



IPR Estoppel Does Not Prohibit ‘Cumulative or Duplicative’ System-Based Invalidity Defenses in District Court Actions

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In a decision denying summary judgment, the District of Massachusetts weighed in on an unsettled issue: whether after receiving a final written decision in an *inter partes* review, a patent challenger is permitted to raise system-based invalidity defenses that are related to printed publications or patents that could have been raised in an IPR. The court’s answer was yes.

Plaintiff filed an action against Defendant alleging infringement of three patents covering low-precision, high dynamic range, computer processing unit architectures. In response, Defendant filed several petitions for IPR of the patents-at-issue, contending that the challenged claims were unpatentable as obvious. Defendant relied on three prior-art references in the IPR proceedings to support its unpatentability grounds, as well as additional patents and prior art references for background purposes. In a final written decision, the Patent Trial and Appeal Board upheld the patentability of two claims that were asserted in the district court action. Based on the Board’s decision, Plaintiff moved for partial summary judgment of estoppel under 35 U.S.C. § 315(e)(2) in an effort to prevent Defendant from raising what Plaintiff characterized as the same obviousness defense in district court.

According to 35 U.S.C. § 315(e)(2), a petitioner “may not assert [] in a civil action...that the claim is invalid on **any ground** that the petitioner **raised or reasonably could have raised**” during the IPR. Plaintiff argued that Defendant was statutorily estopped from raising the same obviousness defenses because **any argument** Defendant presented in district court under 35 U.S.C. § 103 was one that Defendant either already raised, or reasonably could have raised, in

the IPR proceedings. Also, because Defendant had already presented printed publications in the IPR that described the prior art systems, any further evidence of these prior-art systems was barred. In response, Defendant argued that when a party **combines any evidence that could not have been presented in the IPR** (i.e., any evidence outside of patents or printed publications) with any patent or printed publication, estoppel does not apply. Defendant further argued that because it was relying on different printed publications describing the prior-art systems, along with other forms of evidence, including source code, oral presentations and expert testimony, estoppel did not apply.

The court disagreed with both parties, stating that each party's argument misconstrued the statutory language—Plaintiff's interpretation was overly narrow and Defendant's interpretation was too broad to the point of estoppel vitiation. The court defined "ground" in 35 U.S.C. § 315(e)(2) as "any anticipation or obviousness claim based on prior art in the form of a patent or printed publication." Based on this definition, the court reasoned that while it is uncontested that estoppel applies to any raised patents and printed publications, and those which could have reasonably been raised, "[t]he Patent Act says nothing about estopping invalidity claims that are 'cumulative' or 'duplicative' of those raised in an IPR proceeding." Ultimately, estoppel did not preclude Defendant from presenting other forms of evidence of the asserted prior-art systems.

Practice Tip

An IPR petitioner involved in a co-pending district court action should consider including in its invalidity defenses prior art evidence in other forms besides patents or printed publications, including any relevant evidence of prior art products and systems. As evidenced by this district court decision, such evidence may be immune from IPR estoppel and may be used in district court to support invalidity even in light of a final written decision in a related IPR.

Case

Singular Computing LLC v. Google LLC, Civil Action No. 19-12551-FDS (D. Mass. Apr. 6, 2023)

Categories

District Court

Inter Partes Review

35 U.S.C. § 315(e)(2) estoppel

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