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Update on IPR Estoppel

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No estoppel if IPR not instituted. A recent district court case confirms that IPR estoppel does not apply to IPR petitions that are not instituted. See *inMusic Brands, Inc. v. Roland Corporation*, 1-17-cv-00010 (DRI Jun. 14, 2022) (Lincoln D. Almond). This follows on the heels of the following CAFC decisions mentioned in past posts.

Estoppel applies to grounds not in IPR petition. Estoppel applies for all grounds not in petition for claims challenged in a petition. See *California Institute of Technology v. Broadcom Limited, et al.,* 20-2222, Feb. 4, 2022 and Feb. 22, 2022 errata sheet.

Estoppel does not apply to claims not challenged. The CAFC held that estoppel arising on a final written decision in two simultaneously filed IPRs required dismissal of a third simultaneously filed IPR ***which asserted different grounds against the same claims.*** The court noted that petitioner could have filed multiple petitions addressing different subsets of the claims, as opposed to different subsets of the grounds. In so doing, the court indicated that IPR estoppel "applies on a claim-by-claim basis." *Intuitive Surgical v. Ethicon*, 2022 WL 414252, Feb. 11, 2022.