

Insights: Alerts

Consider Estoppel Before Proceeding on Newly-Instituted Grounds Post-SAS

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In *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018), the Supreme Court held that an IPR final written decision must address every challenged claim. The PTAB responded by issuing amended Institution Decisions, adding all non-instituted grounds to pending proceedings. See, e.g., *Unified Patents, Inc. v. Collision Avoidance Technologies, Inc.*, Case IPR2017-01355 (PTAB) (Paper 18). In some instances, the parties may wish to proceed without these new grounds. For example, estoppel prevents a Petitioner from asserting invalidity in district court based on any ground that was raised or could have raised during the IPR. 35 U.S.C. § 315(e). Before SAS, if the PTAB denied institution on a ground, no estoppel attached. Now estoppel may apply to all grounds, even if initially denied. Also, Patent Owner may wish to expedite the proceeding, and the newly-instituted grounds may cause the schedule to be extended.

The parties have at least three options to limit the grounds considered. First, Petitioner may request withdrawal of newly-instituted grounds; however, doing so with the stated goal of avoiding estoppel will likely result in denial. See *Dish Network Corp. v. Customedia Technologies, Inc.*, Case CBM2017-00019 (PTAB) (Paper 50) (denying Petitioner's motion as the PTAB was "unpersuaded that avoiding estoppel" was a good cause for withdrawal). Second, the parties may file a Joint Motion to limit the proceeding to specific grounds. Such motions have been granted in the interest of "resolving [the] proceedings in a just, speedy, and inexpensive manner." See, e.g., *Unified Patents, Inc. v. Collision Avoidance Technologies, Inc.*, Case IPR2017-01355 (PTAB) (Paper 22). However, this strategy may not affect estoppel. Finally, Petitioner can request adverse judgement as to the previously-denied grounds. See, e.g., *1964 Ears, LLC v. Jerry Harvey Audio Holding, LLC*, Case IPR2017-01084 (PTAB) (Paper 50). Depending on the nature of the adverse judgement, the newly-instituted grounds may not be subject to estoppel, e.g., requesting adverse judgment as to the availability of prior art in an IPR. Petitioners wishing to limit newly-instituted grounds post-SAS must consider the estoppel effects when determining how to proceed.

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