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The Week at the Boards - January 12, 2018

Related Practices

Intellectual Property
Patent

Massachusetts District Holds That IPR Estoppel Provision Is Limited Only To Grounds That Were Petitioned, Instituted, And Decided In A Final Written Decision

A Massachusetts district court recently held that the IPR estoppel provision of 35 U.S.C. § 315(e)(2) is applicable only to grounds that were petitioned, instituted, and decided in a final written decision by the Patent Trial and Appeal Board (PTAB). Under this holding, additional grounds that were not included in the petition, either intentionally or otherwise, are not within the scope of the estoppel provision. Thus, based at least on this holding, the IPR estoppel provision of 35 U.S.C. § 315(e)(2) does not extend to additional grounds that a petitioner could have reasonably raised at the time of filing the petition (e.g., based on references the petitioner was already aware of or could have been reasonably aware of with a diligent prior art search), but did not end up actually including in the petition, intentionally or otherwise. Previously, the Federal Circuit had commented (in dicta) that the 35 U.S.C. § 315(e)(2) estoppel provision applies only to grounds raised *during* an IPR, and that an IPR does not begin until institution. *See e.g., Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.,* 817 F.3d 1293 (Fed. Cir. 2016). The Massachusetts district court appears to have taken *Shaw* a step further, holding that grounds that were never raised at all in the petition will not be subject to estoppel under 35 U.S.C. § 315(e)(2), regardless of whether they reasonably could have been raised or not at the time of the petition.

A link to the decision is found here.
Additionally, a link to a Michael Best client alert regarding this decision is found here.

Federal Circuit Holds That IPR Time-Bar Rulings Are Subject To Appeal

The Federal Circuit recently held that a time-bar ruling in an IPR is now subject to judicial review, overruling a previous Federal Circuit decision to the contrary. The Federal Circuit

had previously addressed the same issue in *Achates Reference Publishing, Inc. v. Apple Inc.*, 803 F.3d 652 (Fed. Cir. 2015) and expressly held that § 314(d) prohibits the Federal Circuit from reviewing the PTAB's time-bar determinations under 35 U.S.C. § 315(b). In this new decision, however, the Federal Circuit addressed the issue again in wake of the recent Supreme Court case *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131 (2016), which refused to foreclose judicial review of all potential institution-related decisions, and held that the "strong presumption" of favoring judicial review may only be overcome by clear and convincing indications. In its holding, the Federal Circuit noted that "[w]e find no clear and convincing indication in the specific statutory language in the AIA, the specific legislative history of the AIA, or the statutory scheme as a whole that demonstrates Congress's intent to bar judicial review of § 315(b) time-bar determinations."

A link to the decision is found here.
Additionally, a link to a Michael Best client alert regarding this decision is found here.

Board Allows Petitioner To Amend Real Party In Interest Section In IPR Petition

The Board recently granted a petitioner a five day period to amend its real party in interest section in an IPR petition, or in lieu of amending the section, ten days to submit a reply brief to address patent owner's contention that the real party in interest was not properly identified. The Board did not allow the patent owner to file a sur reply. In granting the five day period to correct the real party in interest, the Board noted that its precedential decision in *Lumentum Holdings, Inc. v. Capella Photonics, Inc.* Case IPR2015-00739, slip op. at 5 (PTAB March 4, 2016) (Paper 38) indicates that "a lapse in compliance with…requirements under [under 35 U.S.C. § 312(a), including that all real parties in interest be identified] does not deprive the Board of jurisdiction over the proceeding, or preclude the Board from permitting such lapse to be rectified."

A link to the decision is found here.

Board Estops Petitioner From Relying On Grounds That Reasonably Could Have Been Raised In Other IPR Proceeding

The Board recently estopped a petitioner from relying on grounds that the Board found reasonably could have been raised in another IPR proceeding involving the same petitioner. The petitioner, Apple, had filed a first IPR petition attacking the validity of U.S. Patent No. 8,966,144, and had relied on a particular prior art reference for its grounds of invalidity. Three months later, the petitioner filed two other IPR petitions against the same patent, as well as corresponding motions for joinder ("Joinder petitions"). The Board granted the motions for joinder, and Apple was added as a petitioner to the two other proceedings. However, the petitions filed by Apple in the joinder matters did not include the same prior art reference. The Board eventually issued final written decisions in the joined IPR matters. The Board in the original petition filed by Apple then noted that by virtue of being joined to the other IPR matters, Apple was a petitioner that had obtained a final written decision on all of the challenged claims of the 144 Patent. The Board looked to determine whether Apple was now estopped under 35 U.S.C. §315(e)(1) from maintaining its proceeding. The Board found that under 35 U.S.C. §315(e)(1), Apple was, in fact, estopped from now relying on the prior art reference because that reference could have been raised, but was not, in the joinder proceedings where a final written decision had already been issued.

A link to the decision is found here.

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