



Federal Circuit Clarifies Scope of IPR Estoppel, Reversing Prior Shaw Decision

Feb 23, 2022

Reading Time : 2 min

By: Rachel J. Elsby, Jason Weil

Section 315(e)(2) sets forth the scope of IPR estoppel in civil litigation. Under that Section, the petitioner in an IPR that results in a final written decision “may not assert ... any [invalidity] ground that the petitioner **raised or reasonably could have raised**” during that IPR. In *Shaw*, the Federal Circuit held that because an IPR does not begin until it is instituted, only those grounds on which the Patent Trial and Appeal Board (PTAB) institutes review meet the “raised or reasonably could have been raised” standard, and therefore, only those grounds that actually get reviewed during the IPR were subject to estoppel.

However, because *Shaw* only involved a ground that **was raised** in the petition, but **was not instituted** by the PTAB, district courts split on whether that decision extended to grounds that were not included in the petition.

In *California Institute of Technology v. Broadcom Ltd*, a panel of the Federal Circuit was asked to clarify the scope of IPR estoppel. In that case, multiple accused infringers filed petitions for IPRs that were instituted, but ultimately unsuccessful. Failing to invalidate the claims through IPRs, the accused infringers raised new prior art invalidity grounds in the district court that were not presented to the PTAB. The district court held the accused infringers were estopped from raising those grounds because they were aware of the prior art references when the IPR petitions were filed, and could have raised them in the petitions.

The Federal Circuit agreed, holding that IPR estoppel applies to all grounds that a petitioner raised or reasonably could have raised **at the time the petition was filed**. In so doing, the court reversed its decision in *Shaw*. As the court explained, at the time *Shaw* was decided, the PTAB would often institute IPRs on fewer than all grounds raised in an IPR (as in *Shaw*).

Thus, it made sense at the time that a petitioner should not be barred from later litigating grounds that were not reviewed in an IPR. After *Shaw*, however, the Supreme Court's *SAS Institute* decision made clear that the PTAB's institution authority did not permit partial institution. Rather, the PTAB was required to institute on all grounds or deny institution. Under *SAS Institute*, it is the petition that defines the IPR and any resulting estoppel.

The panel also clarified its authority to overrule a prior decision of the Federal Circuit without en banc activity. While acknowledging that the Supreme Court's decision in *SAS Institute* *did not explicitly overrule Shaw*, the panel explained that the reasoning in *Shaw* rests on an assumption that the Supreme Court rejected. Thus, *SAS Institute* sufficiently undercut the theory or reasoning underlying *Shaw*, such that the rulings were irreconcilable, which permitted the panel in this case to overrule the *Shaw* panel's decision.

Practice Tip: Because the Federal Circuit has now clarified that IPR estoppel extends to all grounds that could have been raised in an IPR petition that results in a final written decision, petitioners should consider all defenses, including those that cannot be raised at the PTAB (e.g., evidence of prior use, Section 112 defenses), when evaluating whether to petition for IPR.

Categories

Federal Circuit

Patent Trial & Appeal Board

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.