



The Estoppel Statute Precludes Institution of Petitioner's Subsequent Inter Partes Review

Apr 24, 2015

Reading Time : **1 min**

By: Rubén H. Muñoz

Petitioner's request for review asserts prior art that was asserted by petitioner against the same patent in an earlier request for inter partes review—the '635 IPR. The same art was asserted in both petitions, but with different arguments—switching between obviousness and anticipation. In the '635 IPR, the board instituted trial and entered a final written decision finding that the patent had not been shown to be unpatentable.

In the instant case, the PTAB found that petitioner was estopped from requesting inter partes review under 35 U.S.C. §315(e)(1). The statute allows the board to deny review requests that contain prior art already presented in a proceeding that resulted in a final written decision. The instant request met all the requirements to deny institution under the estoppel statute: (1) the petitioner here and in the '635 IPR is the same; (2) there was a final written decision in the '635 IPR; and (3) the prior art petitioner asserts was presented in the initial petition. The board concluded that the differences in the way that the prior art is asserted did not weigh in the board's determination. What mattered is that the grounds that petitioner raises in the instant petition could have been raised in the '635 IPR.

The PTAB also concluded that two claims asserted were not precluded by estoppel because they were not previously reviewed, but they were nonetheless timebarred by § 315(b).

Dell Inc. v. Elecs. And Telcomms. Research Institute, IPR 201500549 (PTAB Mar. 26, 2015).

Categories

Patent Trial & Appeal Board

Inter Partes Review

© 2025 Akin Gump Strauss Hauer & Feld LLP. All rights reserved. Attorney advertising. This document is distributed for informational use only; it does not constitute legal advice and should not be used as such. Prior results do not guarantee a similar outcome. Akin is the practicing name of Akin Gump LLP, a New York limited liability partnership authorized and regulated by the Solicitors Regulation Authority under number 267321. A list of the partners is available for inspection at Eighth Floor, Ten Bishops Square, London E1 6EG. For more information about Akin Gump LLP, Akin Gump Strauss Hauer & Feld LLP and other associated entities under which the Akin Gump network operates worldwide, please see our Legal Notices page.