

# Under the Same Precedent, Different Estoppel Standards Have Developed in the PTAB and the District Courts

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While Congress was debating the provisions of the America Invents Act (AIA), some lawmakers proposed that *inter partes* review (IPR) and post-grant review (PGR) should be a substitute for invalidity challenges at district court, such that patent challengers would have to choose one forum or the other for available challenges. This mutually exclusive framework was expressed by “could have raised” estoppel language.[1] Under this “could have raised” estoppel scheme, patent challengers would essentially get one chance to raise invalidity contentions before either the Patent Trial and Appeal Board (PTAB) or the district courts. If the challenger was unsuccessful before the PTAB, it would be estopped from raising any prior art challenges at district court that could have been raised before the PTAB.[2]

To address concerns about the scope of such “could have raised” estoppel, Congress ultimately limited estoppel to grounds of challenge “that the petitioner raised or **reasonably** could have raised during [an] *inter partes* review” or post-grant review.[3] During debate in the Senate, Senator Kyl remarked that adding the modifier “reasonably” to the estoppel provisions of the AIA “ensures that could-have-raised estoppel extends **only** to that prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover.”[4]

Estoppel applies, on a claim-by-claim basis, when the PTAB issues a final written decision for a challenged claim. Estoppel prevents the petitioner from raising or maintaining a ground of challenge at the Patent Office, in the district courts, or before the International Trade Commission (ITC) that the petitioner “raised or reasonably could have raised” during an IPR or PGR.[5]

The estoppel provisions of the AIA do not contain an explicit definition of what “reasonably could have raised” means. The PTAB and the district courts have reached different conclusions on what “reasonably could have raised” means. Ironically, the divergence between the PTAB and the district

courts’ interpretation of the scope of estoppel became more pronounced after the Federal Circuit’s decision in *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.* [6] in which the court addressed the scope of estoppel for grounds of challenge that were denied institution by the PTAB.

## **Pre-Shaw PTAB Interpretation of Estoppel Provisions**

In two early IPR decisions on the scope of estoppel, PTAB panels held that the “reasonably could have raised” provision of 35 U.S.C. § 315(e)(1) applies in a follow-on petition when the petitioner relies on prior art that the same petitioner asserted in an earlier-filed petition.

In *Dell Inc. v. Electronics and Telecommunications Research Institute*, a panel of the PTAB held that the petitioner was estopped from asserting an obviousness challenge based on the Mylex and Hathorn references, because the same petitioner received an adverse final written decision in response to an earlier petition in which the petitioner asserted those references.[7] In the earlier petition, the petitioner alleged that the claims are anticipated by the Mylex reference, and that the claims are obvious over the Hathorn reference in view of other references. The PTAB panel held that “the differences in how the references have been asserted in these proceedings have no weight on our determination of whether the grounds raised in the instant Petition could have been raised in the [earlier] IPR.”[8] The PTAB panel concluded that the petitioner could have raised the obviousness challenge in the follow-on IPR petition because the petitioner relied on the same prior art in the earlier IPR petition.[9]

In *Apotex Inc. v. Wyeth LLC*, a PTAB panel similarly held that the petitioner was estopped from raising in a follow-on petition an obviousness ground of challenge (Ground 2) based on several references that the petitioner was aware of and cited in an earlier petition for which the petitioner

received an adverse final written decision.[10] The PTAB panel held that the petitioner was estopped from raising this ground of challenge because it “reasonably could have raised it during [the earlier] proceeding.”[11]

In *Apotex*, the PTAB panel also held that the petitioner was not estopped from asserting another obviousness ground of challenge (Ground 1) because that ground, although presented in the earlier petition, was denied institution as being “redundant” to the instituted grounds of challenge. The PTAB panel reasoned that the estoppel provisions of 35 U.S.C. § 315(e)(1) apply only to grounds that petitioner “raised or reasonably could have raised during [the] *inter partes* review.”[12] Thus, the panel explained that if a ground of challenge is denied institution, then that ground is not raised during the IPR, and it cannot be one that “reasonably could have been raised during” the IPR. The panel held that, once a ground is denied, the PTAB’s decision on institution prevents the petitioner from raising that ground during the trial.[13]

### **Pre-Shaw District Court Interpretation of Estoppel Provisions**

In *Clearlamp, LLC v. LKQ Corp.*, the court relied on Senator Kyl’s statement about the scope of “reasonably could have raised” estoppel, noting that the Federal Circuit “has yet to define its scope.”[14] Citing Senator Kyl’s statement, the court interpreted 35 U.S.C. § 315(e)(2) as requiring that “an *inter partes* review petitioner is estopped from relying on any ground that could have been raised based on prior art that could have been found by a skilled searcher’s diligent search.”[15] In this case, the accused infringer (LKQ) attempted to rely on a prior art datasheet that was not presented in the counterpart IPR proceeding. The court indicated that “[i]n accordance with the § 315(e)(2) standard, the datasheet can be used in civil litigation only if it could not have been found by a skilled searcher performing a diligent search.”[16] However, the court allowed LKQ to rely on the datasheet in the district court litigation because the plaintiff (Clearlamp), as the proponent of the estoppel argument, did not meet its burden in demonstrating that a “skilled searcher’s diligent searcher would have found the... datasheet.”[17]

In *Clearlamp*, the court also appeared to be persuaded by the datasheet containing non-cumulative information that was not previously considered by the PTAB during the IPR. The court explained that if Clearlamp’s diligent search had uncovered cumulative pieces of prior art that contained the information of the datasheet, then “LKQ should be estopped from using prior art that was not reasonably available during

*inter partes* review if prior art that was reasonably available allowed for the same argument for invalidity.”[18] However, since the court determined that the datasheet contained non-cumulative information, the court held that the possibility of estoppel from cumulative information did not apply.

### **The Federal Circuit’s Treatment of Estoppel**

In *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, the Federal Circuit held that an IPR petitioner (*Shaw*) was not estopped from raising noninstituted grounds of challenge in either a later IPR proceeding or at the district court.[19] In the underlying IPRs that were consolidated on appeal, the PTAB denied institution for a ground of challenge as being “redundant” to grounds of challenge that the PTAB instituted for trial. On appeal, *Shaw* petitioned for a writ of mandamus to compel the PTAB to reevaluate the noninstituted ground because it may be estopped from raising the noninstituted ground. The Federal Circuit held that mandamus relief was not appropriate because the court was barred from reviewing the institution decisions under 35 U.S.C. § 314(d).[20]

Nevertheless, the court assured *Shaw* that it would not be estopped from pursuing the noninstituted ground. The court explained that “[b]oth parts of § 315(e) create estoppel ‘on any ground that the petitioner raised or reasonably could have raised *during* that *inter partes* review,’” and that an “IPR does not begin until it is instituted.”[21] Using this statutory interpretation, the Federal Circuit explained that *Shaw* could “not raise—nor could it have reasonably raised—the [noninstituted] ground *during* the IPR.”[22] Accordingly, the Federal Circuit held that *Shaw* was not estopped from raising the noninstituted ground because it could not have raised the noninstituted ground during the IPR, which begins at institution. The Federal Circuit’s holding in *Shaw* is consistent with the PTAB’s rationale in *Apotex* for grounds of challenge that were denied institution.

In *HP Inc. v. MPHJ Technology Investments, LLC*,[23] the Federal Circuit followed the post-institution estoppel rationale of *Shaw* and held that a petitioner is not estopped from raising grounds of challenge that were presented in an IPR petition but were denied institution. In *HP*, the Federal Circuit explained that “the noninstituted grounds do not become a part of the IPR. Accordingly, the noninstituted grounds were not raised and, as review was denied, could not be raised in the IPR.”[24]

Thus, the Federal Circuit has consistently held the estoppel does not apply to grounds of challenge that are presented in an IPR petition but are denied institution. Nevertheless, there

is an emerging divide between the PTAB and the district courts over what grounds of challenge should be estopped if they “reasonably could have [been] raised” in an IPR trial before the PTAB. The divergence between the PTAB and the district courts is largely predicated on how each forum’s judges have interpreted—albeit inconsistently—the Federal Circuit’s guidance on the scope of estoppel in *Shaw*. As discussed below, this divergence began to develop after *Shaw*. The PTAB and the district courts also differ on which party has the burden of proof in demonstrating whether the IPR petitioner should be estopped from raising grounds of challenge that it reasonably could have presented in an earlier IPR proceeding.

### **Post-*Shaw* PTAB Interpretation of “Reasonably Could Have Raised” Estoppel**

Generally, PTAB panels have broadly interpreted the “reasonably could have raised” estoppel provision of § 315(e) (1), as demonstrated by the following decisions.

In *Ford Motor Co. v. Paice LLC*, a PTAB panel held that the petitioner was estopped from maintaining a challenge for a claim in a subsequent IPR proceeding after the petitioner received a final written decision with respect to that claim in an earlier IPR proceeding.[25] The panel determined that the petitioner could not maintain its challenge of the claim because the prior art newly asserted in the second petition was cited during prosecution of the challenged patent and is listed on the face of the patent.[26] The panel therefore determined that estoppel applies because the petitioner reasonably could have raised that challenge in the earlier petition.

In *Praxair Distribution Inc. v. Ino Therapeutics LLC*, a PTAB panel denied institution of a second petition filed against the challenged patent because the petitioner had received a final written decision addressing all the claims of the patent in response to a first petition filed by the same petitioner.[27] In the second petition, the petitioner newly relied on two textbooks as prior art, and argued that it was not aware of the newly asserted references despite conducting diligent searches of the prior art.[28] The panel determined that the petitioner did not “demonstrate[] that a skilled searcher conducting a diligent search would not have expected to discover [the textbooks].”[29] Importantly, the panel emphasized that it was the **petitioner’s burden** to demonstrate that it reasonably could **not** have presented the new textbook-based grounds of challenge in the first petition. Finding that the petitioner did not meet its burden, the panel held that the petitioner reasonably could have raised the

textbook-based grounds of challenge in the first petition and was therefore estopped from bringing those grounds in the second petition.[30]

The panel in *Praxair* noted that the petitioner’s assertion of a diligent search was predicated on a single search report by an unidentified searcher identifying a mere fifteen “exemplary” search results.[31] Further, the panel noted that the petitioner did not identify the searcher’s skill level and experience in the field, or the search parameters used during the search.[32] It appears that the petitioner’s characterization of the textbooks worked against the petitioner. The petitioner and its expert characterized one of the textbook authors as being a “thought leader” in the field, and argued that both textbooks would be “part of a collected literature” regarding the technical focus of the patent.[33] These factors contributed to the panel determining that the petitioner reasonably could have raised the textbook-based challenges in the earlier petition.

In *Kofax, Inc. v. Uniloc USA, Inc.*,[34] a PTAB panel terminated a later-filed IPR proceeding on the basis that the petitioner was estopped from maintaining the later IPR proceeding after receiving an adverse final written decision in an earlier IPR proceeding.[35] The PTAB panel determined that the petitioner reasonably could have raised the grounds of challenge in the later proceeding because identical grounds were presented in another petition that was filed earlier against the same patent. The petitioner filed (1) a first IPR petition with a first prior art challenge, and (2) a CBM petition with a second prior art challenge on the same day. The first IPR petition was granted. Institution was denied for the CBM petition (patent not CBM-eligible). The petitioner then filed a second IPR petition with the second prior art challenge that was previously presented in the CBM petition. The petitioner argued that it was “not reasonable” to raise the same grounds of challenge in two different proceedings at the same time.[36] The PTAB panel disagreed, holding that the petitioner could have filed a second IPR petition within one month of institution of the first IPR proceeding to join the first IPR proceeding under § 315(c).[37] The panel indicated that the petitioner was aware of the references asserted in the second IPR petition because the petitioner asserted them in the non-instituted CBM petition.[38] Therefore, the PTAB panel held that the petitioner “reasonably could have raised” the second prior art challenge at the time of filing the first IPR petition and was estopped from raising the second prior art challenge after receiving an adverse final written decision in the first IPR proceeding.[39]

## Post-Shaw District Court Interpretation of “Reasonably Could Have Raised” Estoppel

After *Shaw*, district courts have narrowly interpreted the estoppel provisions to be generally limited to only those claims and instituted grounds of challenge that were addressed by the PTAB in a final written decision.

In *Intellectual Ventures I v. Toshiba Corp.* (“IV”), the court held that the IPR petitioner (Toshiba) was estopped from asserting one obviousness challenge (the Ogawa combination) that was actually raised in the counterpart IPR, but was not estopped from asserting another obviousness challenge (the Fuse combination) that was not raised during the IPR despite being based on publicly-available prior art.[40] The court explained that “[a]lthough IV’s argument in this regard is perfectly plausible, in the sense that Toshiba certainly could have raised these additional obviousness grounds based on public documents at the outset of their IPR petition, the Federal Circuit has construed the [language of § 315(e)(2)] quite literally.”[41] The court indicated that it was constrained by the reasoning in *Shaw*, noting that the Federal Circuit “determined in *Shaw* that, because the PTAB rejected a certain invalidity ground proposed by the IPR petitioner, no IPR was instituted on that ground and, therefore, petitioner ‘did not raise—nor could it have raised—the [rejected] ground **during** the IPR.’”[42]

Nevertheless, the court expressed reservation about its ruling, explaining that “[a]lthough extending [*Shaw*’s] logic to prior art references that were never presented to the PTAB at all (despite their public nature) confounds the very purpose of this parallel administrative proceeding, the court cannot divine a reasoned way around the Federal Circuit’s interpretation in *Shaw*.”[43] In response to a reconsideration motion, the court explained that it was compelled to maintain its decision, explaining that “since it is not my place to make policy decisions, I am not inclined to change my original decision, with the hopes that an appeal may clarify the issue for future judges in future cases.”[44]

In *Verinata Health, Inc. v. Ariosa Diagnostics, Inc.*, the court interpreted the holding in *Shaw* as “plainly stating that only arguments raised or that reasonably could have been raised during IPR are subject to estoppel.”[45] In the counterpart IPRs, Ariosa asserted multiple grounds of challenge:

- (1) obviousness over the Dhallan and Binladen references;
- (2) over the Quake and Craig references; and
- (3) obviousness over the Shoemaker, Dhallan, and Binladen references.

The PTAB instituted challenge (3), denied institution for challenge (1) as being “redundant,” and denied institution for challenge (2). After a remand from the Federal Circuit, the PTAB determined in a second final written decision that Ariosa had not demonstrated that the claims are unpatentable on the basis of challenge (3).[46] Ariosa conceded that it was estopped from raising challenge (3) in the district court.

Following the rationale in *Shaw*, the court held that Ariosa was not estopped from raising challenge (2) in the district court, because the PTAB did not institute this challenge.[47] However, the court held that Ariosa was estopped from raising challenge (1) in the district court, even though the PTAB denied institution for this challenge. The court explained that “defendants raised, or could have raised, these grounds in the IPR proceedings, as the combination of Dhallan and Binladen is **simply a subset of the instituted grounds**,”[48] i.e., Shoemaker, Dhallan and Binladen. The court’s estoppel of challenge (1) in *Verinata* appears to be inconsistent with the Federal Circuit’s decisions in *Shaw* and *HP*, since challenge (1) was denied institution.

There likely will be more developments in the *Verinata* estoppel dispute. On January 27, 2017, *Verinata Health* filed a Petition for a Writ of Mandamus with the Federal Circuit requesting the Federal Circuit to direct the district court to preclude Ariosa from asserting any ground of challenge that it reasonably could have raised in the IPR, including non-instituted grounds of challenge that the PTAB “substantively addressed” when it denied institution for those grounds.[49] In essence, *Verinata Health* argued that the district court’s interpretation of *Shaw* of precluding estoppel from applying to noninstituted grounds erroneously renders the phrase “reasonably could have raised” in § 315(e)(2) meaningless, since only instituted challenges can be raised *during* an IPR.[50]

In *Illumina, Inc. v. Qiagen, N.V.*, the court followed the rationale of *Shaw* and held that the defendant was not estopped from raising an obviousness challenge at the district court that it had presented in an IPR petition because the PTAB denied institution for that obviousness challenge on the basis that it was “redundant” to the instituted grounds.[51]

Similarly, in *Princeton Digital Image Corp. v. Konami Digital Entertainment Inc.*, the court held that the defendant was not estopped from challenging the patentability of three claims that the PTAB did not address in a final written decision.[52] The defendant challenged the patentability of those claims

in an IPR, but the PTAB denied institution of review for those claims. Therefore, the court held that the defendant was not estopped from challenging those claims under § 315(e)(2). [53]

In *Depomed, Inc. v. Purdue Pharma L.P.*, the court held that the defendant (Purdue) was not estopped from pursuing an obviousness challenge of claims 11 and 12 because those claims were not addressed in the PTAB's final written decisions. Purdue challenged claims 11 and 12 in two of three IPR petitions filed against the asserted patents, but the PTAB denied institution for those claims. In the final written decisions, the PTAB determined that all challenged claims are not unpatentable. Relying on *Shaw*, the court held that Purdue was not estopped from pursuing its obviousness challenge to claims 11 and 12.[54] In addition, the court held that Purdue was not estopped from pursuing on-sale bar and § 102(g) defenses against claims that were addressed in the PTAB's final written decisions, since Purdue could not pursue those challenges in an IPR.[55]

In *Precision Fabrics Group, Inc. v. TieTex International, Ltd.*, the court held that Tietex was not estopped from raising a ground of challenge that was denied institution by the PTAB, and was not estopped from raising an additional ground of challenge that was not presented to the PTAB.[56] However, the defendant was effectively estopped from challenging the validity of the patent, because the court granted plaintiff's motion for summary judgement of non-invalidity. While acknowledging that estoppel under §315(e)(2) did not apply, the court found that "the PTAB's refusal to institute *inter partes* review is indicative of the weakness of TieTex's claim of invalidity..., as the PTAB will not authorize an *inter partes* review unless 'there is a reasonable likelihood 'that a petitioner would prevail in proving invalidity.'"[57]

As evidenced by the post-*Shaw* decisions discussed above, district courts have generally taken a narrow view of estoppel and have limited estoppel to only those grounds of challenge that were addressed by the PTAB in final written decisions. The notable exception was in *Verinata* where the defendant was estopped from raising a challenge that was denied institution by the PTAB as being "redundant." Unlike the PTAB, district courts have been reluctant to address whether estoppel applies to grounds of challenge based on publicly available prior art that IPR petitioners reasonably could have raised in an IPR but did not.

### **Post-IV PTAB Interpretation of "Reasonably Could Have Raised" Estoppel**

In *Great West Casualty Co. v. Intellectual Ventures II LLC*, a PTAB panel took the opposite approach of the district courts in finding that the petitioner was estopped from raising a ground of challenge that it did not present before on the basis that it "reasonably could have raised" that ground in a prior IPR proceeding, and even went so far as to criticize the reasoning in *IV* and *Verinata*. [58] In this proceeding, the panel was considering the petitioner's fifth IPR petition against the challenged patent. The Board had instituted two of the prior IPR petitions, and denied the other two.[59] The dispute in this proceeding was whether the petitioner reasonably could have raised the Robinson reference in combination with other references that the petitioner had previously asserted. The Robinson reference, a printed publication, was not at issue in the prior completed IPR proceedings.[60]

The PTAB panel disagreed with the reasoning in *IV* and *Verinata* and held that it was "unpersuaded that the words 'reasonably could have raised during that *inter partes* review' from Section 315(e)(1) should be interpreted as limited to grounds actually raised during the prior completed proceedings." [61] The panel explained that "Congress would not have included the additional words 'or reasonably could have raised' after 'raised' if Congress had desired to limit the estoppel to grounds actually raised." [62] The panel interpreted *Shaw* as being limited to "estoppel does not apply to any ground of unpatentability that was presented in a petition, but denied institution." [63] Further, the panel indicated that there is "a substantive distinction between a ground that a petitioner attempt to raise, but was denied a trial, and a ground that a petitioner could have raised, but elected not to raise in its previous petition or petitions." [64] The panel explained that when a petitioner elects not to raise a ground in a prior petition, "a petitioner makes an affirmative choice to avail itself of *inter partes* review only on certain grounds. That choice, however, comes with consequences, most prominently, that grounds petitioner elects not to raise in its petition for *inter partes* review may be subject to the consequences of Section 315(e)(1)." [65]

In addressing whether the petitioner reasonably could have relied on the Robinson reference earlier, the PTAB panel discounted the petitioner's assertion that it was unaware of the Robinson reference before filing its prior IPR petitions, because "Petitioner did not present search parameters such that we could evaluate the 'reasonableness' of its search." [66] In addition, the panel pointed to evidence

indicating that the petitioner was familiar with web systems under which the reference could be obtained, and that the reference was indexed at the Library of Congress. Based on these factors, the panel concluded that the Robinson reference would have been identified in a diligent search, and held that the petitioner was estopped from bringing the Robinson-based challenge because it reasonably could have raised that challenge in its prior IPR petitions.[67]

## Conclusion

As illustrated by the decisions discussed above, the PTAB and the district courts are generally interpreting the estoppel provisions of the AIA differently. The PTAB's interpretation of the "reasonably could have raised" estoppel provisions of 35 U.S.C. § 315(e)(1) appears to be more in line with the legislative history than the district courts' interpretation of this statutory language. As evidenced by the court's rationale in *IV*, for example, district courts have interpreted the estoppel provisions narrowly based on the Federal Circuit's rationale in *Shaw*. The Federal Circuit has not yet addressed the specific question of whether an IPR or PGR petitioner is estopped from raising grounds of challenge based on publicly available prior art that the petitioner could have raised, but did not raise, in an earlier IPR or PGR proceeding.

Based on the current state of the law, IPR or PGR petitioners should consider presenting multiple grounds of challenge in their petitions under appropriate circumstances. If the PTAB denies some of the grounds of challenge on the merits or pursuant to the PTAB's discretionary authority, the petitioner would not be estopped from raising those grounds again in a follow-up petition or in a district court litigation under *Shaw*. However, this practice is not without its limitations, because presenting multiple grounds of challenge in one petition may dilute the effectiveness of the primary ground of challenge due to petition word count limits, and the PTAB may institute a less favorable ground of challenge instead of a preferred one.

Understandably, patent challengers would prefer a narrow scope of estoppel that is limited to only those grounds of challenge that the petitioner actually raised in an instituted IPR or PGR proceeding. However, if the scope of estoppel becomes too weak, petitioners may be less successful in obtaining stays in corresponding district court litigation. A narrow scope of estoppel may not simplify the issues to be resolved in the district court litigation (i.e., most, if not all, invalidity challenges that reasonably could have been raised in an IPR or PGR). Litigants before the PTAB should also be cognizant of the PTAB's broader interpretation of the estoppel provisions of § 315(e)(1) when the PTAB addresses subsequent petitions.

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[1] "Patent protection will be stronger with the inclusion of 'could have raised' estoppel, strong administrative estoppel, and explicit statutory authority for the Patent and Trademark Office, PTO, to reject petitions by third parties and order joinder of related parties." 157 CONG. REC. S1367 (daily ed. Mar. 8, 2011) (statement of Sen. Kohl). Senator Kyl argued that "[t]his [estoppel] effectively bars a party or his real parties in interest or privies from later using *inter partes* review or ex parte reexamination against the same patent, since the only issues that can be raised in an *inter partes* review or ex parte reexamination are those that could have been raised in [an] earlier post-grant or *inter partes* review." 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).

[2] Senator Grassley argued that "[i]deally extending could-have-raised estoppel to privies will help ensure that if an *inter partes* review is instituted while litigation is pending, that review will completely substitute for at least the patents-and-printed-publications portion of the civil litigation." 157 CONG. REC. S1360-94 (daily ed. Mar. 8, 2011) (statement of Sen. Grassley). 35 U.S.C. § 311(b) limits IPR challenges to only anticipation or obviousness grounds under 35 U.S.C. § 102 or 103 and "only on the basis of prior art consisting of patents or printed

publications." See also *Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1316 ("*inter partes* review cannot replace the district in all instances, for example, when the claims are challenged in district court as invalid based on the on-sale bar, for claiming patent-ineligible subject matter, or on grounds of indefiniteness.")

[3] 35 U.S.C. §§ 315(e) (emphasis added). The same estoppel provisions are contained in 35 U.S.C. § 325(e) for PGRs.

[4] "The present bill also softens the could-have-raised estoppel that is applied by *inter partes* review against subsequent civil litigation by adding the modifier 'reasonably.' It is possible that courts would have read this limitation into current law's estoppel. Current law, however, is also amenable to the interpretation that litigants are estopped from raising any issue that it would have been physically possible to raise in the *inter partes* reexamination, even if only a scorched-earth search around the world would have uncovered the prior art in question. Adding the modifier 'reasonably' ensures that could-have-raised estoppel extends **only to that prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover.**" 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (emphasis added).

- [5] 35 U.S.C. §§ 315(e) and 325(e); *Westlake Services LLC v. Credit Acceptance Corp.*, CBM2014-00176, Paper 28 at 4-5 (PTAB May 14, 2015) (precedential).
- [6] 817 F.3d 1293, 1300 (Fed. Cir. 2016).
- [7] IPR2015-00549, Paper 10 at 4-6 (PTAB Mar. 26, 2015) (representative); IPR2013-00635, Paper 39 (PTAB Feb. 27, 2015) (final written decision in earlier IPR proceeding).
- [8] IPR2015-00549, Paper 10 at 5.
- [9] *Id.* at 6.
- [10] IPR2015-00873, Paper 8 at 6-8 (PTAB Sept. 16, 2015); IPR2014-00115, Paper 94 (PTAB Apr. 20, 2015) (final written decision in earlier IPR proceeding).
- [11] *Id.* at 8.
- [12] *Id.*
- [13] *Id.* at 8-9.
- [14] *Clearlamp, LLC v. LKQ Corp.*, No. 12-C-2533, 2016 WL 4734389, at \*7 (N.D. Ill. Mar. 18, 2016) (Lefkow, DJ).
- [15] *Id.* at \*8.
- [16] *Id.* at \*9.
- [17] *Id.* at \*9 (citing *Kennedy v. U.S.*, 965 F.2d 413, 417 (7th Cir. 1992) (“The burden of proof is on the party claiming estoppel.”)).
- [18] *Id.* at \*9.
- [19] 817 F.3d at 1300.
- [20] *Id.* at 1299-1300.
- [21] *Id.* at 1300 (quoting 35 U.S.C. § 315(e)(1) and (2)).
- [22] *Id.* (emphasis original).
- [23] 817 F. 3d 1339, 1347 (Fed. Cir. 2016).
- [24] *Id.*
- [25] IPR2015-00790, Paper 34 at 7 (PTAB Nov. 4, 2016).
- [26] *Id.*
- [27] IPR2016-00781, Paper 10 at 8-10 (PTAB Aug. 25, 2016).
- [28] *Id.* at 8.
- [29] *Id.* at 10.
- [30] *Id.*
- [31] *Id.* at 9.
- [32] *Id.*
- [33] *Id.* at 9-10.
- [34] IPR2015-01207, Paper 22 at 6-9 (PTAB June 2, 2016).
- [35] *Id.* at 8-9.
- [36] *Id.* at 4.
- [37] *Id.* at 8.
- [38] *Id.*
- [39] *Id.* at 8-9.
- [40] *Intellectual Ventures I LLC v. Toshiba Corp.*, 1-13-cv-00453, 2016 WL 7341713 at \*12-13 (D. Del. Dec. 19, 2016) (Robinson, DJ).
- [41] *Id.* at \*13.
- [42] *Id.* (quoting *Shaw*, 817 F.3d at 1300 (emphasis original)).
- [43] *Id.*
- [44] *Intellectual Ventures I LLC v. Toshiba Corp.*, 1-13-cv-00453, 2017 WL 107980 at \*2 (D. Del. Dec. 19, 2016) (Robinson, DJ).
- [45] *Verinata Health, Inc. v. Ariosa Diagnostics, Inc.*, 12-cv-05501-SI, 2017 WL 235048 at \*3 (N.D. Cal. Jan. 19, 2017) (Illston, DJ).
- [46] *Id.*
- [47] *Id.* at \*4.
- [48] *Id.* (emphasis added).
- [49] *In re Illumina, Inc. and Verinata Health, Inc.*, No. 17-109, Dkt. 2-1 at 18-21 (Fed. Cir. Jan. 27, 2017).
- [50] *Id.* at 17-18.
- [51] *Illumina, Inc. v. Qiagen, N.V.*, 16-2788-WHA, 2016 WL 4719269 at \*6 (N.D. Cal. Sept. 9, 2016) (Alsup, DJ).
- [52] *Princeton Digital Image Corp. v. Konami Digital Entm't*, No. 12-1461-LPS-CJB (slip op. at 8-10) (D. Del. Jan. 19, 2017) (Burke, MJ).
- [53] *Id.*
- [54] *Depomed, Inc. v. Purdue Pharma L.P.*, No. 13-571, Mem. Op. Dkt. 238 at 15-16 (NJD Nov. 4, 2016) (Bongiovanni, MJ).
- [55] *Id.* at 16-17 (citing *Synopsys*, 814 F.3d at 1316).
- [56] *Precision Fabrics Grp., Inc. v. TieTex Int'l*, Nos. 1:13-cv-645/650, 2016 WL 6839394 at \*9 (M.D. N.C. Nov. 21, 2016) (Schroeder, DJ).
- [57] *Id.* (citing 35 U.S.C. § 314(a) and *Husky Injection Molding Sys. Ltd. v. Athena Automation Ltd.*, 838 F.3d 1236, 1246 (Fed. Cir. 2016)).
- [58] IPR2016-01534, Paper 13 at 8-16 (PTAB Feb. 15, 2017).
- [59] *Id.* at 5-6.
- [60] *Id.* at 11.
- [61] *Id.* at 12.
- [62] *Id.*
- [63] *Id.*
- [64] *Id.* at 13.
- [65] *Id.*
- [66] *Id.* at 15.
- [67] *Id.* at 16.