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# The Scope of PGR Estoppel

by John C. Alemanni

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In one of the first decisions to address the scope of post-grant review ("PGR") estoppel under 35 U.S.C. §325(e)(2), the Eastern District of Texas recently found that the statute means what it says. *GREE, Inc. V. Supercell Oy*, Case No. 2:19-cv-00071, Dkt. No. 81 (EDTX Oct. 30, 2019)[1]. Namely, "§ 325(e) estops grounds that were actually raised in PGR as well as any grounds that could have reasonably been raised during PGR."

The question arose in the context of a motion to strike the defendant's affirmative defense of invalidity as statutorily estopped based on a final written decision in a PGR proceeding. The defendant had challenged the asserted patent with a PGR but asserted invalidity only based on ineligibility under §101. The PTAB issued a final written decision in the PGR, finding that some of the claims were not shown to be unpatentable. In its answer, which was filed after the PTAB issued the final written decision, the defendant raised the affirmative defense of invalidity. The plaintiff moved to strike.

The court denied the motion to strike. However, in so doing, the court stated that the defendant is estopped under §325 from raising challenges under §§112, 102 or 103, including relying on prior art references, the plaintiff either used or reasonably could have used during the PGR proceeding. And further, a question of facts exists as to whether a diligent, skilled searcher would have found any of the prior art the defendant wished to assert. Thus, the defendant could rely only on prior art that could not have reasonably been located when the PGR petition was filed. And the question under the reasonable searcher standard may be addressed at summary judgment if contested. This decision stresses the importance of considering the scope and effect of estoppel when deciding whether to file IPR or PGR petitions and determining which grounds to include.

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[1]In the interests of full disclosure, we represent the plaintiff in this matter.