



## Collateral Estoppel Provides Petitioner with Successful Shortcut in IPR Challenge

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Petitioner Alphatec Holding, Inc. filed an IPR petition alleging that five dependent claims of Patent Owner Nuvasive, Inc.'s patent (related to systems and methods of spinal fusion) would have been obvious. The board had previously considered the patentability of several claims of that patent in an IPR brought by another petitioner in 2013. In that IPR, the board held that independent claim 1 was obvious in light of a combination of two references. In 2016, the Federal Circuit affirmed the Board's final written decision.

Here, Petitioner asserted a three-reference obviousness combination that included the two references previously held to render obvious independent claim 1. Petitioner argued that—as the board previously held—those references teach or suggest all limitations of claim 1. According to Petitioner, Patent Owner was estopped from arguing that claim 1 lent any support to the patentability of any dependent claim over those two references and that it was irrelevant that the exact three-reference ground was not previously considered. This was so, according to Petitioner, because there was already a final decision that two of those references taught or disclosed each limitation of claim 1. Patent Owner argued that Petitioner failed to meet each element of collateral estoppel. Here, according to Patent Owner, the issues are different from the previous IPR because Patent Owner could not have had a full and fair opportunity to litigate a three-reference ground that had never been raised. Patent Owner also argued, among other things, that in the prior IPR it did not have an adequate opportunity to respond to arguments made in that petitioner's reply.

The board agreed with Petitioner. First, the board recognized that collateral estoppel prevents a patentee from asserting the validity of a claim that has been declared invalid in a prior proceeding if (1) the identical issue was litigated; (2) the issue was actually decided in a final

decision on the merits; (3) the determination of the issues was necessary to the resulting judgment; and, (4) the party defending against preclusion had a full and fair opportunity to litigate the issues.

In its previous final written decision, the board determined the same issue presented here—that two references taught all limitations of claim 1. That issue was decided in a final decision and was necessary for the conclusion that claim 1 was unpatentable. As to the fourth element of collateral estoppel, Patent Owner failed to point to evidence that it did not have a full and fair opportunity to litigate the issue. The fact that Petitioner asserts an additional reference does not affect the previous final determination that the other two references teach and disclose all limitations of claim 1. And the board did not apply collateral estoppel to Petitioner’s asserted rationale for combining the references (which include the third, new, reference). Finally, the fact that Patent Owner did not make certain arguments in the prior IPR does not mean that estoppel does not apply. Accordingly, the board found that the prior determination precluded Patent Owner from relitigating whether the references teach all limitations of claim 1, as arranged in the claim, for purposes of determining patentability of dependent claims.

**Practice Tip:** When filing an IPR petition, a petitioner should consider whether a prior decision might collaterally estop the patent owner from contesting any issues on which petitioner carries the burden of proof. Specifically, if any related claims have already been held invalid or unpatentable in a prior decision, petitioners should consider whether that prior decision resolves the same issues with respect to the challenged claims. If so, those prior findings may be leveraged through collateral estoppel.

*Alphatec Holdings, Inc. v. NuVasive, Inc.*, IPR2019-00361, Paper 59 (PTAB July 8, 2020)

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