

The Many Flavors of Inter Partes Review Estoppel: A Review and Update

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I. Introduction

The Leahy-Smith America Invents Act (“AIA”) was years in the making. From the first patent reform bill introduced by Representative Lamar Smith in June 2005² until the final House and Senate debates in September 2011, Congress debated every provision of the AIA, revised the language, debated some more, and finally codified the new law with overwhelming bipartisan support. Congress designed the statutory inter partes review (“IPR”) estoppel provisions in 35 U.S.C. Section 315(e) to limit serial post-grant challenges to the patentability of patent claims whether in the Patent Office, district court, or the International Trade Commission (ITC). The estoppel language was carefully crafted and closely debated.³ This article addresses the legislative history, statutory language, and leading cases interpreting the many flavors of IPR estoppel that attach under a variety of circumstances.

II. AIA Legislative Review – Policy Pronouncements and Estoppel Rationale

The AIA was “designed to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs,” and it included the creation of “a relatively efficient and inexpensive administrative system for resolution of patent validity issues before the USPTO.”⁴ Congress drafted the IPR provisions to replace an underutilized inter partes reexamination process with a “quick, inexpensive, and reliable alternative to district court litigation to resolve questions of patent validity” at the USPTO.⁵ IPRs “only make sense if ... not unduly expensive, and if such proceedings substitute for a phase of district court litigation.”⁶ Congress, therefore, included statutory IPR estoppel as a crucial tool to effect its oft-stated policy goals of avoiding duplicative litigation and serial patent validity challenges to the same patent by the same challenger and any real parties in interest and privies.

² The Patent Reform Act of 2005 H.R. 2795.

³ 35 U.S.C. § 315(e); *see also* 35 U.S.C. § 325(e), which recites the same operative estoppel language applicable to “post-grant review” proceedings. I will focus only on IPRs in this article.

⁴ Patent Reform Act of 2007 S. 1145, Senate Report 110-259, 4-5 (1.24.08) (hereafter “Senate Rep.”); *see also* America Invents Act H.R. 1249, House Report 112-98, 40 (6.01.11) (hereafter “House Rep.”).

⁵ *Id.* Senate Rep. at 20.

⁶ *Id.* at 66 (Additional Views of Sen. Specter).

Statutory IPR estoppel was an essential component of the AIA architecture, designed to “improve patent quality and limit litigation abuses, thereby ensuring that patents remain positive forces in the marketplace.”⁷ The intent was to “prohibit[] multiple bites at the apple by restricting the cancellation petitioner to opt for only one window one time.”⁸ The statutory one-bite-at-the-apple estoppel restriction in the AIA is a crucial “procedural limit[] on post-grant administrative proceedings that will prevent abuse of these proceedings for purposes of harassment or delay.”⁹ The twin themes of providing patent challengers with a one-shot, streamlined administrative proceeding to challenge the validity of issued patent claims at the Patent Office rather than district court, and preventing patent owner harassment and abuse, were constantly reinforced throughout the legislative debate over the AIA. Additional examples to those quoted above abound:

This ‘one bite at the apple’ provision was included ... to quell concerns that a party bent on harassing a patent holder might file serial [post grant review] petitions.¹⁰

The goal is to encourage [post grant review] challenges when warranted, not discourage them in view of complicated, expensive, and arcane procedures. The Director is admonished ... to ensure that regulations forbidding and penalizing harassment are enacted and enforced.”¹¹

[T]his bill represents a fair, balanced, and necessary effort to improve patent quality, ... and offer productive alternatives to costly and complex litigation.¹²

The bill’s enhanced administrative estoppel will effectively bar a third party or related parties from invoking ex parte reexamination against a patent if that third party has already employed post-grant or inter partes review against that patent.¹³

⁷ 153 Cong. Rec. E774 (4.18.07) (Rep. Berman).

⁸ *Id.*

⁹ 157 Cong. Rec. S1374 (3.8.11) (Sen. Kyl).

¹⁰ Senate Rep. at 22.

¹¹ *Id.* at 23.

¹² 157 Cong. Rec. S1030 (3.01.11) (Statement of Administration Policy regarding Patent Reform Act of 2011 S. 23).

¹³ *Id.* at S1041 (Sen. Kyl); *see also* House Rep. at 48.

This bill will establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs, while making sure no party's access to court is denied.¹⁴

Ideally, extending could-have-raised estoppel to privies will help ensure that ... an inter partes review ... will completely substitute for at least the patents-and-printed-publications portion of the civil litigation.¹⁵

These [post grant review] proceedings will serve to minimize costs and increase certainty by offering efficient and timely alternatives to litigation as a means of reviewing questions of patent validity. ... It is important that post-grant review proceedings be designed to prevent delay and abusive challenges, but still enable valid challenges based on meritorious grounds.¹⁶

The House and Senate versions of the Patent Reform Act of 2007 included very similar statutory estoppel language to effect an enhanced administrative estoppel that would prohibit unsuccessful petitioners from later challenging the same patent claims (or any newly added claims) in subsequent reexamination, derivation, post grant review, district court, or International Trade Commission (ITC) proceedings “based on any ground that the cancellation petitioner raised during the post-grant review proceeding.”¹⁷ Although the estoppel provisions in the 2007 proposed bills were limited to grounds actually raised during the post grant challenge proceeding, the Senate bill added a separate provision that would bar unsuccessful petitioners and real parties in interest from filing a subsequent IPR “on the same patent, *regardless of the issues raised in the first [post grant review]*.”¹⁸ The 2007 Senate bill and accompanying report planted the seeds for the later-adopted AIA estoppel provisions that bar petitioners, their real parties in interest, and privies from challenging the same patent claims in any subsequent Patent

¹⁴ *Id.* at S1361 (3.08.011) (Sen. Leahy).

¹⁵ *Id.* at S1376 (Sen. Kyl)

¹⁶ House Report at 87 (Agency Views in letter from Secretary Locke to Hon. Lamar Smith).

¹⁷ Patent Reform Act of 2007 H.R. 1908, Section 335 (emphasis added); Patent Reform Act of 2007 S. 1145, Section 338; *see also* Patent Reform Act of 2005, Section 9(f) (§336 Estoppel)).

¹⁸ Senate Rep. at 22, referencing Patent Reform Act of 2007 S. 1145, Section 325(a) (emphasis added).

Office, district court, or ITC proceeding based on “any ground that the petitioner raised or reasonably could have raised” during the earlier IPR (or PGR) proceeding.¹⁹

Congress tried hard to make their intent clear as to the scope of the enhanced “reasonably could have raised” IPR estoppel provision:

[I]t is only reasonable to apply estoppel to claims the challenger was, or should have been, in a position to raise, whether or not it did so.²⁰

[A petitioner] might be required to raise all prior art identified to him as a result of a reasonable search request submitted to a commercial search firm.²¹

The bill ... preserves estoppel against relitigating in court those issues that an inter partes challenger reasonably could have raised in his administrative challenge.²²

Adding the modifier “reasonably” ensures that could-have-raised estoppel extends only to that prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover.²³

The estoppels in subsection (e) will prevent ... petitioners from seeking ex parte reexamination of issues that were raised or could have been raised in the inter partes or post-grant review.²⁴

Try as Congress might to craft clear and unambiguous statutory estoppel language, the scope and applicability of the IPR statutory estoppel provisions have been, and continue to be,

¹⁹ See 35 U.S.C. §§ 315(e), 325(e). Both the House and Senate legislative record are reasonably clear that post-grant review (PGR) estoppel in district court patent infringement and ITC proceedings under Section 325(e)(2) was to be limited to “any ground that the petitioner raised during a post-grant review of the claim.” See 157 Cong. Rec. S1387, 1st col.; House Rep. at 48, 76. Through either a misunderstanding or ministerial error, the final bill signed into law included the “or reasonably could have raised” enhanced estoppel language in Section 325(e)(2).

²⁰ Senate Report at 23.

²¹ *Id.* at 67.

²² 157 Cong. Rec. S1326 (3.07.11) (Sen. Sessions).

²³ *Id.* at 1375 (3.08.11) (Sen. Kyl).

²⁴ *Id.* at 1376; see also House Rep. at 47.

heavily litigated. An analysis of inter partes reexamination estoppel and the legislative evolution of statutory IPR estoppel language follows in the next section.

III. Statutory Inter Partes Reexamination Estoppel – Former 35 U.S.C. §§ 315(c), 317(b)

We begin with the now-replaced inter partes reexamination statute, which contained substantial administrative estoppel provisions. One provision precluded an unsuccessful inter partes reexamination requester from requesting or maintaining a later inter partes reexamination following a final decision “favorable to patentability:”

[N]either [the requester] nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies *raised or could have raised in such ... inter partes reexamination proceeding* and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office This subsection does not prevent the assertion of invalidity based on *newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office* at the time of the inter partes reexamination proceedings.²⁵

The unsuccessful requester also was:

“*estopped* from asserting at a later time, in any civil action [for patent infringement], the invalidity of any claim finally determined to be valid and patentable on *any ground* which the third-party requester *raised or could have raised during the inter partes reexamination proceedings.*”²⁶

The estoppel provision in former 35 U.S.C. Section 315(c) also included the safe harbor provision recited in former Section 317(b) for newly discovered prior art unavailable to the third-party requester and Patent Office.

The inter partes reexamination estoppel provisions quoted above defined a statutory form of claim preclusion (“any ground ... raised or could have raised”²⁷) that Congress carried forward, in modified form, into the IPR statutory estoppel provisions. For example, the unsuccessful inter partes reexamination requester was estopped at both the Patent Office and in district court from later pursuing grounds that it raised or could have raised against the challenged claims during the inter partes reexamination proceeding. As with statutory IPR estoppel, the inter partes reexamination estoppel provisions were put in place “to guard against

²⁵ 35 U.S.C. § 317(b) (pre-AIA) (emphasis added).

²⁶ 35 U.S.C. § 315(c) (pre-AIA) (emphasis added).

²⁷ See *Brain Life, LLC v. Elekta Inc.*, 746 F.3d 1045, 1053 (Fed. Cir. 2014) (“claim preclusion bars both claims that were brought as well as those that could have been brought.”).

harassment of a patent holder.”²⁸ And Congress further recognized during the AIA debate that for inter partes reexamination it had “imposed severe estoppel provisions that preclude a later court challenge based on issues not even raised during an inter partes reexamination proceeding.”²⁹ Congress was well aware of how to craft a form of statutory claim preclusion based on its experience drafting the inter partes reexamination estoppel provisions. Congress made two very important modifications to those provisions when drafting the statutory IPR provisions.

First, the inter partes reexamination statute provided for a two-way estoppel that ran from district court to the Patent Office, and vice versa, and was intended to prevent parallel resolution of validity issues by district courts and the Patent Office.³⁰ Such a two-way estoppel was not carried forward in the AIA estoppel provisions, as recently noted by the PTAB.³¹ The PTAB recognized that “the AIA expressly imposes claim preclusion in one direction—from an IPR to other proceedings—but not in the other direction—from district-court litigation to Office proceedings.”³² Congress is presumed to legislate with knowledge of existing federal law, which means that when it replaced inter partes reexamination with inter partes review, Congress intended “not [to] maintain the prior statute’s express claim preclusion against an unsuccessful party in litigation.”³³

Second, Congress modified statutory IPR estoppel by removing the safe harbor clause for “newly discovered prior art unavailable to the third-party requester and Patent [] Office” recited in the inter partes reexamination estoppel provisions. Congress had defined the scope of the safe harbor provision broadly: “Prior art was unavailable at the time of the inter partes reexamination

²⁸ Conference Report on HR 1554, 145 Cong. Rec. H11769, H11805 (11.9.99).

²⁹ Senate Rep. at 19.

³⁰ 35 U.S.C. § 317(b) (pre-AIA) (“Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit, . . . then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action.”)

³¹ See *Intel Corp. v. VLSI Techn. LLC*, IPR2021-01229, Paper 128 (PTAB 6.2.23).

³² *Id.* at 6.

³³ *Id.* at 7 (Note: whether common law claim preclusion (or issue preclusion) might apply was not argued by the parties or addressed by the Board. More on common law issue preclusion below.).

if it was not known to the individuals who were involved in the reexamination proceeding on behalf of the third-party requester and the USPTO.”³⁴ Such a definition meant that the “could have raised” estoppel provision was limited to a situation where the unsuccessful reexamination requester was actually aware of the prior art at the time of the request but chose not to raise it. Congress, therefore, broadened IPR statutory estoppel by deleting the safe harbor and adding the word “reasonably” to soften “could have raised” estoppel such that it would preclude assertion of prior art reasonably discoverable by a skilled searcher conducting a diligent search, but not prior art discoverable only by a “scorched-earth search around the world.”³⁵ As it did with inter partes reexamination estoppel, Congress attempted to define the meaning of “reasonably could have raised” estoppel during the AIA legislative debate (discussed above, and further below).

In sum, inter partes reexamination estoppel was narrower than statutory IPR estoppel. Both statutes, however, preclude an unsuccessful challenger (after final decision by the Board) from later raising invalidity grounds in district court or the Patent Office that could have been raised against the challenged claims during an earlier inter partes reexamination or review. The statutory IPR estoppel language will be examined in the next section.

IV. 35 U.S.C. § 315(e) – Statutory IPR Estoppel Provisions

Congress expressed statutory IPR estoppel as follows:

§ 315. RELATION TO OTHER PROCEEDINGS OR ACTIONS

(e) ESTOPPEL.—

(1) PROCEEDINGS BEFORE THE OFFICE.—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), or the real party in interest or privy of the petitioner, 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.

(2) CIVIL ACTIONS AND OTHER PROCEEDINGS.—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), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section

³⁴ Conference Report on HR 1554, 145 Cong. Rec. H11769, H11805 (11.9.99).

³⁵ 157 Cong. Rec. S1375, 1st col. (3.8.11) (Sen. Kyl).

337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

Section 315(e) is titled “Estoppel,” but curiously, unlike former inter partes reexamination section 315(c), IPR section 315(e) does not use the word “estopped” in the text. Even so, Board issuance of a “final written decision under section 318(a)” triggers statutory IPR estoppel under section 315(e).³⁶ It is important to remember that if the Board denies institution no statutory estoppel attaches. Similarly, if an IPR is instituted but later settled and/or terminated as to petitioner, no statutory estoppel attaches to the terminated petitioner.³⁷ Statutory IPR estoppel takes effect only if an instituted IPR results in a final written decision by the Board, and the estoppel attaches to a petitioner who remains a party to the proceeding.

To understand the scope of IPR estoppel, we must consider it in context of the AIA statutory framework. An IPR petitioner may challenge the patentability of one or more claims of a patent, but only based on section 102 anticipation or section 103 obviousness grounds that rely on “prior art consisting of patents and printed publications.”³⁸ No other invalidity challenges can be raised in an IPR.³⁹ An IPR petitioner must “identify ... each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds” in the petition.⁴⁰ An IPR petitioner cannot add new grounds challenging patentability after institution. A petitioner reading the estoppel provisions of section 315(e), therefore, is informed that it must raise all section 102 and 103 permitted grounds of challenge in the petition or be estopped from raising “any ground that the petitioner raised or reasonably could have raised during that inter partes review” if the Board enters a “final written decision under section 318(a).”

A. Statutory IPR Estoppel Applies to Real Parties in Interest and Privies

Statutory IPR estoppel, by its express terms, attaches not only to a petitioner but also to “the real party in interest or privy of the petitioner.” One nuance of this provision is that the

³⁶ See *Intuitive Surgical, Inc. v. Ethicon LLC*, 25 F.4th 1035, 1041 (Fed. Cir. 2022) (“[E]stoppel is triggered when an IPR proceeding results in a final written decision.”).

³⁷ See 35 U.S.C. § 317(a) (“If the inter partes review is terminated with respect to a petitioner under this section, no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner, on the basis of that petitioner’s institution of that inter partes review.”).

³⁸ 35 U.S.C. § 311(b).

³⁹ A PGR petition can raise any statutory ground of challenge. See 35 U.S.C. § 321(b).

⁴⁰ 35 U.S.C. § 312(a)(3).

Board will not decide whether an IPR petitioner should have identified an unnamed real party in interest under section 312(a)(2), unless there is an alleged time bar under section 315(b)⁴¹ or statutory estoppel under section 315(e) that would bar institution of petitioner's IPR.⁴² Director Vidal recently underscored the point in a *sua sponte* Director Review and vacatur of a Board Order, which had determined Samsung Electronics Co., Ltd. and Apple Inc. should have been named by petitioner Unified Patents as real parties in interest due to statutory IPR estoppel implications:

The Board can and should make a determination of the real parties in interest or privity in any proceeding in which that determination may impact the underlying proceeding, for example, but not limited to, a time bar under 35 U.S.C. § 315(b) or an estoppel under 35 U.S.C. § 315(e) that might apply.⁴³

The Director, however, vacated the Board's order as an improper advisory opinion, because any estoppel that might apply to Samsung and Apple in subsequently filed IPRs (or district court proceedings) did not apply in the current IPR proceeding to which Samsung and Apple were not a party.

In short, a real party in interest to an IPR proceeding, whether named or not, and privies of petitioner will be bound by the statutory IPR estoppel provisions of section 315(e) if the Board issues a final written decision in that proceeding.

B. Statutory IPR Estoppel Applies on a Claim-by-Claim Basis

Section 315(e) estoppel applies by its terms to "a claim in a patent" when an instituted IPR results in a final written decision. The statute further provides that an estopped petitioner cannot request or maintain a proceeding before the Office "with respect to that claim," nor assert in a district court action or ITC proceeding that "the claim is invalid." Statutory IPR estoppel, therefore, is applied on a claim-by-claim basis; estoppel does not attach to unchallenged patent

⁴¹ See *Appl'ns in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1136 (Fed. Cir. 2018) (unnamed third party alleged to be a time-barred real party in interest).

⁴² See *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11, 18 (PTAB 10.6.20) (precedential) (Board will not address whether petitioner must identify an unnamed real party in interest because "there is no allegation or evidence that [the third party] is barred or estopped from this proceeding").

⁴³ *Unified Patents, LLC v. Memoryweb, LLC*, IPR2021-01413, Paper 76, 5 (PTAB 5.22.23).

claims.⁴⁴ PTAB’s precedential *Westlake Services* decision noted that, in comments to 37 C.F.R. Section 42.208(b), the Patent Office stated “35 U.S.C. 315(e), as amended, and 35 U.S.C. 325(e) provide for estoppel on a claim-by-claim basis, for claims in a patent that result in a final written decision.”⁴⁵ Given the clarity of the statutory language and Federal Circuit opinions on this point, there is consensus that statutory IPR estoppel applies on a claim-by-claim basis.

C. Statutory IPR Estoppel Applies to Other Patent Office Proceedings, District Court Patent Actions and § 337 ITC Proceedings

Statutory IPR estoppel precludes a petitioner from raising permitted grounds in other Patent Office proceedings: “The petitioner ... may not maintain or request a proceeding before the Office.” The estoppel extends to other IPR, PGR, and ex parte reexamination proceedings filed by petitioners, whether filed in parallel with a finally decided IPR or filed after the final written decision, all of which will be discussed in more detail below. Statutory IPR estoppel also precludes a petitioner from later raising permitted grounds in district court patent actions and in section 337 ITC proceedings: “The petitioner ... may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the [ITC] under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.” The more interesting developments involve disputes over the proper scope of estoppel applied in district court actions, discussed below.

V. Parallel IPRs: The First Final Written Decision Triggers Parallel Estoppel

Board issuance of a final written decision under section 318(a) triggers statutory IPR estoppel with immediate effect. In *Intuitive Surgical*, petitioner had filed three parallel IPR petitions on the same day challenging various claims of the same patent.⁴⁶ Due to an administrative quirk, the first two petitions were granted a Notice of Filing Date Accorded several weeks earlier than the third petition, which led to a gap of several weeks between the

⁴⁴ *Intuitive Surgical*, 25 F.4th at 1042 (“§ 315(e)(1) estoppel applies on a claim-by-claim basis.”); see also *Westlake Services, LLC v. Credit Acceptance Corp.*, CBM2014-00176, Paper 28, 5 (PTAB 5.14.15) (precedential) (statutory PGR “estoppel is applied on a claim-by-claim basis.”).

⁴⁵ *Westlake Services*, *id.* at 4 (citing to Comment 60 in CHANGES TO IMPLEMENT INTER PARTES REVIEW PROCEEDINGS, POST-GRANT REVIEW PROCEEDINGS, AND TRANSITIONAL PROGRAM FOR COVERED BUSINESS METHOD PATENTS; FINAL RULE, 77 Fed. Reg. 48680, 48703 (8.14.12)).

⁴⁶ *Intuitive Surgical*, 25 F.4th at 1038.

statutory due dates of the final written decisions in the first two cases versus the third case. The Board entered the first two final written decisions on the same day determining certain of the challenged patent claims to be patentable, and patent owner then filed a motion asking the Board to terminate the petitioner from the third IPR proceeding based on statutory IPR estoppel. The Board granted the motion.

The Federal Circuit upheld the Board’s decision and dismissed the appeal, determining that “estoppel is triggered when an IPR proceeding results in a final written decision, compelling the conclusion that Intuitive was estopped as to the [third] IPR once the [first two] IPRs concluded with final written decisions.”⁴⁷ The Federal Circuit held that section 315(e)(1) estops a petitioner from “maintaining” an IPR petition that reasonably could have raised the asserted grounds challenging the same patent claims in an “earlier decided IPR, regardless of whether the petitions were *simultaneously filed* and regardless of the reasons for their separate filing.”⁴⁸ The court also indicated that petitioner could have avoided the problem if it had filed separate petitions with each one addressing “a separate, manageable subset of the claims to be challenged—as opposed to subsets of grounds—as § 315(e)(1) estoppel applies on a claim-by-claim basis.”⁴⁹

One important lesson from *Intuitive Surgical* is that if PTAB institutes more than one parallel IPR brought by the same petitioner challenging the same patent claims, the petitioner should consider requesting Board authorization to file a motion to consolidate the proceedings. Consolidation and issuance of a single final written decision will avoid a potential estoppel that otherwise would take effect if the parallel IPR cases proceed on different schedules. If a final written decision in one IPR issues before the other(s), as it did in *Intuitive Surgical*, petitioner will be estopped from maintaining the undecided IPRs.

VI. “Reasonably-Could-Have-Raised” Estoppel in District Court and the Federal Circuit

Statutory IPR estoppel applies to “any ground ... petitioner ... reasonably could have raised during that inter partes review,” a statutory form of claim preclusion. For context,

⁴⁷ *Id.* at 1041.

⁴⁸ *Id.* (emphasis added).

⁴⁹ *Id.* at 1041-42.

Congress had drawn a narrower form of estoppel for inter partes reexamination, included in the safe harbor provision:

However, the third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or inter partes reexamination. *Prior art was unavailable at the time if it was not known* to the individuals who were involved in the civil action or inter partes reexamination proceeding on behalf of the third-party requester and the USPTO.⁵⁰

In the AIA, Congress decided to jettison the personal knowledge exception to inter partes reexamination estoppel, and it further illuminated during debate that “reasonably-could-have-raised” estoppel extends to “that prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover.”⁵¹ Congress made clear that “[i]t is only reasonable to apply estoppel to claims the challenger was, or should have been, in a position to raise, whether or not it did so.”⁵²

A number of court decisions have addressed the scope of reasonably-could-have-raised estoppel, particularly in the wake of *SAS Institute v. Iancu*, which ruled that PTAB institution decisions require “a binary choice—either institute review or don’t.”⁵³ One important effect of *SAS Institute* was to end the Board’s practice of partial institution—instituting review of some claims and grounds in a petition but denying others. No more partial institution meant no more partial estoppel,⁵⁴ because after *SAS Institute* all challenged claims and grounds are addressed and decided by the Board in a final written decision. *SAS Institute* put teeth into “reasonably-could-have-raised” estoppel, as intended by Congress.

A. Patent Owner Bears the Burden of Proving that Statutory IPR Estoppel Applies

One of the first district court decisions to address reasonably-could-have-raised estoppel after *SAS Institute* was *Sionyx v. Hamamatsu Photonics*.⁵⁵ In *Sionyx*, patent owner moved for summary judgment to preclude defendant from pursuing section 102 and 103 invalidity defenses

⁵⁰ Conference Report on HR 1554, 145 Cong. Rec. H11769, H11805, 2nd col. (11.9.99) (emphasis added).

⁵¹ 157 Cong. Rec. S1375 (3.8.11) (Sen. Kyl); see quotes in II. AIA Legislative Review, above.

⁵² Senate Rep. at 23.

⁵³ *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018) (“*SAS Institute*”).

⁵⁴ See *Shaw Indus. v. Automated Creel*, 817 F.3d 1293, 1300 (Fed. Cir. 2016) (“The plain language of the statute prohibits the application of estoppel under these [non-instituted claims and grounds] circumstances.”).

⁵⁵ *Sionyx, LLC v. Hamamatsu Photonics K.K.*, 330 F. Supp. 3d 574 (D. Mass. 2018) (“*Sionyx*”).

based on prior art not raised in the earlier-decided IPR proceeding. The *Sionyx* court went on to determine that patent owner had the burden of proving statutory IPR estoppel applied, but had failed to present “evidence showing that a skilled searcher would have found” the prior art patent publication at issue.⁵⁶ Although there was a split among district courts at the time as to which party had the burden of proof, the Federal Circuit very recently held in *Ironburg v. Valve Corp.* that “the burden of proving, by a preponderance of the evidence, that a skilled searcher exercising reasonable diligence would have identified an invalidity ground rests on the patent holder, as the party asserting and seeking to benefit from the affirmative defense of IPR estoppel.”⁵⁷ The Federal Circuit reversed and remanded the district court’s decision to estop defendant Valve Corp. from raising prior art invalidity defenses not raised in Valve’s IPR petition, “[b]ecause the district court improperly placed the burden of proof on Valve.”⁵⁸

The burden of proving that statutory IPR estoppel applies rests on patent owner. How a patent owner tries to satisfy that burden will be the source of a lot of creative lawyering, discovery, and subsequent litigation, discussed in more detail below.

B. The Standard for Reasonably-Could-Have-Raised Estoppel

The *Sionyx* court clarified that, after *SAS Institute*, “the words ‘reasonably could have raised’ ... must refer to grounds that were not actually in the IPR petition, but reasonably could have been included.”⁵⁹ The *Sionyx* court then defined the standard for determining whether an invalidity ground “reasonably could have been raised” in an IPR petition by quoting Senator Kyl from the Senate floor debate in March 2011: “[R]easonably could have raised’ is meant to include any patent or printed publication that a petitioner actually knew about or that ‘a skilled searcher conducting a diligent search reasonably could have been expected to discover.”⁶⁰ The district court cited other district court decisions that had adopted the same standard, and stated “[t]his Court will do the same.”⁶¹

The Federal Circuit has reached the same conclusion as the district courts. In *California Institute of Technology v. Broadcom*, the Federal Circuit affirmed summary judgment of no

⁵⁶ *Id.* at 602-03.

⁵⁷ *Ironburg Inventions Ltd. v. Valve Corp.*, 64 F.4th 1274, 1299 (Fed. Cir. 2023) (“*Ironburg*”).

⁵⁸ *Id.* at 1299.

⁵⁹ *Sionyx*, 330 F. Supp. 3d at 602.

⁶⁰ *Sionyx*, 330 F. Supp. 3d at 602 (quoting 157 Cong. Rec. S1375).

⁶¹ *Id.*

invalidity based on IPR statutory estoppel, clarifying that “estoppel applies ... to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the petition.”⁶² The Federal Circuit again confirmed the standard for reasonably-could-have-raised estoppel in the recent *Ironburg* decision:

[W]e hold that, provided the other conditions of the statute are satisfied, § 315(e)(2) estops a petitioner as to invalidity grounds *a skilled searcher conducting a diligent search* reasonably could have been expected to discover, as these are grounds that the petitioner “reasonably could have raised” *in its petition*.⁶³

The Federal Circuit has concluded that, in a post-*SAS Institute* regime, any ground that could have been raised in a petition due to petitioner’s actual knowledge of the prior art patents or printed publications, or sufficient evidence that a skilled searcher conducting a diligent search would have located them, is a ground that petitioner reasonably could have raised during the inter partes review. And the Supreme Court recently denied *certiorari* on Apple-Broadcom’s challenge to the Federal Circuit’s statutory interpretation, as recommended in the considered view of the Solicitor General, thereby lending further weight to the Federal Circuit’s holding quoted above.⁶⁴ The breadth of statutory IPR estoppel also may add strength to a request for a stay of a district court action pending completion of an IPR, because there will be little to no overlap on the section 102 and 103 prior art invalidity issues between the two fora.

C. *Applying the Reasonably-Could-Have-Raised Estoppel Standard*

In *Ironburg*, the Federal Circuit left it to the district court to decide whether a jury trial on remand would be needed to resolve questions of fact, or whether the estoppel determination could be resolved as a matter of law “via case-dispositive motions or some other mechanism.”⁶⁵ The patent owner would likely want time to consider whether to retain an expert witness, or take depositions of defendant and its patent counsel to determine whether and when defendant might have learned about any unidentified prior art references. A district court would certainly want to

⁶² *California Institute of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 991 (Fed. Cir. 2022), *cert den.* in *Apple Inc. v. California Inst. of Tech.*, 2023 WL 4163206 (Mem.) (June 26, 2023).

⁶³ *Ironburg*, 64 F.4th at 1298 (emphasis added).

⁶⁴ See *Apple Inc. v. California Inst. of Tech.*, 2023 WL 4163206 (Mem.) (June 26, 2023) (No. 22-203).

⁶⁵ *Ironburg*, 64 F.4th at 1300.

resolve the estoppel issue prior to trial via summary judgment or a motion in limine, rather than risk confusing a jury on a question of law, but that might not be possible in every case.

The *Sionyx* court determined, consistent with the Federal Circuit's later *Ironburg* decision, that it was Patent Owner's burden "(1) to identify the search string and search source that would identify the allegedly unavailable prior art and (2) present evidence, likely expert testimony, why such a criterion would be part of a skilled searcher's diligent search."⁶⁶ The court found a question of material fact as to whether a skilled searcher would have located the prior art reference at issue, noting that "indeed, the examiner of the '591 patent tried 56 search strings and still did not turn up [the prior art]."⁶⁷ The court denied the patent owner's summary judgment motion attempting to bar defendant from raising certain invalidity grounds.

Patent owners and petitioners will have their hands full when addressing the reasonably-could-have-raised estoppel standard. Questions abound:

- a. What search strings and sources did the USPTO Examiner use during prosecution? What search strings and sources would a skilled searcher conducting a diligent search have used, and with what results?
- b. How did patent owner learn of any IDS references cited during prosecution, and who will testify about it?
- c. Does patent owner need to introduce expert testimony of a skilled searcher's prior art search method, diligence, and results against patent owner's own patent?
- d. Was defendant actually aware of the prior art references at issue? If so, how, when did defendant learn about the references, and who will testify about it? (Note: In *Ironburg*, Valve had done its own search but only learned of the disputed references from a third-party IPR filed after Valve's IPR.)
- e. How should a defendant rebut evidence that a skilled searcher exercising reasonable diligence would have found the prior art at issue, if defendant's search did not?
- f. Should defense counsel hire a commercial prior art search service to conduct a search and bolster the argument that the search was performed by a skilled searcher exercising reasonable diligence?

⁶⁶ *Sionyx*, 330 F. Supp. 3d at 603 (citing *Clearlamp, LLC v. LKQ Corp.*, 2016 WL 4734389, at *7-8 (N.D. Ill. Mar. 18, 2016)).

⁶⁷ *Id.*

- g. Should a defendant present expert testimony that defendant’s search was conducted by a skilled searcher exercising reasonable diligence but did not uncover the prior art?
- h. Is it reasonable to not search catalogued Ph.D. theses? Non-English language art? Foreign patent offices?
- i. Did counsel have input into any searches and who, if anyone, will testify about it?
- j. Will a party that presents evidence about its own search need to waive attorney work product protection or attorney-client privilege and, if so, what will be the scope of the waiver?

There will be many different approaches that are situation dependent, but a few common threads are apparent. Both parties will want to scour the relevant patent prosecution history for the Examiner’s search strategies and results, all IDS-cited references, and particularly published international applications and non-patent literature to see if any correspond to the reference(s) relied on by the patent challenger in post-IPR Patent Office reexamination (or IPR), district court, or ITC proceedings. Patent owners bear the burden of proof and will want to consider retaining a competent prior art search expert to provide expert testimony discussing the method and results of a diligent, skilled prior art search directed to the challenged patent claims. Some specific evidentiary techniques are discussed below in section IX. Estoppel in Reexamination section. Parties and their counsel also should give careful consideration to any potential waiver of attorney work product or attorney-client privileged communications before providing documentary and testimonial evidence regarding the application of statutory IPR estoppel.

D. Does Statutory IPR Estoppel Apply to Prior Art Products and Systems?

Other cases raise the fact-dependent question of whether an infringement defendant can rely on a prior art product or system to assert invalidity in district court, because IPR petitioners cannot rely on product or system art to support a ground of challenge under section 311(b). The answer depends on which district court you are in, whether a printed publication describing the relevant product—for example a product manual, data sheet, manufacturing specification, or article—was identifiable from a reasonably diligent search, and whether such document disclosed “all the relevant features of that physical product.”⁶⁸ In *Wasica Finance v. Schrader*,

⁶⁸ *Wasica Finance GmbH v. Schrader Int’l, Inc.*, 432 F. Supp. 3d 448, 453-54 (D. Del. 2020) (Stark, J.); *see also Sionyx* at 603-04 (“defendants’ declarations [] raise a genuine issue of material fact as to whether the manufacturing specification [for the device] was public.”); *SPEX*

Judge Stark expressed the view that because section 315(e) “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.”⁶⁹ Judge Noreika, on the other hand, has expressed the view that “Congress could have dictated that estoppel applies to products covered by the paper art underlying the IPR where the paper art discloses the same claim limitations as the product,” but chose not to do so.⁷⁰ Judge Noreika’s strict construction concerning the scope of statutory IPR estoppel represents a view shared by other district courts.⁷¹

The scope of statutory IPR estoppel when prior art products or systems are raised by a defendant in district court after an IPR final written decision, is an issue ripe for Federal Circuit review and guidance. In the meantime, it looks like the estoppel analysis applied to prior art product and system-based invalidity defenses will depend upon the particular district court judge assigned to the case.

VII. Does Statutory IPR Estoppel Apply to Amended (Substitute) Claims?

Under section 315(e), statutory IPR estoppel applies to “a claim in a patent under this chapter that results in a final written decision.” Section 316(d) permits a patent owner in an instituted IPR proceeding to “amend the patent” by proposing “[f]or each challenged claim, [] a reasonable number of substitute claims” that do “not enlarge the scope of the claims of the patent.” Section 318(a) requires the Board to “issue a final written decision with respect to the patentability of ... any new claim added under section 316(d).” Whether statutory IPR estoppel applies to newly amended (substitute) claims approved by the Board in a final written decision remains an open question awaiting further guidance from the Patent Office and courts.

Pre-AIA inter partes reexamination estoppel applied to “any claim finally determined to be valid and patentable,” which included new and amended claims introduced during inter partes

Techns. Inc. v. Kingston Techn. Corp., 2020 WL 4342254 (C.D. Cal. 2020) (Selna, J.); *Medline Industries, Inc. v. C.R. Bard, Inc.*, 2020 WL 5512132 (N.D. Ill. 2020) (Ellis, J.).

⁶⁹ *Wasica Finance*, 432 F. Supp. 3d at 454 (emphasis in original)(n.6 collecting cases).

⁷⁰ *Chemours Co. FC, LLC v. Daikin Indus., Ltd.*, 2022 WL 2643517, at *2 (D. Del. 2022).

⁷¹ See *Singular Computing LLC v. Google LLC*, 2023 WL 2839282 at *4-7 (D. Mass. 2023) (“The Patent Act says nothing about estopping invalidity claims that are “cumulative” or “duplicative” of those raised in an IPR proceeding.” [However] “Google is estopped from using patents and printed publications of which it was aware, or reasonably should have been aware, at the time of the IPR proceeding. That bar applies whether the patents and printed publications are offered as stand-alone evidence, or in combination with other evidence that could not have been presented at the IPR proceeding.”).

reexamination.⁷² Consistent with inter partes reexamination estoppel, the Patent Reform Act of 2007 expressly applied post grant statutory estoppel to “any original or *new claim* of the patent challenged.”⁷³ The estoppel language referring to “any original or new claim,” however, was not carried forward in AIA sections 315(e) and 325(e), even though a final written decision of the Board under section 318(a) must address “any new claim added under section 316(d).”

The change to the express estoppel language used in the Patent Reform Act of 2007, when considered against the backdrop of inter partes reexamination estoppel that encompassed new and amended patent claims, suggests that Congress may not have intended for statutory IPR estoppel to apply to newly amended (substitute) claims that issue from an IPR proceeding. On the other hand, requiring a final written decision to address “any new claim” could be viewed as consistent with the application of statutory IPR estoppel to such new claims. The author was unable to locate a legislative history reference explaining why the “any original or new claim” estoppel language in the Patent Reform Act of 2007 was changed in AIA sections 315(e) and 325(e).

If Congress did not intend statutory IPR estoppel to apply to “any new claim,” it would be consistent with the limitations of several sections of the AIA. Section 311(b) provides that an IPR petition can only challenge “[one] or more *claims of a patent*.” Section 312(a)(3) provides that a petition must identify “each claim *challenged*,” and section 315(e) estoppel applies to “a *claim in a patent* under this chapter that results in a final written decision under section 318(a).” New patent claims that arise from a patent owner’s motion to amend filed after an IPR has been instituted do not satisfy the literal terms of sections 311(b), 312(a)(3), and 315(e). New patent claims are not a claim “challenged” in a petition or even “a claim in a patent” until the Director issues and publishes a certificate under section 318(b) “incorporating in the *patent* by operation of the certificate any new or amended claim determined to be patentable.” A Director’s certificate does not issue under section 318(b) until “the time for appeal has expired or any appeal has terminated,” which is typically months after an appeal to the Federal Circuit and issuance of a mandate.

⁷² 35 U.S.C. § 315(c) (pre-AIA).

⁷³ Patent Reform Act of 2007 S. 1145, § 338 (2007) (emphasis added); *see also* Senate Rep. 110-259 at 48; H.R. 1908, § 335 (2007).

On the other hand, Congress made clear that an “enhanced” form of estoppel was important to limit a petitioner’s opportunities to challenge patent validity under sections 102 and 103 based on prior art patents and printed publications. The Board provides petitioners with an opportunity to oppose proposed substitute claims presented during an IPR, and the Board itself can raise a patentability issue based on the evidence of record to support rejection of a proposed substitute claim.⁷⁴ The Supreme Court also has ruled that “§ 318(a) categorically commands the Board to address in its final written decision ‘any patent claim *challenged by the petitioner.*’”⁷⁵ A petitioner’s opposition to a patent owner’s motion to amend one or more of the challenged claims during an IPR, including any opposition to a revised motion to amend after the Board issues Preliminary Guidance regarding patentability, could be viewed as part of a petitioner’s “challenge” to “any patent claim.”

In short, if the Board upholds a new patent claim in a final written decision over the opposition of a petitioner, there is certainly an argument that statutory IPR estoppel, if not common law issue preclusion, should apply. Where the Federal Circuit will land on this question is difficult to predict.

VIII. Does Statutory IPR Estoppel Replace Common Law Issue Preclusion?

*A. The June 2023 District Court Decision in DMF v. Amp Plus*⁷⁶

One interesting estoppel question recently considered by the Central District of California in the *DMF* case, is whether statutory IPR estoppel under section 315(e) applies in lieu of common law issue preclusion (collateral estoppel) when a court determines whether to estop a defendant from pursuing patent invalidity defenses in district court.⁷⁷ In *DMF*, the patent owner filed a motion to preclude defendant from pursuing an invalidity defense based on a prior art physical product, after the PTAB had issued a final written decision finding several patents

⁷⁴ See *Nike, Inc. v. Adidas AG*, 955 F.3d 45, 51 (Fed. Cir. 2020) (“the Board may sua sponte identify a patentability issue for a proposed substitute claim based on the prior art of record”); see also *Hunting Titan, Inc. v. DynaEnergetics GmbH & Co. KG*, IPR2008-00600 Paper 67 (PTAB 7.6.20) (“the Board may, in certain rare circumstances, raise a ground of unpatentability that a petitioner did not advance, or insufficiently developed, against substitute claims.”).

⁷⁵ *SAS Institute*, 138 S. Ct. at 1357 (emphasis added).

⁷⁶ See *DMF, Inc. v. Amp Plus, Inc.*, 2:18-cv-07090 Docket 613, Decision on Plaintiff’s Motion that Issue Preclusion Bars Elco’s § 102/103 Prior Art Invalidity Challenges (C.D. Cal. 6.14.23) (Snyder, J.) (hereafter “*DMF*”).

⁷⁷ *Id.* at 6.

claims not unpatentable. Patent owner’s motion relied on the “well established” doctrine of issue preclusion.⁷⁸

The district court in *DMF* framed the question, a matter of first impression, as “whether common law issue preclusion may be applied in this context, i.e., where the 35 U.S.C. § 315(e)(2) framework applies to determine whether invalidity grounds are barred by IPR estoppel.”⁷⁹ The court reasoned that the question devolved to whether there was an evident statutory purpose not to apply common law issue preclusion when statutory IPR estoppel applies to bar invalidity grounds, in accordance with the rule of *B&B Hardware*: “courts may take it as given that Congress has legislated with the expectation that the principle [of issue preclusion] will apply except when a statutory purpose to the contrary is evident.”⁸⁰ *B&B Hardware* involved the question of whether a final decision of an administrative agency, specifically the Trademark Trial and Appeal Board (TTAB), could have issue preclusive effect in district court litigation. The Supreme Court ruled that nothing in the text or structure of the Lanham Act provided an “evident’ reason why Congress would not want TTAB decisions to receive preclusive effect.”⁸¹

The district court in *DMF* recognized that, unlike the Lanham Act at issue in *B&B Hardware*, “Section 315(e)(2) set[s] forth the bounds of estoppel based on IPR proceedings.”⁸² The Lanham Act, by contrast, does not contain a comparable TTAB statutory estoppel provision or anything else that would “bar[] the application of issue preclusion.”⁸³ The district court, therefore, reasoned that the “evident statutory purpose” exception of *B&B Hardware* applied to statutory IPR estoppel, which barred application of common law issue preclusion in the context of deciding whether to preclude defendant from pursuing invalidity grounds as defenses in district court:

[The IPR statute] also contains an explicit section covering “estoppel” in later IPR proceedings, civil actions, and other proceedings. Because Congress enacted a specific framework with respect [to]the issue preclusive effect of IPR proceedings, the Court finds that § 315(e)(2) embodies an evident statutory

⁷⁸ *Id.* at 6-7.

⁷⁹ *Id.* at 6.

⁸⁰ *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 148, 135 S. Ct. 1293, 1303 (2015) (citation omitted) (emphasis added).

⁸¹ *Id.* 135 S. Ct. at 1305.

⁸² *DMF* at 7 (citing *Illumina, Inc. v. Qiagen, N.V.*, 207 F. Supp. 3d 1081, 1089 (N.D. Cal. 2016)).

⁸³ See *B&B Hardware*, 135 S. Ct. at 1305.

purpose to apply the specified framework in lieu of common law issue preclusion. *Cf. Click-to-Call Techs. LP v. Ingenio, Inc.*, 45 F.4th 1363, 1368 (Fed. Cir. 2022) ... The Court declines to adopt an application of common law issue preclusion that would render § 315(e)(2) meaningless, at least on the facts presented here.⁸⁴

The district court in *DMF* interpreted section 315(e) as reflecting the evident statutory purpose of Congress to apply statutory IPR estoppel, rather than common law issue preclusion, when considering whether to preclude invalidity defenses in district court. This makes sense under *B&B Hardware* given that statutory IPR estoppel expressly precludes petitioner from later asserting any “ground” that was actually “raised” or that “reasonably could have [been] raised” during the IPR. The *DMF* court, importantly, underlined the limited context for applying statutory IPR estoppel by emphasizing the limited scope of IPRs as challenging patent claims “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.”⁸⁵ The *DMF* court ruled that patent owner DMF had failed to establish “that common law issue preclusion can be used as an end-run around § 315(e)(2).”⁸⁶

B. *The Federal Circuit Click-to-Call Decision*

The Federal Circuit has weighed-in on the question once, albeit somewhat indirectly. In *Click-to-Call v. Ingenio*,⁸⁷ defendant Ingenio moved for summary judgment of invalidity. Patent owner Click-to-Call opposed the motion under section 315(e)(2), arguing that Ingenio was estopped because Ingenio “could have raised” the invalidity argument during an IPR proceeding that resulted in a final written decision, but had failed to do so. The district court granted defendant’s motion for summary judgment and rejected patent owner’s estoppel argument. The district court, however, had analyzed estoppel only under the principles of common law issue preclusion, not section 315(e)(2).

The Federal Circuit reversed, stating:

We agree that the district court erred by not addressing the actual basis of Click-to-Call’s estoppel argument, and *we hold as a matter of law that IPR estoppel applies*. At the outset, the district court erred by analyzing Click-to-Call’s

⁸⁴ *DMF* at 8 (statute citation omitted). The *DMF* court, nevertheless, also determined that even if common law issue preclusion were to be considered, patent owner failed to establish that it applied on the merits. *Id.* at 10-14.

⁸⁵ *Id.* at 9 (quoting 35 U.S.C. § 311(b)).

⁸⁶ *Id.*

⁸⁷ *Click-to-Call Techs. LP v. Ingenio, Inc.*, 45 F.4th 1363 (Fed. Cir. 2022) (*certiorari* filed).

argument only under common law issue preclusion. Click-to-Call’s argument regarding Dezonno and claim 27 was grounded in IPR estoppel under 35 U.S.C. § 315(e)(2), not standard issue preclusion.⁸⁸

The Federal Circuit analyzed Click-to-Call’s reasonably-could-have-raised statutory IPR estoppel argument and further held that “IPR estoppel applies here as a matter of law and precludes Ingenio from arguing that claim 27 is anticipated by Dezonno.”⁸⁹ That holding makes perfect sense and is mandated by the plain language of the statute.

The Federal Circuit also limited its decision to the unusual set of facts in the case (which included a pre-*SAS Institute* partial institution decision) and the district court’s failure to recognize and apply the reasonably-could-have-raised prong of statutory IPR estoppel. It was in this context that Judge Stoll went on to say that “the district court’s reason for rejecting Click-to-Call’s argument—a reason derived from the issue preclusion rubric—does not apply to IPR estoppel.” The *DMF* district court cited that language from *Click-to-Call* in support of its conclusion that statutory IPR estoppel applied in lieu of common law issue preclusion. It is worth noting, however, that Judge Stoll may only have been emphasizing the district court’s error in failing to analyze the argument that patent owner actually made under 315(e)(2)—patent owner never argued that common law issue preclusion applied.⁹⁰ Regardless, the Federal Circuit decision supports the view that statutory IPR estoppel applies in lieu of common law claim preclusion when deciding whether invalidity grounds or defenses may be pursued in later reexamination, district court, or ITC proceedings.

Congress intended the enhanced form of statutory IPR estoppel—“any ground . . . petitioner raised or reasonably could have raised”—to take precedence over common law issue preclusion (no “actually litigated” requirement), particularly in view of the extensive discussion and debate regarding the scope and purpose of the statutory estoppel provisions in both the Senate and House chambers.⁹¹ Statutory IPR estoppel is broader than issue preclusion and has more bite as a statutory form of claim preclusion. Congress intended it that way to avoid or minimize duplicative litigation, serial patent validity challenges, and patent owner harassment. It

⁸⁸ *Id.* at 1368 (emphasis added).

⁸⁹ *Id.*

⁹⁰ It is likely that patent owner understood common law issue preclusion would not have estopped defendant in district court because the same invalidity issue had not been raised, actually litigated, or decided during the earlier IPR proceeding.

⁹¹ *See* II. AIA Legislative Review above.

would be surprising if a court determined that Congress intended common law issue preclusion to apply in addition to section 315(e)(2) estoppel in the specific context of deciding whether to preclude unpatentability grounds or invalidity defenses in later reexamination, IPR, district court, or ITC proceedings.

C. Applying Common Law Issue Preclusion in Other IPR Contexts

What about applying common law issue preclusion in Patent Office or court proceedings in a context other than statutory IPR preclusion of invalidity defenses or unpatentability grounds? The Federal Circuit has stated that “Board decisions in IPR proceedings can trigger issue preclusion,” such as when the same section 315(b) one-year time bar issue is raised in separate IPR proceedings.⁹² The Federal Circuit also has applied common law issue preclusion when an intervening Federal Circuit decision affirmed the unpatentability of some of the same patent claims being considered in the pending appeal, and the court found the intervening decision “binding in this proceeding, as a matter of collateral estoppel.”⁹³ The court went on to point out that “[i]f the differences between the unadjudicated patent claims and adjudicated patent claims do not materially alter the question of invalidity, collateral estoppel applies” against patent owner.⁹⁴

The Federal Circuit recently applied collateral estoppel against a patent owner in exactly the same context referenced in *Maxlinear* to invalidate patent claims in an “unadjudicated” related patent, while underscoring the point that “[i]t is well established that collateral estoppel applies to IPR proceedings.”⁹⁵ The *Google v. Hammond Development* decision applied a form of patent owner collateral estoppel to reverse an IPR final written decision upholding patentability of two patent claims, because an earlier final written decision in an IPR of a related patent sharing the same specification determined very similar claims to be unpatentable. The court found that even though the claim language was slightly different, “collateral estoppel requires [only] that the *issues of patentability* be identical.”⁹⁶ Patent Office regulations for IPR

⁹² See *Power Integrations, Inc. v. Semiconductor Components Industries, LLC*, 926 F.3d 1306, 1312, n.3 (Fed. Cir. 2019).

⁹³ *Maxlinear, Inc. v. CF Crespe LLC*, 880 F.3d 1373, 1376 (Fed. Cir. 2018).

⁹⁴ *Id.* at 1377.

⁹⁵ *Google LLC v. Hammond Development Int’l, Inc.*, 54 F.4th 1377, 1381 (Fed. Cir. 2022) (citing *Papst Licensing GmbH & Co. KG v. Samsung Elecs. Am., Inc.*, 924 F.3d 1243, 1251 (Fed. Cir. 2019)).

⁹⁶ *Id.* at 1381 (emphasis in original).

proceedings also set out a form of patent owner estoppel that precludes “[a] patent applicant or owner ... from taking action inconsistent with the adverse judgment, including obtaining in any patent [a] claim that is not patentably distinct from a finally refused or canceled claim.”⁹⁷ The rationale of *Google v. Hammond Development* and the cited Patent Office regulation applies in subsequent IPRs, reexamination, reissue, or continuation application proceedings, which may be at odds with Director Iancu’s April 2019 Guidance re Amendments in Reissue or Reexamination informing patent owners that reissue or reexamination is available for obtaining new claims after an IPR determines issued claims unpatentable.⁹⁸

One unresolved question is whether underlying determinations necessary to the Board’s judgment in a final written decision will apply and bind the parties in district court and ITC proceedings, for example: i) claim construction, ii) whether patent claims have sufficient written description support in the specification for an earlier priority date, iii) whether an anticipatory reference is enabling, iv) whether a reference teaches away from the claimed invention, or v) whether objective indicia of non-obviousness have an appropriate nexus to the claimed invention. Common law issue preclusion encompasses all underlying determinations essential to a final judgment, so it makes sense that parties might be precluded from contesting the essential underlying determinations of an IPR proceeding in subsequent reexamination, district court, and ITC proceedings addressing the same claims. A recent district court decision, however, provides a different twist on such an application of issue preclusion.

In *Indivior v. Alvogen Pine Brook*, the district court determined that issue preclusion would not apply to prevent patent owner from pursuing infringement of a dependent claim that had not been challenged during an earlier IPR proceeding.⁹⁹ The PTAB had invalidated a number of other claims in the patent because patent owner could not establish an earlier priority date due to lack of written description support under section 112(a). Because the unadjudicated dependent claim recited an additional limitation that “significantly narrow[ed]” the claim, the district court was not prepared to “resolve on a collateral-estoppel basis at the summary

⁹⁷ 37 C.F.R. § 42.73(d)(3).

⁹⁸ Vol. 84 (No. 77) Fed. Reg. 16,654 (4.22.19).

⁹⁹ *Indivior Inc. f/k/a Reckitt Benckiser Pharmaceuticals Inc. v. Alvogen Pine Brook, Inc.*, 2-17-cv-07106 at 19-23 (D.N.J. 7.10.23) (McNulty, J.).

judgment stage” the question of whether the added limitation cured the written description deficiencies identified by the PTAB in a final written decision.¹⁰⁰ Fair enough.

The district court also ruled in the alternative, however, that issue preclusion did not apply because “the two proceedings [PTAB and district court] had disparate burdens of proof.”¹⁰¹ The court emphasized that a PTAB petitioner has a lower burden of proving unpatentability—preponderance of the evidence—compared to a defendant asserting invalidity in district court—clear and convincing evidence. The court reasoned that, under *B&B Hardware*, “issues are not identical if the second action involves application of a *different legal standard*, even though the factual setting of both suits may be the same.”¹⁰²

Under the district court’s interpretation of *B&B Hardware*’s different-legal-standard theory, all essential determinations underlying a PTAB final written decision would fail to satisfy the “same issue” prong of common law issue preclusion, even if the same patent claims that survive an IPR are being asserted in district court. For example, if PTAB had found the challenged patent claims not unpatentable over the prior art because there was sufficient written description support for the claims in an earlier priority application, could the petitioner/defendant avoid application of common law issue preclusion and assert that the same claims are invalid for insufficient written description under section 112(a) because the burdens of proof are different? Even though petitioner-defendant’s burden of proof in district court is *higher* than at the PTAB? Such a result would seem to be at odds with the law of issue preclusion.

The district court in *Indivior*, moreover, overlooked the next sentence following the quoted holding in *B&B Hardware* where the Supreme Court explained that the “different legal standard” doctrine did not apply in that case: “Here, however, the same likelihood-of-confusion standard applies to both [TTAB] registration and [district court] infringement.”¹⁰³ As with the likelihood-of-confusion standard for TTAB registration and trademark infringement, the PTAB applies the same legal standard as a district court for testing the sufficiency of a patent

¹⁰⁰ *Id.* at 21.

¹⁰¹ *Id.* at 23.

¹⁰² *Id.* at 21 (quoting *B&B Hardware*, 135 S. Ct. at 1306) (emphasis added)).

¹⁰³ *B&B Hardware*, 135 S. Ct. at 1306.

application's written description of a claimed invention.¹⁰⁴ The Supreme Court went on to explain:

[I]f federal law provides a single standard, parties cannot escape preclusion simply by litigating anew in tribunals that apply that one standard differently. A contrary rule would encourage the very evils that issue preclusion helps to prevent.¹⁰⁵

That the burdens of proving invalidity are different in PTAB and district court does not alter the fact that both tribunals apply the same legal standard for assessing the issue of written description sufficiency, namely “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.”¹⁰⁶

The Federal Circuit will need to weigh in on the issue of whether the underlying determinations in an IPR final written decision necessarily bind the parties in subsequent Patent Office, district court, and ITC proceedings.

IX. Estoppel in Reexamination: “petitioner ... may not request or maintain a proceeding before the Office”

Section 315(e) provides that “petitioner ... may not request or maintain a proceeding before the Office.” We have explored how the provision applies to estop a petitioner from maintaining a parallel IPR proceeding challenging the same patent claims. But can an unsuccessful IPR petitioner file an *ex parte* request for reexamination challenging the same claims after a final written decision upholding patentability in an IPR proceeding? Can the requester do so if it asserts new grounds of unpatentability not raised in the IPR petition? After all, Patent Office regulations require the reexamination requester to file a certification that “the statutory estoppel provisions of 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) do not prohibit the requester from filing the *ex parte* reexamination request.”¹⁰⁷

¹⁰⁴ See *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

¹⁰⁵ *B&B Hardware*, 135 S. Ct. at 1307.

¹⁰⁶ *Ariad v. Eli Lilly*, 598 F.3d at 1351.

¹⁰⁷ 37 C.F.R. § 1.510(b)(6).

A. *Alarm.com v. Hirshfeld*

In *Alarm.com v. Hirshfeld*, Alarm.com had filed three IPR proceedings after being sued for patent infringement.¹⁰⁸ The PTAB issued three final written decisions upholding patentability of several of the challenged patent claims. After the Federal Circuit affirmed the IPR decisions, Alarm.com filed three requests for ex parte reexamination of the same claims upheld by the PTAB and Federal Circuit. The Office of Legal Administration, acting on behalf of the Director, found that Alarm.com reasonably could have raised its reexamination grounds in the IPR and therefore was estopped from submitting each of its reexamination requests.¹⁰⁹ The Director rejected the requester’s certification as “incorrect” and vacated the ex parte reexamination proceedings based on estoppel under section 315(e)(1) without deciding whether the request raised a substantial new question of patentability.¹¹⁰

Alarm.com then filed an action in the Eastern District of Virginia seeking review of the Director’s vacatur decision under the Administrative Procedure Act. The district court dismissed the case for lack of jurisdiction, and Alarm.com appealed to the Federal Circuit. The Federal Circuit noted, but never ruled on the merits of, the Director’s estoppel decision. After a procedural remand, Alarm.com voluntarily dismissed the suit without prejudice. It is worth noting that the Federal Circuit’s reasonably-could-have-raised estoppel decision in *California Inst. of Techn. v. Broadcom* issued a few weeks before the remand decision in *Alarm.com*, which could explain Alarm.com’s voluntary dismissal of the district court action shortly after the remand, because the holding in *California Inst. of Techn.* supports the Director’s application of estoppel to reexamination proceedings as a matter of law under the facts and circumstances of the *Alarm.com* case.

B. *In re Tyler*

Director Vidal, through the Office of Legal Administration, has continued to apply section 315(e)(1) estoppel to preclude unsuccessful IPR petitioners from challenging the same patent claims in a later reexamination proceeding. In *In re Tyler*,¹¹¹ an IPR petitioner, GITS

¹⁰⁸ See *Alarm.com v. Hirshfeld*, 26 F.4th 1348 (Fed. Cir. 2022).

¹⁰⁹ *Id.* at 1352-53.

¹¹⁰ *Id.* at 1352.

¹¹¹ *In re Tyler, Ex Parte* Reexam. of U.S. Patent No. 6,601,821, Control No. 90/014,950 (Decision on Petition to Vacate Reexamination 11.16.22).

Manufacturing Co., requested reexamination of certain patent claims that were upheld by the Board in an IPR final written decision. The request relied on prior art references that were not cited in GITS’s IPR petition. The Patent Office granted the request for reexamination. Patent owner filed a Petition to Vacate the Reexamination Order pursuant to 37 C.F.R. § 1.181(a), arguing that the request was precluded by statutory IPR estoppel pursuant to section 315(e)(1). Patent Owner filed a declaration of an expert prior art searcher in support of the Petition to Vacate.

The *In re Tyler* decision vacated the reexamination order and terminated reexamination. The decision is instructive for the high standard to which reexamination requesters will be held to avoid reasonably-could-have-raised statutory IPR estoppel, even though the burden of proof is on patent owners. The decision follows the district courts and Federal Circuit in applying the “skilled searcher” standard articulated by Senator Kyl during the AIA Senate floor debate.¹¹² The decision repeatedly indicates that because of the ready availability of commercial databases to the public “most patents and printed publications, particularly U.S. patents and U.S. patent application publications, may, in general, be expected to be discovered by a skilled searcher conducting a diligent search.”¹¹³ The decision notes, for example, that translations of foreign language patents, such as the French language patent at issue, are “commonly used and publicly available” in patent search sites such as Patbase.¹¹⁴ A well-known text book in the field of the invention—internal combustion engines—was found to be obtainable by citation-searching the patent in suit and relevant prior art, which was characterized as “a standard search method and [] not, as requester asserts, unreasonable in a diligent search.”¹¹⁵ Similarly, a non-patent literature publication was publicly available in a searchable database maintained by the Society of Automotive Engineers and found to be within the scope of a reasonably diligent search.¹¹⁶

Footnote 13 in the decision is somewhat surprising, because the Patent Office cites the AIPLA 2017 Economic Survey of significant IPR petition costs to justify the view that “it is expected a petitioner would be motivated to conduct a diligent search, including contacting experts in the relevant field for recommendations on prior art and/or to determine the state of the

¹¹² *Id.* at 5.

¹¹³ *Id.* at 5-6.

¹¹⁴ *Id.* at 7 (citing patent owner’s expert searcher declaration in support).

¹¹⁵ *Id.* at 8.

¹¹⁶ *Id.*

art.”¹¹⁷ When paired with the criticisms of the reexamination requester for failing to describe the searches used to uncover the new references cited in the request, and failing to declare that “references containing equivalent teachings were not found in the search results,” one has to wonder what an estoppel-defeating “scorched-earth” search effort would require to satisfy the Patent Office that newly cited references were, in fact, ““obscure text[s] unlikely to be discovered upon a reasonably diligent search of the relevant prior art.””¹¹⁸

C. Takeaways

Two recent reexamination estoppel decisions, written by the same Senior Patent Attorney in the Office of Patent Legal Administration who authored the *In re Tyler* decision, offer more of the same analysis.¹¹⁹ The Patent Office first addressed the question of whether a final written decision, which was later vacated and remanded by the Federal Circuit, triggers statutory IPR estoppel under section 315(e)(1). The Patent Office answered in the affirmative, relying on the Federal Circuit’s *Intuitive Surgical* holding that statutory estoppel is effective upon issuance of a final written decision. The Patent Office reasoned that statutory IPR estoppel is distinguishable from common law estoppel, where the “courts have uniformly held that estoppel does not apply following vacatur of final decisions.”¹²⁰ It remains to be seen whether the Federal Circuit agrees with the Patent Office’s reasoning on this point. Both decisions also found that all grounds in the respective reexamination requests reasonably could have been raised in the prior IPRs, thereby resulting in a determination that statutory IPR estoppel applied, the requester’s estoppel certification was “improper” under Patent Office regulations, and the reexaminations must be terminated.¹²¹

One final technical point to bear in mind is that *ex parte* reexamination requesters do not have to identify themselves when filing a request under section 302. The Patent Office, therefore, allows a registered practitioner to file the required certification that the statutory IPR estoppel provisions do not prohibit the requester from filing the request for *ex parte*

¹¹⁷ *Id.* at 6 n.13.

¹¹⁸ *Id.* at 6 (citing *Praxaire Dist’n, Inc. v. INO Therapeutics, LLC*, IPR 2016-00781, Paper 10 at 9 (PTAB 8.25.16)).

¹¹⁹ See *In re Frankland, Ex Parte* Reexam. of U.S. Patent No. 7,356,482, Control No. 90/019,070 (Decision on Patent Owner’s Petition 05.26.23); *In re Frankland, Ex Parte* Reexam. of U.S. Patent No. 8,484,111, Control No. 90/019,069 (Decision on Patent Owner’s Petition 5.26.23).

¹²⁰ *Id.* at 7-9.

¹²¹ *Id.* at 9-11.

reexamination.¹²² Would YOU sign such a certification for an unsuccessful IPR petitioner? Practitioners and their clients are well advised to consider providing substantial evidence, including expert testimony, to try to avoid reasonably-could-have-raised statutory IPR estoppel when requesting ex parte reexamination after an IPR final written decision.

Even though patent owner bears the burden of proving that statutory IPR estoppel applies, Director Vidal, through the Office of Legal Administration, has set a high bar for petitioners to avoid statutory IPR estoppel in reexamination requests that challenge the same patent claims upheld in an IPR final written decision.

X. Joinder and Privity Estoppel

A pair of Federal Circuit decisions from 2020 and 2021 explored the intricacies of statutory IPR estoppel in the context of a petitioner who joins an instituted IPR pursuant to 35 U.S.C. Section 315(c).

*A. Network-1 v. Hewlett-Packard*¹²³

In *Network-1*, the Board initially denied Hewlett-Packard's ("HP") petition and motion to join an instituted IPR because HP attempted to include different grounds from those already instituted against challenged claims 6 and 9. HP, now time-barred but utilizing the joinder exception under section 315(b), filed a second petition and motion for joinder that included only the grounds already instituted, and the Board granted the motion. The Board subsequently found challenged claims 6 and 9 not unpatentable in a final written decision, and the Federal Circuit affirmed.

During the subsequent patent infringement trial, where claim 6 (among other claims) was asserted against HP in district court, HP introduced evidence of patent invalidity based on the prior art patents and printed publications the Board had refused to allow HP to add to the joined IPR. The jury found the patent claims invalid for obviousness. The district court granted patent owner's post-trial JMOL motion and concluded that HP was estopped under section 315(e) from raising any prior art patents and printed publications to support obviousness challenges, because HP reasonably could have raised the obviousness grounds in the IPR proceeding.¹²⁴ The Federal

¹²² See MPEP 2214, I.

¹²³ *Network-1 Techns., Inc. v. Hewlett-Packard Co.*, 981 F.3d 1015 (Fed. Cir. 2020) ("*Network-1*").

¹²⁴ *Id.* at 1020-21.

Circuit vacated the district court’s ruling, concluding that “[b]ecause a joining party cannot bring with it grounds other than those already instituted, that party is not statutorily estopped from raising other invalidity grounds.”¹²⁵ The ruling expressly determined that HP “was not estopped from raising *other invalidity challenges against those claims* [claims 6 and 9 challenged in the IPR] because, as a joining party, HP could not have raised with its joinder any additional invalidity challenges.”¹²⁶

*B. Uniloc 2017 v. Facebook*¹²⁷

In *Uniloc 2017*, Apple filed an IPR challenging claims 1-6 and 8 of the Uniloc patent at issue, but Apple did not challenge claim 7. Facebook then filed its first petition for *inter partes* review challenging claims 1-8 of the Uniloc patent. When the Board instituted the Apple IPR, Facebook filed a second petition challenging claims 1-6 and 8 of the patent on the same grounds raised by Apple, and the Board joined Facebook to the Apple IPR. LG Electronics then filed a petition identical to Facebook’s first petition challenging claims 1-8, and the Board instituted and joined LG to the Facebook IPR.

When the Board issued a final written decision in the Apple IPR (which Facebook had joined) upholding the patentability of claims 1-6 and 8 of the patent, the Board determined that the decision triggered statutory IPR estoppel and precluded Facebook from challenging claims 1-6 and 8, but not claim 7, in the Facebook IPR. The Board also concluded that LG was not estopped from challenging claims 1-8 in the Facebook IPR (which LG had joined). The Board later issued a final written decision in the Facebook IPR finding claims 1-8 unpatentable. Patent owner Uniloc appealed, arguing that Facebook was estopped from challenging claims 1-8 when the Board issued its final written decision upholding the patentability of claims 1-6 and 8 in the Apple IPR, and that LG was estopped as a privy of Facebook because “‘joined parties are privy to a petitioner.’”¹²⁸

The Federal Circuit rejected Uniloc’s estoppel arguments and affirmed the Board. The court determined that Facebook was not estopped from challenging claim 7, because section

¹²⁵ *Id.* at 1027; *see also Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1335 (Fed. Cir. 2020) (section 315(c) “does not authorize the joined party to bring new issues from its new proceeding into the existing proceeding.”).

¹²⁶ *Id.* at 1027 (emphasis added).

¹²⁷ *Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018 (Fed. Cir. 2021) (“*Uniloc 2017*”).

¹²⁸ *Id.* at 1024.

315(e) “explicitly limits the estoppel to the claims previously challenged” when a final written decision is issued.¹²⁹ The court also cited the *Network-1* decision to underscore that a joined party such as Facebook cannot challenge additional claims or raise additional grounds in the IPR proceeding, but made no mention that in *Network-1* the joined petitioner was not estopped from challenging the same claims that had survived IPR in a final written decision, albeit on other grounds.¹³⁰ With regard to LG, the court found insufficient evidence to support Uniloc’s contention that LG was a real party in interest or privy of Facebook or that LG became a “privy” of Facebook merely by joining the Facebook IPR.

C. Takeaways

Network-1 and *Unilock 2017* demonstrate the benefits and pitfalls of joining an instituted IPR proceeding. The primary takeaway is that because a party joining an instituted IPR as a petitioner cannot challenge additional claims or raise additional grounds of challenge, the estoppel effect is limited to only the grounds actually raised against the challenged claims, as long as the joining party is not a real party interest or privy of petitioner. If a joining party loses in an IPR final written decision, that party is “not estopped from raising *other invalidity challenges against those claims* [challenged in the IPR] because, as a joining party, [joined petitioner] could not have raised with its joinder any additional invalidity challenges.”¹³¹ That result may seem incongruous, particularly if one considers that many parties join an IPR after the one-year statutory bar date has passed, without having filed their own IPR petitions. It seems odd that a joined petitioner should be in a better position than the original petitioner, and one wonders whether a different Federal Circuit panel might think so too if it looks at the issue again. But the court’s reasoning in *Network-1* (citing *Facebook v. Windy City*) is arguably consistent with the text of section 315(e), because a joined petitioner could not have raised “any ground” against the challenged claims other than the grounds on which the Board instituted and later addressed in a final written decision.

In the *Uniloc* case, moreover, the Board appears to have incorrectly estopped Facebook from challenging claims 1-6 and 8 in Facebook’s IPR after it lost the Apple IPR as a joined petitioner. The grounds raised in the Facebook IPR were necessarily different from the grounds

¹²⁹ *Id.* at 1030.

¹³⁰ Presumably, Facebook did not raise the issue in a notice of cross-appeal.

¹³¹ *Network-1*, 981 F.3d at 1027 (emphasis added).

raised in the Apple IPR (which Facebook had joined) where the Board upheld patentability of all challenged claims, and the Board subsequently found all challenged claims unpatentable in the Facebook IPR when LG took over as the joined petitioner. But for LG's joinder, Facebook would have had to appeal the Board's estoppel ruling that prevented Facebook from challenging patentability of claims 1-6 and 8 on grounds other than those Facebook raised when it joined the Apple IPR.

The *Uniloc* court's ruling that LG was not an RPI or privy of Facebook explicitly noted the lack of evidence showing any control, cooperation, or financial support as between the two petitioners. Patent owners arguing for reasonably-could-have-raised estoppel of a joined party will need discovery to establish a real party in interest or privity relationship between the two petitioners. Patent Owners will need to make a motion for additional discovery after institution and raise the argument in patent owner's response and/or sur-reply to the petition.

XI. Conclusion

There are many flavors of statutory IPR estoppel to consider, with an overlay of common law issue preclusion, whenever an IPR petition is filed. Petitioners, patent owners, and potential joinder petitioners all face different considerations and tactical choices impacted by estoppel. This article provides a broad update of IPR estoppel issues for all parties to consider in a variety of circumstances.