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Apple v. GTP: Reminders and Takeaways from the Federal Circuit's Recent Precedential Opinion

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A recent precedential decision by the Federal Circuit in *Apple Inc v. Gesture Technology Partners, LLC*, decided on March 4, 2025, has affirmed the Patent And Trial Appeal Board's *inter partes review* (IPR) mixed ruling on appeal. The IPR relates to U.S. Patent No. 7,933,431 titled "Camera Based Sensing in Handheld, Mobile, Gaming, or Other Devices," issued to Gesture Technology Partners, LLC ("GTP"). The Board's final written decision had found all claims unpatentable, except claims 11 and 13. Apple appealed as to claims 11 and 13 and GTP cross-appealed as to the remaining claims. This blog post gives an overview of the recent decision and provides some reminders and takeaways for litigation and IPR counsel-alike.

Apple's Appeal

On appeal, Apple argued that (1) the Board used the wrong legal standard for obviousness by "by only looking to the explicit disclosures" of a reference rather than considering the reference "in view of the knowledge of a person of ordinary skill in the art" and (2) the Board ignored certain evidence and arguments presented by Apple in violation of the Administrative Procedure Act ("APA"). *Id*. at 12. The Federal Circuit rejected both arguments.

First, the Federal Circuit noted that although the Board considered whether there was explicit disclosure of the claimed limitation, the Board also rested its decision "on the petition's lack of analysis about how [the reference] (with or without the knowledge of person of ordinary skill in the art) would apply to the claim construction that Apple had advocated for." *Id*. According to the Federal Circuit, the Board did not misapply the obviousness standard—but rather "simply found the evidence did not support Apple's argument." *Id*.

Second, the Federal Circuit also disagreed with Apple's APA argument that the Board ignored its evidence. Although the Federal Circuit "agree[d] that the Board did not expressly explain its thoughts," the Federal Circuit also re-emphasized that "there is no requirement that the Board expressly discuss each and every negative and positive piece of evidence lurking in the record to evaluate a cursory argument." *Id*. at 13.

Takeaways from Apple

Apple's experience emphasizes that securing a favorable claim construction alone is only step one and is not enough to win an IPR challenge if the petition fails to demonstrate how the prior art meets the relevant limitation. It can often be easy to lose sight of the forest for the trees when a key position depends on a favorable construction. However, this Federal Circuit opinion reminds practitioners that it is equally important to explicitly connect the favorable construction to the prior art—no matter how obvious that connection may seem.

GTP's Cross-Appeal

GTP's cross appeal raised three distinct arguments: (1) lack of standing, (2) error with the Board's obviousness findings and (3) lack of jurisdiction over an expired patent.

First, GTP argued that Apple lacked standing to appeal because of the Section 315(e)(1) statutory estoppel bar. However, the Federal Circuit found that GTP forfeited this argument because it was not previously raised before the Board. The Federal Circuit noted that "[a]s an appellate court, [they could] not decide questions of fact in the first instance on appeal." *Id*. at 8.

Second, GTP raised several arguments regarding the Board's obviousness determination. However, the Federal Circuit rejected them all. Among other things, the Federal Circuit noted that the Board had found certain of GTP's arguments to be "inconsistent with the express disclosure of [the reference]." *Id*. at 14. Meanwhile, certain of GTP's other arguments were only based on the alleged lack of express disclosure. But given that "Apple's argument [was] grounded in obviousness, [it did] not require an express disclosure." *Id*. at 16.

Third, GTP's final argument was that the Board did not have jurisdiction over IPRs involving expired patents. However, the Federal Circuit simply stated that they had already rejected this same argument before and confirmed, again, that "the Board has jurisdiction over IPRs concerning expired patents." *Id*. at 24.

Takeaways from GTP

The Federal Circuit opinion provides—among others—two, simple but important practice pointers. First, arguments that require a determination of fact should always be brought before the Board or they will be waived. The Federal Circuit's rejection of GTP's estoppel arguments is a reminder that they will not make determinations of fact for the first time on appeal. Second, practitioners should remember that although explicit disclosures are not required to support a case for obviousness, arguments about the knowledge that a person of ordinary skill in the art would have should not be inconsistent with a reference's express disclosure.

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