



District of Delaware: IPR Estoppel Does Not Apply to Prior-Art Products

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The court initially noted that it was undisputed that the defendant could not have raised the prior-art products during a related IPR proceeding. However, the patentee had argued that the prior-art products at issue in the district court case were “cumulative” to the paper-based prior art that the defendant had asserted in the IPR proceeding. As such, the patentee argued that the defendant was still estopped from pursuing invalidity defenses based on the products. The court explained that although it had agreed to hear evidence on the cumulativeness of the prior-art products, the dispute could be settled without a hearing.

The court resolved the dispute by looking at the text of the estoppel statute and using “well-accepted canons of construction.” The court first explained that by the plain text of the statute, estoppel only applies to grounds that were raised or reasonably could have been raised during the IPR proceeding. Furthermore, even though the term “ground” was not defined in the statute, other courts had interpreted it to mean the “specific pieces of prior art” involved in the challenge. Adopting the same interpretation, the court reasoned that because prior-art products cannot not be raised in an IPR, such products cannot not be a “ground” that is subject to statutory estoppel.

The court acknowledged that the issue is not settled. Across the country, judges have reached varying conclusions, including a decision in which the former Chief Judge of the District of Delaware ruled that Section 315(e)(2) estoppel did apply to a prior-art product, given the circumstances of that case. Nevertheless, the court reasoned that adhering closely to the statutory text was the most appropriate course given that neither the Supreme Court nor the Federal Circuit has decided the issue.

The court also explained that Congress had chosen the statutory text after “considered debate and careful thought.” And because Congress could have provided broader categories of estoppel but did not do so, the court should not seek to create additional bases for estoppel.

Practice tip:

This decision highlights an on-going struggle among district courts about the scope of IPR estoppel. Until the scope is clarified, at least in the first instance by the Federal Circuit, parties should consider carefully whether estoppel might apply to invalidity grounds premised on prior-art products. Parties should look to decisions from within the district court and, more specifically, the presiding judge to determine how estoppel has been applied.

Chemours Co. FC LLC v. Daikin Indus., Ltd., 2022 WL 2643517, C.A. No. 17-1612 (MN) (D. Del. July 8, 2022)

Categories

District of Delaware

Prior Art

Inter Partes Review

35 U.S.C. § 315(e)(2) estoppel

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