David L. McCombs, Theo Foster, Eugene Goryunov, Scott Jarratt, Calmann Clements in The Patent Lawyer: 'Good for the Gander: Patent Owners Face IPR Estoppel, Too'

October 2, 2020 David McCombs, Theodore Foster, Scott Jarratt, Calmann Clements

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Most patent litigators are familiar with the *inter partes* review estoppel that bars a petitioner from relitigating its validity challenge after the Patent Trial and Appeal Board (PTAB) issues a Final Written Decision. But a lesser-known estoppel provision exists and prohibits a patent owner from "taking action inconsistent with" an adverse judgment, including pursuing before the Patent Office a "claim that is not patentably distinct from a finally refused or canceled claim." The patent owner estoppel rule has gotten little attention, so this article will explore what qualifies as a triggering "adverse judgment" and what the rule prohibits a Patent Owner from doing.

Disclaimer may trigger adverse judgment and patent owner estoppel

Patent Owners at times make the strategic decision to disclaim all or some of the challenged claims to avoid institution or otherwise terminate an IPR trial. Such disclaimer may be construed as a request for adverse judgement. One of the "[a]ctions construed to be a request for adverse judgment" is the "disclaimer of a claim such that the party has no remaining claim in the trial."

Previously, different panels at the PTAB had reached different conclusions as to the PTAB's authority to enter adverse judgment prior to institution. This split was resolved, however, when the Federal Circuit confirmed that the PTAB may enter adverse judgment before institution.

Excerpted from *The Patent Lawyer*. To read the full article, click here.