Volume XV, Number 141

THE NATIONAL LAW REVIEW

Advertisement

IPR Estoppel's Evolving Landscape

by: Dana Nguyen of Winstead - *News Alert*

Posted On Monday, February 10, 2025

RELATED PRACTICES & JURISDICTIONS

Intellectual Property

Administrative Regulatory

All Federal

The America Invents Act ("AIA) provided an accused infringer sued for patent infringement ("Patent Challenger") with a new, alternative forum to challenge the patents asserted against them: *inter partes* review ("IPR"). In exchange—and to avoid duplicative parallel district court and Patent Office proceedings—the AIA provided upon a final written decision, the Patent Challenger would be estopped from asserting against any surviving claim an invalidity theory based "on any

Google Exhibit 1090
Google v. Mullen
IPR2025-00365

In 2022, the Patent Office provided guidance encouraging Patent Challengers to embrace the AIA's estoppel provision *upon institution* of an IPR, through use of a so-called *Sotera* stipulations.[2] *Sotera**[3]*** stipulations are used to influence the PTAB's weighing of *Fintiv* factors—which take into account the timing of a parallel court action and potential for duplication as part of the PTAB's analysis of whether to institute an IPR[4] Specifically, a *Sotera* stipulation is intended to address the *Fintiv* factor concerning the "overlap between issues raised in the petition and in the parallel proceeding."[5] In effect, *Sotera* stipulations serve to assure the PTAB that where parallel litigation is likely to be resolved before a final written decision on the IPR would be due, if the PTAB institutes the IPRs, the Patent Challenger will not pursue estopped invalidity theories in the district court as the parallel litigation proceeds. If a *Sotera* stipulation is filed, the PTAB stated that it will not deny institution of an IPR under *Fintiv*.[6] Since then, *Sotera* stipulations have become increasingly commonplace.

As an example, in *Sotera*, the Patent Challenger's stipulation stated:

[I]f the [PTAB] institutes IPR . . . Defendants will not pursue in [the District Court] the specific grounds [asserted in the *inter partes* review] in connection with the referenced patent(s) and claim(s) as originally issued on the instituted [IPR] petition, or on any other ground for a given patent for which the [PTAB] institutes, that was raised or could have been reasonably raised in an IPR. (i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patent or printed publications)."[7]

Sotera stipulations may vary in form to some extent, but inclusion of the statutory "or could have been reasonably raised" language distinguishes a *Sotera* stipulation from other stipulations that the PTAB has accorded less weight.[8]

The scope of "or could have been raised" was subject to much dispute, but the Federal Circuit has clarified that IPR estoppel applies to any grounds a petitioner reasonably could have brought in an IPR.[9] This conclusion was further confirmed

[10]

The court of appeals correctly held that 35 U.S.C. 315(e)(2) bars petitioners from advancing invalidity grounds they knew or should have known about at the time they filed their petitions for *inter partes* review, yet omitted from their petitions.

Thereafter, in apparent agreement, the Supreme Court declined to grant certiorari to review the Federal Circuit's interpretation.

On its face, the AIA's estoppel provision—and *Sotera* stipulations—may seem to provide a broad benefit to a Patent Owner. In practice, however, determining the scope of IPR estoppel to invalidity grounds in litigation can be more complicated than it may seem for a variety of reasons:

- **Burden of Proving IPR Estoppel**. The Federal Circuit has held the burden to show IPR estoppel is on the Patent Owner, as the party asserting the estoppel.[11]
- **Standard**. The Patent Owner must show, by a preponderance of the evidence, that the Patent Challenger actually knew of the reference or if a skilled searcher conducting a diligent search reasonably could have been expected to discover the reference.[12] At least one district court has denied a summary judgment motion to enforce IPR estoppel because questions of fact remained as to whether the printed publication at issue could have been found by a skilled searcher.[13]
- **Application of IPR Estoppel to Non-Instituted Claims**. IPR estoppel can apply to claims that were not raised in the IPR.[14]
- **Discovery of Privileged Material**s. Whether a printed publication "could have been raised" may implicate privileged or work product materials. For example, written discovery requests seeking the date when counsel learned of each reference may be within the fair scope of discovery.[15]
- **Patent Challenger Searches**

that a skilled and diligent searcher would not have found the later-identified prior art. Post-IPR searches should use new information or circumstances to identify prior art. Third parties, such as Unified Patents, may also have documents relevant to identifying prior art known to a Patent Challenger.[16]

- **Patent Owner and Public Searches**. Under some circumstances a Patent Owner may want to consider having their own searches conducted and documented in order to establish what a skilled and diligent searcher would have uncovered[17] or identify other earlier patent searches where the prior art was uncovered (e.g., public patent searches completed as part of patent prosecution or prior art identified in other IPR proceedings).
- **Use of System Art**. IPR grounds are statutorily limited to prior art in the form of printed publications.[18] Patent Challengers filing a *Sotera* stipulation often rely on prior devices or prior systems as prior art to avoid application of IPR estoppel. The line between what constitutes printed art and what is system art becomes blurred when the evidence of a prior system includes documents to which IPR estoppel applies. Some courts have held that estoppel does not apply to any invalidity theory that relies (in any part) on a system art. [19] Other courts have excluded system art where the argument amounts to a disguised prior publication theory, the system art is coextensive with—or materially identical to—the printed art to which IPR estoppel applies.[20]

---

[1] 35 U.S.C. § 315(e)(2).

[2] USPTO Director's June 21, 2022, memorandum available at interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

[3] Sotera Wireless, Inc. v. Masimo Corporation, IPR2020-01019 (Paper 12) at 17 (precedential).

[4] *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) ("Fintiv").

[5] Sotera Wireless, Inc. v. Masimo Corporation, IPR2020-01019 (Paper 12) at 12 (precedential).

[6] USPTO Director's June 21, 2022, memorandum available at interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf at 9.

[7] Sotera Wireless, Inc. v. Masimo Corporation, IPR2020-01019 (Exhibit 1038).

[8] *See, e.g.*, Apple Inc. v. Koss, IPR2021-00255, Paper 22 at 18-19 (PTAB June 3, 2021).

[9] Cal. Inst. of Tech. v. Broadcom, Ltd., 25 F.4th 976, 991 (Fed. Cir. 2022).

[10] *Apple, Inc. v. California Institute of Technology*, Br. of U.S., 22-203 (2022), available at https://www.supremecourt.gov/DocketPDF/22/22-203/267527/20230523143157264_22-203%20Apple%20v.%20CalTech.pdf

[11] *Ironburg Inventions Ltd. v. Valve Corp.*, 64 F.4th 1274, 1297–1299 (Fed. Cir. 2023).

[12] *Id.* at 1299.

[13] *EIS, Inc. v. IntiHealth Ger GmbH*, 2023 WL 6797905 at *2-*5 (Del. 2023).

[14] *Click-to-Call Technologies LP v. Ingenio, Inc.*, 45 4th 1363 (Fed. Cir. 2022) (evaluating unique facts—unlikely to reoccur under current law—in which a Patent Challenger was estopped from asserting the same invalidity theory against a claim on which the PTAB denied had institution, despite the PTAB finding other instituted claims unpatentable under said theory, because the Challenger "reasonably could have raised" the argument in IPR.

[15] *Promptu Systems Corporation v. Comcast Corporation et al*, 2-16-cv-06516 (Dkt. 390) at n.2 (Oct. 25, 2024) (EDPA).

[16] Textile Computer Systems, Inc. v. Broadway National Bank d/b/a Broadway Bank, No. 6-21-cv-01050 (Dkt. 109) (Nov. 9, 2022) (WDTX).

[17] *See, e.g.*, *SiOnyx, LLC v. Hamamatsu Photonics K.K.*, 330 F. Supp. 3d 574 (D. Mass. 2018) (the Court refused application of IPR estoppel because Patent Owner could not provide the Court with the "search string and search source that would identify" the reference and "evidence, likely expert testimony, why such a criterion would be part of a skilled searcher's diligent search.").

[18] 35 U.S.C. § 311(b).

[19] See, for example, the following cases: *IPA Techs. v. Microsoft Corp.*, No. 18-1, 2024 WL 1797394, at *6-7 (D. Del. Apr. 25, 2024) (allowing documents to prove up system art); *Prolitec Inc. v. ScentAir Techs., LLC*, 2023 WL 8697973, at *22-23 (D. Del. Dec. 13, 2023); *EIS, Inc. v. IntiHealth Ger GmbH*, No. 19-1227, 2023 WL 6797905, at *5–6 (D. Del. Aug. 30, 2023) (holding IPR estoppel does not apply to system art); *Cellwitch Inc. v. Tile, Inc.*, 2023 WL 8813524 at *3 (N.D. Cal. 2023); *Willis Elec. Co. v. Polygroup Macau Ltd.*, 649 F. Supp. 3d 780, 813–15 (D. Minn. 2023) (same); *Singular Computing LLC v. Google LLC*, No. 19-12551, 2023 WL 2839282 (D. Mass. Apr. 6, 2023) (same); *Chemours Co. FC, LLC v. Daikin Indus., Ltd.*, No. 17-1612, 2022 WL 2643517, at *2 (D. Del. July 8, 2022) (same); *Medline Indus., Inc. v. C.R. Bard, Inc.*, No. 17 C 7216, 2020 WL 5512132, at *3-4 (N.D. Ill. Sept. 14, 2020); *Microchip Tech. Inc. v. Aptiv Servs. US LLC*, No. 1:17-CV-01194, 2020 WL 4335519, at *4 (D. Del. July 28, 2020) (applying IPR estoppel to publications but not to device art used in combination with those publications); *SPEX Techs. Inc v. Kingston Tech. Corp.*, No. SACV 16-01790, 2020 WL 4342254 (C.D. Cal. June 16, 2020) ("The Court finds that the reliance on some printed publications in an overall collection of documents being used to describe a system invalidity theory should not lead to estoppel of the overall system invalidity theory itself, nor piecemeal exclusion of the printed publications underlying that system invalidity theory, absent a showing that the system invalidity theory is a patent or printed publication theory in disguise."); *Polaris Indus., Inc. v. Arctic Cat Inc.*, No. CV 15-4475 (JRT/TNL), 2019 WL 3824255, at *3 (D. Minn. Aug. 15, 2019); *Zitovault, LLC v. Int'l Bus. Machines Corp.*, No. 3:16- CV-0962-M, 2018 WL 2971178, at *4 (N.D. Tex. Apr. 4, 2018).

[20] The following cases either apply this principle directly or discuss circumstances where the use of system art should be limited: *Wirtgen America, Inc. v. Caterpillar, Inc.*, No. 1:17-cv-00770, 2024 WL 51010, at *9 (D. Del. January 4, 2024) (cumulative prior art excluded regardless of whether it could have been raised); *Hafeman v. LG Elecs., Inc. et al.*, No. 6-21-cv-00696, 2023 WL 4362863, at *1 (W.D. Tex. Apr. 14, 2023) (for an "invalidity argument that could not be raised before the PTAB, estoppel still applies when the allegedly new references have 'materially identical' disclosures as the IPR art."); *IOENGINE, LLC v. PayPal Holdings, Inc.*, 607 F. Supp. 3d 464, 512–13 (D. Del. 2022) (noting estoppel did not apply "if, as it appears here, that device is not simply a printed publication invalidity theory in disguise."); *Wasica Fin. GmbH v. Schrader Int'l, Inc.*, 432 F. Supp. 3d 448, 454–55 (D. Del. 2020) (holding IPR estoppel applies to system art cumulative of printed publications); *Boston Sci. Corp. v. Cook Grp. Inc.*

, 653 F. Supp. 3d 541, 593–94 (S.D. Ind. 2023); *In re Koninklijke Philips Pat. Litig.*, No. 18-CV-01885-HSG, 2020 WL 7392868, at *27 (N.D. Cal. Apr. 13, 2020) (noting that if the same printed references were used in an IPR, that evidence would have been unavailable to support system art theories); *Cal. Inst. of Tech. v. Broadcom Ltd.*, No. CV 16-3714, 2019 WL 8192255, at *7 (C.D. Cal. Aug. 9, 2019), aff'd, 25 F.4th 976 (Fed. Cir. 2022); *Oil-Dri Corp. of Am. v. Nestlé Purina Petcare Co.*, No. 15 C 1067, 2019 WL 861394, at *10 (N.D. Ill. Feb. 22, 2019); *Biscotti Inc. v. Microsoft Corp.*, No. 2:13-CV-01015, 2017 WL 2526231, at *8 (E.D. Tex. May 11, 2017).

© 2025 Winstead PC.

WINSTEAD

Dana Nguyen

Email
512.370.2821

Bio and Articles

Find Your Next Job !

Legal Secretary / Typist

Attorney Represented Bodily Injury Adjuster I, II or Sr

Early Career Trial Attorney - Las Vegas, Nevada (Remote)

Post Your Public Notice Today!

PUBLIC NOTICE OF DISPOSITON OF COLLATERAL: Barber Directory, Inc
Published: 19 May, 2025

PUBLIC NOTICE OF UCC ARTICLE 9 SALE: Veil Global Technologies, Inc
Published: 6 May, 2025

PUBLIC NOTICE OF AUCTION OF ASSETS: Rustic Crust, Inc
Published: 2 May, 2025

PUBLIC NOTICE OF UCC ARTICLE 9 SALE: CCP Mezzanine Nashville I, LLC
Published: 24 April, 2025

PUBLIC NOTICE OF 363 SALE: Elmer Buchta Trucking
Published: 31 March, 2025

PUBLIC NOTICE OF UCC ARTICLE 9 SALE: PHILLIPS AMSTERDAM II LLC
Published: 31 March, 2025

Discover More Public Notices

Advertisement

CURRENT LEGAL ANALYSIS

GeTtin' SALTy Episode 53 | GeTtin' SALTy & Beyond: Exploring Extended Producer Responsibility Laws [Podcast]
by: Nikki E. Dobay , Madeline Orlando

Congress and the Feds — the Impact of Nonperformance
by: James V. Aidala

SEC Enforcement Leadership Discusses New Priorities and Expectations
by: Timothy K. Halloran

on Infringement
by: Don Geiger

Department of Justice Outlines New White-Collar Crime Enforcement Priorities: Part One
by: Melissa L. Jampol , Thomas J. Jaworski

Advertisement

MORE FROM WINSTEAD

Court Affirmed Summary Judgment Order Finding That A Will Should Be Set Aside For Undue Influence
by: David Fowler Johnson

Court Held That Non-Attorney Executor Could Not Appeal An Order
by: David Fowler Johnson

Pitfalls to Avoid Before Filing an Offensive Patent Litigation Case
by: Miranda Jones

Regulatory Reset: Texas Establishes a DOGE-Inspired Office to Cut Red Tape
by: Jordan Rodriguez

Court Affirms A Trial Court's Order Granting A Receiver's Request To Sell Real Property
by: David Fowler Johnson

The Decedent's Death
by: David Fowler Johnson

Does a Trustee Have a Duty to Investigate Whether the Trust Document is Valid?
by: David Fowler Johnson

Court Reversed Order Holding That a Will Had Been Revoked Where There Was No Present Intent to Do So
by: David Fowler Johnson

The QPAM Exemption – Key Takeaways for Fund Managers with Benefit Plan Investors
by: Barbara Klepper

Texas Supreme Court To Review Whether A Corporate Trust's Shareholder Has Standing To Sue On Behalf Of The Trust
by: David Fowler Johnson

HUD Updates FHA Loan Residency Requirements: Citizenship or Permanent Residency Now Required
by: Bob Burton , Will Smith

Court Dismissed An Appeal From A Probate Court Order Due To A Lack Of Jurisdiction
by: David Fowler Johnson

Court Reversed Order Setting Aside The Probating Of A Will Where The Evidence Was Insufficient To Support The Order
by: David Fowler Johnson

Corporate Transparency Act Update: U.S. Companies No Longer Subject to Reporting Obligations
by: Andrew Rosell , Tave Doty

Texas Supreme Court Declines The Chance To Rule On Whether There Is A Right To A Jury Trial In A Trust Modification Suit
by: David Fowler Johnson

UPCOMING EVENTS

MAY
22
2025

Kidd Aitken & Chambers USA Q&A

MAY
22
2025

Yours, Mine, Or Ours? The Complex And Often Competing Duties Owed By Agents And Brokers To Their Insurers And Insureds

MAY
22
2025

A Practical Understanding Of Intellectual Property

MAY
27
2025

Making A Mountain Out Of A Mole Hill: Damage Escalation Strategies In Property Claims

THE
NATIONAL LAW REVIEW

Artificial Intelligence

Antitrust Law

Bankruptcy & Restructuring

Biotech, Food, & Drug

Business of Law

Construction & Real Estate

Cybersecurity Media & FCC

Election & Legislative

Environmental & Energy

Family, Estates & Trusts

Financial, Securities & Banking

Global

Immigration

Insurance

Intellectual Property Law

Labor & Employment

Litigation

Public Services, Infrastructure, Transportation

Tax

White Collar Crime & Consumer Rights

LEGAL DISCLAIMER

You are responsible for reading, understanding, and agreeing to the National Law Review's (NLR's) and the National Law Forum LLC's Terms of Use and Privacy Policy before using the National Law Review website. The National Law Review is a free-to-use, no-log-in database of legal and business articles. The content and links on www.NatLawReview.com are intended for general information purposes only. Any legal analysis, legislative updates, or other content and links should not be construed as legal or professional advice or a substitute for such advice. No attorney-client or confidential relationship is formed by the transmission of information between you and the National Law Review website or any of the law firms, attorneys, or other professionals or organizations who include content on the National Law Review website. If you require legal or professional advice, kindly contact an attorney or other suitable professional advisor.

Some states have laws and ethical rules regarding solicitation and advertisement practices by attorneys and/or other professionals. The National Law Review is not a law firm nor is www.NatLawReview.com intended to be a referral service for attorneys and/or other professionals. The NLR does not wish, nor does it intend, to solicit the business of anyone or to refer anyone to an attorney or other professional. NLR does not answer legal questions nor will we refer you to an attorney or other professional if you request such information from us.

Under certain state laws, the following statements may be required on this website and we have included them in order to be in full compliance with these rules. The choice of a lawyer or other professional is an important decision and should not be based solely upon advertisements. Attorney Advertising Notice: Prior results do not guarantee a similar outcome. Statement in compliance with Texas Rules of Professional Conduct. Unless otherwise noted, attorneys are not certified by the Texas Board of Legal Specialization, nor

The National Law Review - National Law Forum LLC 2070 Green Bay Rd., Suite 178, Highland Park, IL 60035 Telephone (708) 357-3317 or toll-free (877) 357-3317. If you would like to contact us via email please click here.

TERMS OF USE | PRIVACY POLICY

69

Copyright ©2025 National Law Forum, LLC

" ıse cookies and other data collection technologies to provide the best experience for our customers. You may r st that your data not be shared with third parties here: "Do Not Sell My Data

Do Not Sell or Share My Personal Information

RTICLES