

David McCombs, Eugene Goryunov, Jonathan Bowser, and Angela Oliver Author Article on Avoiding Non-Party Estoppel

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The America Invents Act (“AIA”) established statutory estoppel provisions that limit when a petitioner in an *inter partes* review (“IPR”) or post-grant review (“PGR”), or the real party in interest (“RPI”) or privy of the petitioner, may pursue another validity challenge before the U.S. Patent and Trademark Office, in district court, or before the U.S. International Trade Commission (“ITC”).

Specifically, where an IPR results in a final written decision from the Patent Trial and Appeal Board (“Board”), the petitioner, RPI, 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.”

Likewise, the petitioner, RPI, or privy of the petitioner may not assert in district court or the ITC that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that IPR. The same estoppel provisions apply for PGRs.

Most disputes regarding the statutory estoppel provisions focus on whether a petitioner “reasonably could have raised” an invalidity ground during an IPR. Important questions also arise, however, where a patent owner asserts that an entity other than the petitioner (i.e., a RPI or privy of the petitioner) should similarly be estopped. In cases where a petitioner and patent owner have litigated the issue of whether another entity is an RPI or privy, where that purported RPI or privy is not already a party to the case, the fairness of applying any finding made in that proceeding to the non-party should be taken into account.

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