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Recent Rulings on IPR Estoppel

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First, a bit of background. Inter-Partes Review (IPR) estoppel applies to "any ground that the petitioner raised or reasonably could have raised during that inter partes review." 35 U.S.C. § 315(e). In 2018, The *Shaw* decision (Shaw Industries Group, Inc. v. Automated Creel Systems, Inc., 817 F.3d 1293, 1299-1300 (Fed. Cir. 2016), held estoppel did not apply to the grounds on which review was denied by the Patent Trial and Appeal Board (PTAB). Then the Supreme Court in the 2018 *SAS* decision (*SAS Institute Inc. v. Iancu*, 138 S.Ct. 1348) held the PTAB had to review all challenged claims, or deny review. Thus, any ground raised in an IPR petition can give rise to estoppel. Also, courts have held that even grounds not raised, but that could have been raised, are estopped (*See, e.g., Wi-LAN Inc. v. LG Elecs., Inc.*, 421 F. Supp. 3d 911, 924 (S.D. Cal. 2019)).

In a June decision, a district court held that the identical issue (not claim) must be present for estoppel to apply. (*TQ Delta LLC v. 2Wire Inc.*, No. 1:13-cv-01835-RGA, ECF No. 1571 (D. Del. June 29, 2021)). In *TQ Delta*, a different, but similar claim was presented in District Court compared to the claim challenged in the IPR. The TQ Delta court held that the asserted claims thus presented different validity issues compared to the claim in the IPR, and thus there was no collateral estoppel. The court noted that the claim upheld in the IPR was a system claim, with both a transmitter and receiver. The claims in litigation were transmitter claims (with some other differences). The court found that the differences in the claims raised different validity issues. For example, the claim held valid in the IPR required combining references to attack validity, since it was a system claim, while the claims in litigation could be attacked without such a combination. If you want to compare them, the claim upheld in the IPR was claim 15 of US Pat. 8,718,158. The two claims in litigation were claim 14 of US Pat. 8,090,008 and claim 14 of US Pat. 8,073,041.

In July, an order was issued denying summary judgment in the Eastern District of Texas (*General Access Solutions, Ltd. v. Virgin Mobile USA, L.P.* et al, 2-20-cv-00007 (EDTX 2021-07-21, Order) (Robert W. Schroeder, III)). The summary judgment motion argued invalidity of dependent claims based on the prior art in a related IPR and a prior art system that the IPR petitioner was aware of. However, the court pointed out that IPRs are limited to patents and printed publication. The new prior art could not have been raised in the IPR since "prior art systems cannot be raised during IPR proceedings. The court's reference to "systems" means an actual physical product, as opposed to a printed publication.

Note that physical product evidence can be used in a Post Grant Review (PGR), and thus the scope of estoppel is much broader. This may be one factor in why few PGRs are filed (recently about 86 PGRs per year, compared to 1464 IPRs per year).