



# NAVIGATING IPR ESTOPPEL IN LITIGATION

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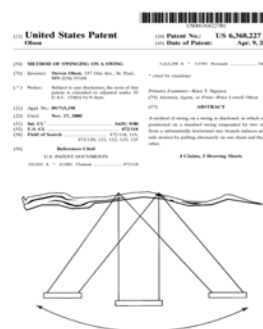
UT Advanced Patent Law Institute  
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McDermott  
Will & Emery

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## 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.**”



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## 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.”



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## IPR ESTOPPEL – WHERE ARE WE?

- Ground raised in IPR Petition ✓
  - *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293 (Fed. Cir. 2016)
    - PTAB instituted some grounds and declined to institute others (pre-SAS)
    - Limited estoppel to only instituted grounds
  - *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018)
    - PTAB must institute on all grounds raised in petition or deny review
    - Result: no IPRs addressing only some grounds raised in petition



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## IPR ESTOPPEL – WHERE ARE WE?

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



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## IPR ESTOPPEL – WHERE ARE WE?

- Ground raised in IPR Petition ✓
- Ground reasonably could have been raised in IPR Petition
  - Known to petitioner prior to filing ✓
  - Should have been located by “skilled searcher” ?
    - Federal Circuit has not addressed

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## Title search: Navigating IPR Estoppel in Litigation

First appeared as part of the conference materials for the  
27<sup>th</sup> Annual Advanced Patent Law Institute session  
"Navigating IPR Estoppel at Trial"