



## Patentability Challenges Not Raised in Prior Interference Foreclosed in Subsequent IPR

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Patent owner Mexichem Amanco Holdings owns U.S. Patent No. 8,633,340, which covers processes for preparing chlorinated and fluorinated hydrocarbons. In September 2020, The Chemours Company (petitioner) filed a petition for IPR seeking review of certain claims of the '340 patent.

This was not the first time that petitioner had challenged the '340 patent at the board. In 2018, the '340 patent was involved in an interference with one of petitioner's reissue applications. Pursuant to the board's instruction, each party in the interference submitted a list of motions they intended to file. Notably, while patent owner sought permission to file motions challenging **both** priority and patentability of petitioner's reissue claims, petitioner only included a single motion for judgment on the basis of priority on its motions list. After authorizing the motions, the board noted that petitioner did not include any responsive motion challenging patentability and invited petitioner to seek authorization if it wanted to do so. Ultimately, petitioner never sought authorization to file a responsive motion. After reviewing the parties' papers, the board held that petitioner's reissue claims were unpatentable for failing to comply with the written description requirement and entered judgment against petitioner. The board's decision was affirmed by the Federal Circuit.

Later, in the IPR, patent owner argued that petitioner was estopped from asserting its grounds of unpatentability because petitioner could have, but did not, raise those grounds in the previous interference. Patent owner based its "interference estoppel" argument on 37 C.F.R. § 41.127(a), which provides that a judgment in an interference "disposes of all issues that were, or

by motion could have properly been raised and decided.” The board agreed with patent owner and denied institution of the IPR.

In reaching its conclusion, the board first explained that “for more than 35 years” it has been deciding patentability challenges in interferences, including those based on anticipation and obviousness, and further noted there is “complete identity” between the ’340 patent claims challenged in the interference count and the IPR. Thus, it was “beyond dispute” that the patentability of the challenged claims could have been raised in the interference. The board also noted that despite having “repeated opportunity” in the interference to file a patentability motion—including an explicit invitation from the board for a conference call to seek authorization to file a patentability motion—petitioner declined to do so. The board also found that petitioner was “well-acquainted” with the asserted prior art at the time of the interference because that prior art was discussed in the interference and was considered during prosecution of the ’340 patent. Thus, there was no reason for petitioner not to raise the IPR grounds in the interference.

In arguing against estoppel, petitioner maintained that § 41.127(a) should be interpreted such that **if** a party chooses to challenge patentability, it is incumbent on the party to raise all known patentability arguments. But where, as petitioner did here, a party chooses to **only** challenge priority, its patentability challenges are not prohibited. The board found petitioner’s interpretation unpersuasive for several reasons. First, it is inconsistent with the text of the regulation because allowing a losing party to raise patentability issues in a subsequent IPR would mean that the prior interference judgment did not dispose of “all issues” that could have been raised in the interference. Second, petitioner’s interpretation improperly conflates the board’s discretion to decide patentability in an interference with a party’s obligation to preserve those issues. On this point, the board explained that “estoppel . . . depends on whether the losing party sought to raise the issue when it had the opportunity to do so and not whether the Board exercised its discretion to reach it.” Finally, the board found that petitioner’s interpretation was contrary to the purpose of § 41.127(a), which is to “encourage the parties to raise issues pertaining to the interfering subject matter, whether they be questions of priority or patentability, so that the Board can assess how best to resolve those questions within the full context of all the issues raised.”

**Practice Tip:** When deciding what challenges to make in an interference proceeding, a party should be aware of, and take into consideration, the possibility that it may be estopped from later challenging patentability in an IPR. A party involved in an interference should consider

raising all patentability challenges of which it is aware, or risk the possibility of being foreclosed from raising them in a subsequent proceeding.

*The Chemours Co. FC, LLC v. Mexichem Amanco Holdings SA de CV*, IPR2020-01667, Paper 10 (P.T.A.B. March 25, 2021)

## Categories

Patent Trial & Appeal Board

Inter Partes Review

Patentability

35 U.S.C. § 315(e)(2) estoppel

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