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Voluntary Nature of IPR Proceedings Forecloses Attorney's Fees, According to District Court

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By: Megan R. Mahoney, Jason Weil, Rubén H. Muñoz

In that case, the plaintiff sued the defendant for patent infringement based on defendant's "automatic top-off" food fryers. The next month defendant presented plaintiff with several pieces of prior art that allegedly invalidated the claims. Defendant later filed an IPR petition alleging that each claim of the patent was anticipated by one of the references the defendant had previously identified. The board ultimately found all claims anticipated over that reference.

The district court dismissed the case and the defendant timely moved for attorney's fees under § 285. According to the defendant, the plaintiff pursued frivolous litigation, including taking inconsistent positions before the court and the board, and proceeding with the litigation despite being presented with the invalidating art.

The plaintiff opposed the motion, arguing that Federal Circuit *dicta* and the statute's silence on the matter show that attorney's fees are not available for work in an IPR. The defendant countered, relying on a Federal Circuit case that addressed a unique situation in a reissue proceeding, and arguing that since the dispute was fully resolved through IPR, the IPR proceeding should be considered part of the patent infringement "case" for § 285 purposes.

The district court ultimately agreed with the plaintiff that § 285 attorney fees are not available for IPR proceedings. The court relied on both the words and context of the statute, as well as the Federal Circuit *dicta* that fees cannot be awarded for work completed during an IPR. IPR proceedings are voluntary, and the alleged infringer chooses to participate in the

proceeding by filing a petition. As such, an alleged infringer is not entitled to receive attorney's fees under § 285 for prevailing in an IPR proceeding.

Practice Tip: When seeking attorney's fees, parties should consider focusing on an adversary's conduct during litigation. Conduct during an *inter partes* review, even if it involves success based on a reference that has been presented to the patent owner, may not support a fee award because proceeding down the IPR route may be viewed as a voluntary choice outside of district court litigation.

Sherwood Sensing Solutions LLC v. Henny Penny Corp., 3:19-cv-00366 (S.D. Ohio May 20, 2022).

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District Court | Inter Partes Review | 35 U.S.C. § 285