McCombs, Goryunov and Erickson: IPR Estoppel and Products? A Question That's Splitting Hairs and Courts

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Haynes Boone Lawyers David McCombs, Eugene Goryunov and Adam Erickson authored an article in *The Patent Lawyer* discussing the distinction between raising a patent and raising the identical product as grounds for invalidity after a recent ruling that provoked divided opinions.

Read an excerpt below:

IPR petitioners can rely on only two types of prior art: "patents and printed publications." 35 U.S.C. § 311(b). As an example, if an IPR petitioner wanted to use a telephone as prior art in an IPR petition, they would have to use US Patent No. 174,465, "Improvement in Telegraphy," as grounds for unpatentability, not the telephone device itself.

For most petitioners, this isn't a problem. But it does present a unique question regarding IPR estoppel. If our example telephone petitioner loses the IPR – meaning the PTAB, in a final written decision, finds the challenged claims not unpatentable – can that petitioner continue to argue the invalidity of the claims based on the *product* (i.e., the telephone itself), *not the patent*?

At first glance, you might think that question is splitting hairs. But, while the distinction between raising a patent and raising the identical product as grounds for invalidity is certainly narrow, it's actually splitting courts.

The Reasoning
35 U.S.C. § 315(e)(2) provides that, if a challenged claim is found not unpatentable in a final written decision, that IPR petitioner "may not assert…that the claim is invalid on any ground that the petitioner *raised or reasonably could have raised* during that *inter partes* review."

Everyone agrees that once our example telephone petitioner raises the telephone patent in an IPR and loses, they are unlikely to be able to raise it again. But everyone also agrees that our telephone petitioner did not raise *the telephone itself* in the IPR and *could not have reasonably raised it* either because they were statutorily prohibited from doing so. As a result, a majority of district courts have held that IPR estoppel does not apply to the product itself, even if it's identical (sometimes referred to as "cumulative"). Some courts have adopted the opposite position.

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

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