

Insights: Alerts

PTAB Posts Two Representative/Informative Decisions re Estoppel Scope & Discovery

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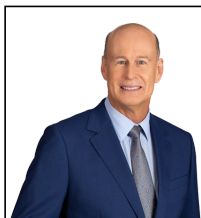
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On July 17, the PTAB posted two representative/informative opinions on its website. One dealt with the scope of estoppel, and the other with discovery requests.

Westlake Services LLC v. Credit Acceptance Corp. (IPR2014-00176) was designated representative (non-binding example) regarding estoppel. The PTAB held that estoppel only applies where there was a final written decision in an earlier review, and does not apply to claims on which review was not instituted. There has been an increase in follow-on petitions on the same patents/claims, and the PTAB makes it clear that such petitions face significant hurdles. The PTAB has the discretion to deny petitions that raise "the same or substantially the same prior art or arguments" that were previously presented in an earlier IPR. The PTAB in *Westlake* pointed out that two U.S. Supreme Court decisions and a CAFC decision (*Alice & Ultramercial*) issued between the first and second petitions, vacating a key precedent relied on in the earlier IPR.

Arris Group Inc. v. C-Cation Technologies LLC (IPR2015-00635) was designated informative (non-binding guidance on rules and practice). Arris "provides guidance on the types of reasonable and narrowly tailored requests for additional discovery concerning privity and real party-in-interest issues that the board frequently grants." Discovery on privity, in particular on indemnification agreements, was allowed. The discovery was not prevented by a similar request in an earlier IPR on different claims, where the earlier IPR was later terminated at C-Cation's request for adverse judgment on the claim at issue. The decision shows that, for non-routine discovery, a strong case must be made that the documents will be useful to the outcome of the case.

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