

IPR Estoppel

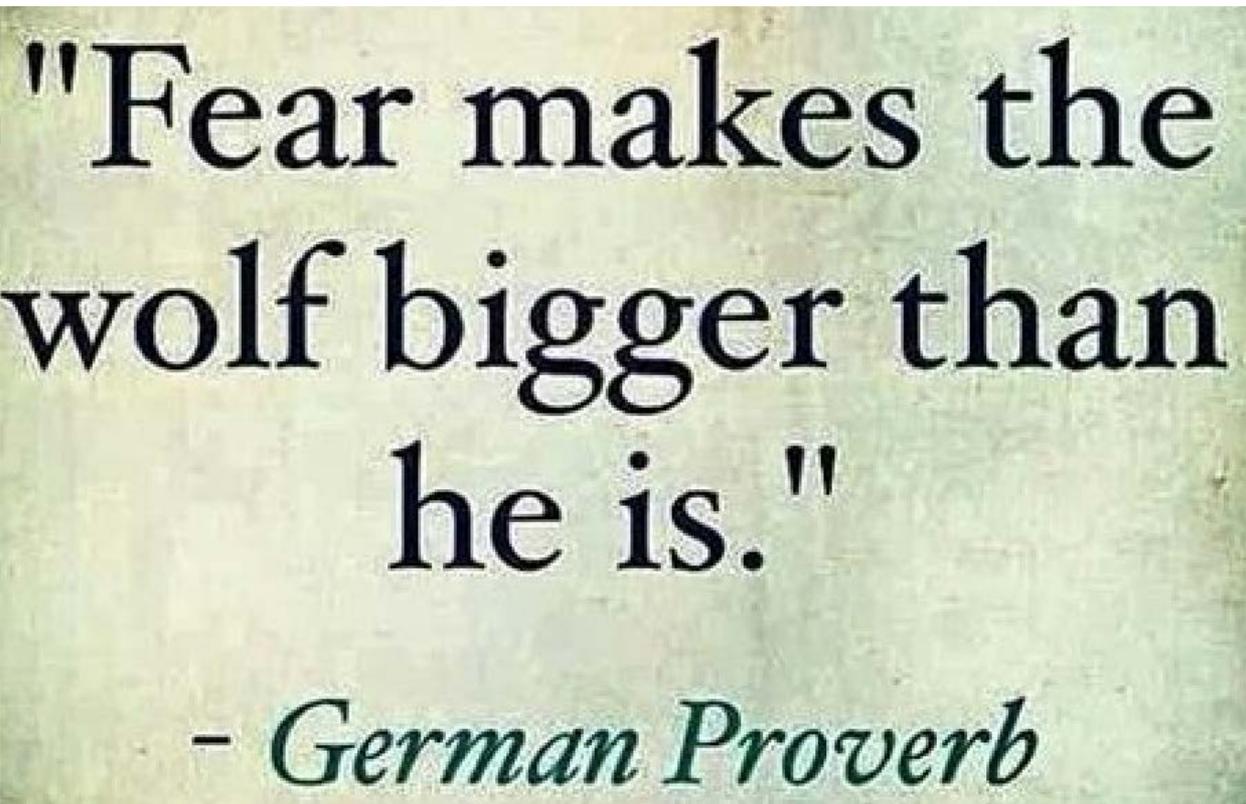
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The IPR Estoppel Landscape

Body		
District Court		Petitioner's District Court
PTAB		Petitioner's -grant
US PTO		Patent Owner's vs Petitioner's at the PTO

District Court—35 U.S.C. § 315(e)(2)

- “The petitioner in an *inter partes* review of a claim in a patent ... that results in a final written decision ... may not assert ... in a civil action ... that the claim is invalid on **any ground that the petitioner raised or reasonably could have raised** during that *inter partes* review.”

Publication v. Product



Oil-Dri Corp. of Am. v. Nestlé Purina Petcare Co

- “Where there is evidence that a petitioner had **reasonable access to printed publications corresponding to or describing a product** that it could have proffered during the IPR process, **it cannot avoid estoppel** simply by pointing to its finished product (rather than the printed materials) during litigation.”

– Case No. 15-c-1067, 2019 U.S. Dist. LEXIS 28279, at *31, 2019 WL 861394 (N.D. Ill. Feb. 22, 2019)

Polaris Industries, Inc. v. Arctic Cat Inc.

- Polaris has not produced, nor could this court find, any court granting the relief Polaris now requests—to apply § 315(e)(2) estoppel to products. Although some courts have suggested that this relief may be possible, see [*Oil-Dri*], such a rule has not been recognized by any circuits. Thus, the Court declines to adopt such a rule here. Other courts, and this Court agrees, have held that **products embodying patents or printed publications are not subject to § 315(e)(2) estoppel.**
 - 2019 WL 3824255 (D. Minn. August 15, 2019)

Wasica Finance GmbH et al. v. Schrader

- “As Wasica observes, 35 U.S.C. § 312(a)(3) identifies as separate requirements to be included in an IPR petition ‘the *grounds* on which the challenge to each claim is based, and the *evidence* that supports the grounds for the challenge to each claim’ (emphasis added). In this way, **the Patent Act distinguishes between grounds and evidence**. Since the estoppel provision, § 315(e)(2), applies to *grounds*, **a petitioner is estopped from proceeding in litigation on those grounds, even if the evidence used to support those grounds was not available to be used in the IPR.**”
 - Case 1:13-cv-01353-LPS, Dkt. 193 (D. Del. January 20, 2020)

Network-1 v. H-P Co., 18-2338 (Fed. Cir.)

- “This appeal presents a recurring problem that is not resolved by *Shaw* (and does not even implicate the district-court conflict identified by the court below): When is a litigant that **joins** a previously instituted IPR after the one-year period has passed estopped from presenting in district court litigation grounds that were not presented by the original petitioner or instituted by the PTAB?”
 - Principal Brief for HP, Dkt. 35 at 55, 18-2338 (Fed. Cir.)
- “That leaves the question whether HP “reasonably could have raised” the Fisher Patents Ground during the Avaya IPR. The answer is “no,” both because **joining parties are rarely permitted to add new grounds in general and because HP was denied from doing so in connection with the Avaya IPR in particular**. HP could not have reasonably raised the Fisher Patents Ground during the Avaya IPR, so no estoppel should attach to that ground.”
 - Id. at 56
 - Argued November 4, 2019

PTAB—35 U.S.C. § 315(e)(1)

- “The petitioner in an *inter partes* review of a claim in a patent ... that results in a final written decision ... may not **request** or **maintain** a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that *inter partes* review.”

Intuitive Surgical, Inc. v. Ethicon LLC

- **June 14, 2018: IPRs -01254, '01247, and -01248 filed**
- **January 13, 2020: FWD in IPRs -01247 and -01254**
- **“The final written decisions in the -1247 and -1254 proceedings have an estoppel effect under 35 U.S.C. § 315(e)(1) because Petitioner reasonably could have raised the grounds [raised in the -1248 IPR] in either the -01247 or -01254 IPR. Thus, because the estoppel attaches, the plain language of § 315(e)(1) requires that the -1248 proceeding be terminated immediately.”**
 - Patent Owner’s Motion To Terminate, IPR2018-01248 (Jan. 21, 2020)

Intuitive Surgical, Inc. v. Ethicon LLC

- **“Petitioner Could Not Have Reasonably ‘Raised’ The Grounds in a Single Petition and Therefore Simultaneously Filed Three Petitions”**
- **“Alternatively, For Estoppel Purposes, All Three Simultaneously-Filed Petitions Should Be Considered a Single Petition”**
- **“In Any Event, Petitioner Is Not ‘Maintaining’ This Proceeding, Which Is Now In Board Control”**
- **“Regardless, the Board Should Exercise Its Discretion and Issue the Final Written Decision”**
 - Petitioner’s Opposition, IPR2018-01248 (Jan. 21, 2020)

Intuitive Surgical, Inc. v. Ethicon LLC

- “We determine that the **estoppel** provision in § 315(e)(1) **applies** to Petitioner with respect to claims 24–26 of the ’969 patent⁵ in the instant ’248 IPR.”
 - Judgment, Final Written Decision IPR2018-01248 (Feb. 6, 2020)