchise.” *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365, 1373 (2018) (emphasis in original). “Specifically, patents are public franchises that the Government grants to the inventors of new and useful improvements.” *Id.* (internal quotation marks omitted). The Supreme Court explained that “Congress [has] significant latitude to assign [the] adjudication of public rights to entities other than Article III courts.” *Id.* at 1368. In exercising its “significant latitude,” Congress grants public franchises “subject to the qualification that the PTO has the authority to reexamine—and perhaps cancel—a patent claim in an *inter partes* review.” *Id.* at 1368, 1374 (internal quotation marks

omitted). That same congressional grant conditioned the USPTO's authority on the patentee's right to seek amendment of the challenged patent claims. 35 U.S.C. § 316(d)(1). The USPTO itself has declared that the amendment process "preserve[s] the merited benefits of patent claims." *Patent Quality Improvement: Post-Grant Opposition: Hearing Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 108th Cong. 10 (2004) (hereinafter "*USPTO Gen. Counsel Toupin Statement*") (statement of USPTO General Counsel James A. Toupin). Accordingly, the USPTO may have jurisdiction to amend and cancel the claims of the patent (e.g., via *inter partes* review or *ex parte* reexamination) but only so long as the public franchise (patent) exists.

7. When a patent expires, however, the public franchise ceases to exist and the former franchisee (e.g., the patent owner) no longer has the right to exclude others. At most, the patent owner may be entitled to collect damages from violations of the public franchise that formerly existed through an infringement action in district court. But because the public franchise no longer exists, the USPTO has nothing in its authority to cancel or amend. 37 C.F.R. § 1.530(j) ("No amendment may be proposed for entry in an expired patent"); see *In re Rambus, Inc.*, 753 F.3d 1253, 1256 (Fed. Cir. 2014) (explaining that a patentee is unable to make claim amendments in an expired patent); *Ex parte* reexamination of U.S. Patent No. 8878949, Control No. 90/014,903, Office Action, p. 2 (USPTO Feb. 17, 2022) ("no amendments . . . will be permitted in this proceeding" because "the '949 patent is expired"), attached hereto as **Exhibit N**.

8. Expiration removes the patent from the USPTO's jurisdiction and returns it to the sole jurisdiction of the Article III courts, which have exclusive authority to govern claims for patent damages.

USPTO's Current IPRs and *Ex Parte* Reexaminations of the Expired Patents

9. Plaintiff is the sole owner of U.S. Patent Nos. 7,933,431 (the “’431 Patent”), 8,553,079 (the “’079 Patent”), 8,194,924 (the “’924 Patent”), and 8,878,949 (the “’949 Patent”) (the “GTP Patent(s)").

10. The ’431 Patent claims benefit under 35 U.S.C. § 120 to U.S. Patent Application Serial No. 09/612,225, which was filed on July 7, 2000. Accordingly, the ’431 Patent expired on July 7, 2020, with no patent term extension. A copy of the ’431 Patent is attached as **Exhibit A**.

11. The ’079 Patent claims benefit under 35 U.S.C. § 120 to U.S. Patent Application Serial No. 09/433,297, which was filed on November 3, 1999. Accordingly, the ’079 Patent expired on November 3, 2019, with no patent term extension. A copy of the ’079 Patent is attached as **Exhibit B**.

12. The ’924 Patent claims benefit under 35 U.S.C. § 120 to U.S. Patent Application Serial No. 09/612,225, which was filed on July 7, 2000. Accordingly, the ’924 Patent expired on July 7, 2020, with no patent term extension. A copy of the ’924 Patent is attached as **Exhibit C**.

13. The ’949 Patent claims benefit under 35 U.S.C. § 120 to U.S. Patent Application Serial No. 09/568,552, which was filed on May 11, 2000. Accordingly, the ’949 Patent expired on May 11, 2020, with no patent term extension. A copy of the ’949 Patent is attached as **Exhibit D**.

14. Unified Patents, LLC filed a petition for an IPR of the ’431 Patent on May 14, 2021 (i.e., after the expiration of the ’431 Patent). *Unified Patents, LLC v. Gesture Technology Partners, LLC*, IPR2021-00917, Paper 1 (P.T.A.B. May 14, 2021). The IPR was instituted on November 22, 2021. IPR2021-00917, Paper 11 (P.T.A.B. Nov. 22, 2021). A copy of the IPR institution decision is attached as **Exhibit E**.

15. Apple Inc. filed a petition for an IPR of the '431 Patent on May 21, 2021 (i.e., after the expiration of the '431 Patent). *Apple Inc. v. Gesture Technology Partners, LLC*, IPR2021-00920, Paper 1 (P.T.A.B. May 21, 2021). The IPR was instituted on December 6, 2021. IPR2021-00920, Paper 12 (P.T.A.B. Dec. 6, 2021). A copy of the IPR institution decision is attached as **Exhibit F**.

16. Apple Inc. filed a petition for an IPR of the '079 Patent on May 18, 2021 (i.e., after the expiration of the '079 Patent). *Apple Inc. v. Gesture Technology Partners, LLC*, IPR2021-00922, Paper 1 (P.T.A.B. May 18, 2021). The IPR was instituted on November 29, 2021. IPR2021-00922, Paper 10 (P.T.A.B. Nov. 29, 2021). A copy of the IPR institution decision is attached as **Exhibit G**.

17. Apple Inc. filed a petition for an IPR of the '924 Patent on May 26, 2021 (i.e., after the expiration of the '924 Patent). *Apple Inc. v. Gesture Technology Partners, LLC*, IPR2021-00923, Paper 1 (P.T.A.B. May 26, 2021). The IPR was instituted on December 6, 2021. IPR2021-00923, Paper 10 (P.T.A.B. Dec. 6, 2021). A copy of the IPR institution decision is attached as **Exhibit H**.

18. Apple Inc. filed a petition for an IPR of the '949 Patent on June 2, 2021 (i.e., after the expiration of the '949 Patent). *Apple Inc. v. Gesture Technology Partners, LLC*, IPR2021-00921, Paper 1 (P.T.A.B. June 2, 2021). The IPR was instituted on December 13, 2021. IPR2021-00921, Paper 8 (P.T.A.B. Dec. 13, 2021). A copy of the IPR institution decision is attached as **Exhibit I**.

19. The following table summarizes dates associated with the IPRs of the GTP Patents. As shown in the table, each IPR petition was filed after the expiration of the respective GTP Patent. Accordingly, an IPR was instituted for each GTP Patent after the expiration of the GTP Patent:

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.