

PTAB Confirms (Again) that the AIA’s “Enhanced Estoppel” Provision Applies to Concurrent IPR Proceedings



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In a decision from the Patent Trial and Appeal Board (“the Board”) issued last week, the Board confirmed that the “enhanced estoppel” provision of 35 U.S.C. § 315(e)(1) applies to co-pending *inter partes* review (“IPR”) proceedings when a final written decision issues in a first IPR. The panel flatly rejected a Petitioner’s attempt to apply the Federal Circuit’s decision in *Shaw Indus. Group, Inc. v. Automated Creel Sys., Inc.*, 817 F.3d 1293 (Fed. Cir. 2016) to those circumstances. The Board emphasized that estoppel does not apply only to grounds in a petition that were considered but not instituted—a circumstance that no longer occurs post-*SAS Inst., Inc. v. Iancu*, 138 S.Ct. 1348 (2018)—and concluded that to hold otherwise would incorrectly render superfluous the “reasonably could have raised” language of § 315(e)(1).

The Petitioners filed a total of four petitions requesting *inter partes* review of U.S. Patent No. 9,606,907 (“the ‘907 Patent”). On December 22, 2017, Petitioner filed two petitions based upon the same prior art reference, Ellsberry, which the Board consolidated. Five days later, Petitioners filed two additional petitions based upon a combination of two new references, Halbert and Amidi, which the Board consolidated separately from the Ellsberry petitions. The Petitioners did not seek to consolidate all of the petitions or to coordinate the case schedules. On June 27, 2019, the Board issued a final written decision in the Ellsberry *inter partes* review, concluding that all but two dependent claims of the ‘907 Patent are unpatentable. The patent owner then moved to terminate the Halbert-Amidi *inter partes* review based upon estoppel under 35 U.S.C. § 315(e)(1).

35 U.S.C. § 315(e)(1) states in pertinent part that:

[t]he petitioner in an *inter partes* review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that *inter partes* review.

The Board answered the question whether the later-filed (and still pending) grounds based upon the combination of Halbert and Amidi “reasonably could have [been] raised” during the Ellsberry IPR: yes.

Petitioners argued that, based upon the reasoning in *Shaw*, the phrase “during that *inter partes* review” refers only to grounds actually raised during the prior completed proceedings. The Board rejected this argument as counter to Congress’ inclusion of the words “or reasonably could have raised” after “raised,” and concluded that such an interpretation would effectively render 35 U.S.C. § 315(e)(1) meaningless. Moreover, following the Supreme Court’s decision in *SAS*, the “factual situation underlying the holding in *Shaw*—i.e., some but not all grounds being instituted—likely will not arise in *inter partes* reviews post-*SAS*[.]” Instead, the Board restated the accepted notion that “reasonably could have been raised” encompasses prior art other than the prior art instituted if a “skilled searcher conducting a diligent search reasonably could have been expected to discover” that prior art. The Board also rejected Petitioners’ argument that they could not have raised the precluded grounds because of, among other things, the page limit on petitions, noting that had the Petitioners filed the IPRs on the same day estoppel would not have applied. It is therefore not relevant whether Petitioner could have fit all the asserted grounds in one petition, as long as the grounds could have been raised in one or more additional petitions filed on the same day.

For these reasons, the Board terminated the Halbert-Amidi proceeding on a discretionary basis mere days before the final written decision was due. This is an important reminder that Petitioners need to be mindful of this potential result when filing serial IPR petitions for strategic purposes. As the Board stated, where “a petitioner makes an affirmative choice to avail itself of *inter partes* review only on certain grounds,” that choice “comes with consequences”—here in the form of section 315(e)(1) estoppel.

Reserved.

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