



No IPR Estoppel Despite Purportedly “Gratuitous” Inclusion of Physical Device in Invalidity Defenses

Jul 30, 2020

Reading Time : **2 min**

By: Jonathan James Underwood, Rubén H. Muñoz

The litigation began when the patent owner brought an action for infringement of several patents in the District of Arizona. The parties met and conferred to discuss the level of detail in the complaint, during which time the patent owner explained its infringement theories. Later, the patent owner dismissed the action and filed a new complaint in the District of Delaware to avoid a venue challenge. The Delaware court stayed the case pending the outcome of ongoing IPR proceedings directed to the same patents. Following completion of the IPR proceedings, the district court case resumed. The defendant asserted anticipation and obviousness defenses that included a physical product and a written reference that had not been raised in the IPRs. The patent owner moved for summary judgment that these defenses were statutorily estopped.

The court began its analysis by considering whether the written reference reasonably could have been raised in the IPR proceedings. The defendant argued that it could not have reasonably raised the reference because the patent owner’s infringement theory stretched the scope of the asserted claims, and was thus not foreseeable. The court rejected that argument for three reasons. First, while a jury might reject the patent owner’s theory as being too aggressive, the theory was not incorrect as a matter of law. Second, the defendant failed to provide legal support for carving out an exception to estoppel based on a defendant’s belief that the infringement theory was “overbroad or outlandish.” And third, the defendant had notice of the infringement theory before filing its IPR.

The court then considered whether the defenses using the physical product were estopped. The patent owner argued that the inclusion of the physical product was “gratuitous,” and that the product did not add anything beyond the written references. In rejecting the argument, the court first explained that other courts considering the application of estoppel had drawn a distinction between a physical device and corresponding printed publications. The court then explained that the patent owner had not identified a corresponding printed publication as a basis for imposing estoppel, but had instead asked the court “to dig into the substance” to find that the physical device added nothing beyond the other written references. The court explained that it had no basis to disregard the defendant’s expert’s position that the physical device was a significant part of the defenses. The court ruled that under these circumstances, estoppel did not apply.

Practice Tip: The application of IPR estoppel continues to be hotly contested. A would-be IPR petitioner should be aware of the contours of the “reasonably could have raised” aspect of IPR estoppel and how it has been applied to anticipation and obviousness challenges that rely on non-printed prior art, such as a physical product. Similarly, a patent owner should be prepared to scrutinize invalidity positions to determine precisely how a defendant uses a physical product in its arguments.

Microchip Tech. Inc. v. Aptiv Servs. US LLC, Case No. 1:17-cv-01194, 2020 WL 4335519 (D. Del. July 28, 2020)

Categories

District Court

Inter Partes Review

35 U.S.C. § 315(e)(2) estoppel

© 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.