

McCombs and Bowser in Westlaw Today: Federal Circuit Limits IPR Estoppel for Ongoing Reexaminations

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PRACTICES Patent Litigation, Patent Office Trials, Patents, Patent Prosecution and Counseling

Haynes Boone Partners [David McCombs](#) and [Jonathan Bowser](#) authored an article for *Westlaw Today* examining a recent Federal Circuit decision, holding that IPR estoppel does not apply to ongoing ex parte reexamination proceedings.

Read an excerpt below.

Patent Trial and Appeal Board (PTAB) post-grant validity challenges, for example, inter partes review (IPR), are frequent components of a patent litigation strategy for defendants. Challenging a patent in IPR does not come without risk, however.

There is a tradeoff to filing an IPR petition. An IPR petitioner is subject to estoppel if the Patent Trial and Appeal Board (PTAB) institutes trial for the petitioner's challenge and then, ultimately, upholds the validity of the challenged claims in a final written decision at the conclusion of the IPR trial. IPR estoppel attaches at the time the PTAB issues a final written decision in the IPR.

If IPR estoppel applies, an unsuccessful petitioner may not "request or maintain" an invalidity challenge in a proceeding before the Patent Office. 35 U.S.C. § 315(e)(1). Similarly, if IPR estoppel applies, an unsuccessful petitioner may not assert an invalidity challenge in district court or the International Trade Commission. IPR estoppel applies to any ground that the petitioner raised or reasonably could have raised during the IPR. 35 U.S.C. § 315(e)(1)-(2). IPR estoppel may also extend to related parties of the petitioner.

The U.S. Court of Appeals for the Federal Circuit has issued several decisions in recent years clarifying the scope of IPR estoppel. For example, in *California Institute of Technology v. Broadcom Ltd.*, the Federal Circuit found that IPR estoppel extends to any invalidity ground that a petitioner did not raise in its petition but reasonably could have. (25 F.4th 976, 991 (Fed. Cir. 2022)). In *Ironburg Inventions Ltd. v. Valve Corp.*, the Federal Circuit adopted a "skilled searcher" standard for evaluating whether a non-petitioned ground reasonably could have been raised in an IPR petition. (64 F.4th 1274, 1297-98 (Fed. Cir. 2023)).

Under the skilled searcher standard, IPR estoppel applies after a final written decision to invalidity grounds that "a skilled searcher conducting a diligent search reasonably could have been expected to discover, as these are grounds that the petitioner reasonably could have raised in its petition."

To read the full article in *Westlaw Today*, click [here](#).