



UNCERTAIN TIMES: WHEN DOES IPR ESTOPPEL APPLY?

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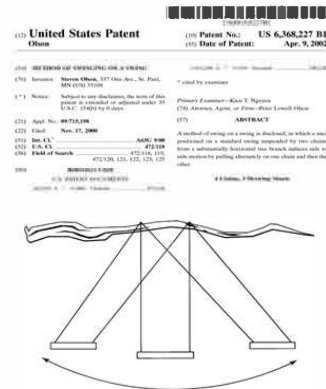
University of Texas Advanced Patent Law Institute
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McDermott
Will & Emery

1

INTER PARTES REVIEW (IPR)

- 35 U.S.C. § 311(b)
 - “A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on **a ground** that could be raised **under section 102 or 103** and only on the basis of prior art consisting of **patents or printed publications.**”

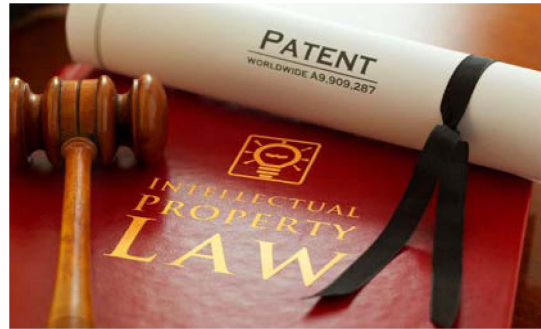


2

2

IPR ESTOPPEL

- 35 U.S.C. § 315(e)(2)
 - “The petitioner in an inter partes review of a claim in a patent under this chapter that **results in a final written decision** under section 318(a) . . . may not assert either in a civil action . . . or in a proceeding before the International Trade Commission . . . that the claim is invalid on **any ground that the petitioner raised or reasonably could have raised** during that inter partes review.”



3



3

IPR ESTOPPEL – WHERE ARE WE?

- Ground raised in Petition ✓
 - *Shaw Indus. Grp., Inc. v. Automated Creel Sys., Inc.*, 817 F.3d 1293 (Fed. Cir. 2016)
 - PTAB instituted some grounds and declined to institute others
 - Estoppel limited to only instituted grounds
 - *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348 (2018)
 - PTAB must institute all grounds raised in petition or deny review
 - Result: no IPRs addressing only some grounds raised in petition
 - *Ironburg Inventions Ltd. v. Valve Corp.*, 64 F. 4th 1274 (Fed. Cir. 2023)
 - Estoppel applies to non-instituted grounds because raised in IPR petition and resulted in final written decision (pre-SAS IPRs)



4



4

IPR ESTOPPEL – WHERE ARE WE?

- Ground raised in Petition ✓
- Ground reasonably could have been raised in Petition
 - Known to petitioner prior to filing ✓
 - *California Inst. of Tech. v. Broadcom Ltd. et al.*, 25 F. 4th 976 (Fed. Cir. 2022)
 - District court barred defendants from raising invalidity grounds based on prior art aware of at time of IPR filing
 - Affirmed district court and overruled *Shaw* holding estoppel applies to grounds based on patents and printed publications petitioner reasonably “could have raised” in petition
 - Petition for cert to Supreme Court denied



5



5

IPR ESTOPPEL – WHERE ARE WE?

- Ground raised in Petition ✓
- Ground reasonably could have been raised in Petition
 - Known to petitioner prior to filing ✓
 - *Click-to-Call Techs. LP v. Ingenio, Inc.*, 45 F. 4th 1363 (Fed. Cir. 2022)
 - District court barred defendant from raising invalidity grounds based on prior art raised in IPR petition against invalidated claims but not surviving claim
 - Affirmed district court finding of estoppel because ground raised against invalidated claims in IPR petition could have been raised against surviving claim
 - Extension of *Cal Tech* recognizing that grounds in petition “define the scope of the IPR” and “thus the extent of the estoppel”



6



6

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Title search: Uncertain Times: When Does IPR Estoppel Apply?

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"Uncertain Times: When Does IPR Estoppel Apply?"