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The Latest on Petitioner Estoppel

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CalTech v. Broadcom. You may have read multiple articles about how the Feb. 4, 2022 precedential opinion of the CAFC in *California Institute of Technology v. Broadcom Limited, et al.*, 20-2222 ("CalTech v. Broadcom") widened IPR estoppel to apply to "all claims and grounds not in the IPR but which reasonably could have been included." The breadth of the opinion indicated that petitioner estoppel would apply even to claims ***not*** challenged if they "reasonably could have been" challenged in the petition. This precipitated a number of articles about possibly changing IPR strategy, making IPRs less attractive, since estoppel would apply to claims not in the IPR. However, on Feb. 22, 2022 the CAFC issued an errata sheet changing that language to "all grounds not stated in the petition but which reasonably could have been asserted against the claims included." Thus, the errata sheet clarified that estoppel is not created for claims not challenged in the petition. Also, the errata sheet indicated that "This order is nonprecedential." Thus, the errata change does not alter the decision that estoppel applies to all *grounds* that could have been raised against the challenged claims, thus providing motivation to include additional grounds where possible.

Intuitive Surgical v. Ethicon. In a Feb. 11, 2022 decision in *Intuitive Surgical v. Ethicon*, 2022 WL 414252, the CAFC indicated that multiple petitions challenging different claims is permissible since estoppel is on a claim by claim basis. The CAFC affirmed a PTAB decision holding that Section 315(e)(1) 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 petitioner had argued that not all grounds could be asserted based on the word count limit. The court disagreed, noting that petitioner could have avoided the problem by filing 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," ***implying that the estoppel does not extend to non-petitioned claims***.

Practice Tip: It is always best to file a single petition against a single patent. But if you find that you are unable to do so, and you are having trouble including all of your arguments in a single petition, consider presenting the arguments in multiple petitions—but be sure that you are challenging different claims in each petition.