



## District of Delaware Holds That IPR Estoppel Does Not Apply to Device Art

December 29, 2023

Reading Time : **2 min**

By: Svetlana Pavlovic, Jason Weil, Rubén H. Muñoz

Federal Circuit Judge William Bryson, sitting by designation in the District of Delaware, ruled on summary judgment that *inter partes* review (IPR) estoppel does **not** apply to device art, even if the device is cumulative of patents or printed publications that were, or could have been, asserted in an IPR.

In a patent infringement litigation related to computer-controlled scent delivery systems, the patentee ultimately narrowed its case to six claims across two patents after the Patent Trial and Appeal Board had found several other claims unpatentable in an IPR. The patentee moved for summary judgment of no anticipation, arguing that the defendant was estopped from asserting that the claims were anticipated by certain devices because those devices are materially identical to a patent that the defendant could have raised in its IPR challenge. In opposition, the defendant argued that the device is different from the patent, and, in any event, IPR estoppel does not apply to device art. Thus, according to the defendant, it was not precluded from arguing anticipation based on the devices.

The court noted that there is a split among district courts (even within Delaware) as to whether IPR estoppel extends to such device art and the key disagreement is in the interpretation of the term “ground” as used in 35 U.S.C. § 315(e)(2), which governs IPR estoppel. That provision extends estoppel to “any ground that the petitioner raised or reasonably could have raised” during a prior IPR. The court explained that “[t]here are two plausible ways of interpreting ‘grounds’ in the IPR context. One interpretation is that ‘grounds’ refers to the underlying legal arguments, which incorporate patents, printed publications, and cumulative device art. The other is that ‘grounds’ are the particular patents and printed publications on

which invalidity arguments are based, and that the supporting affidavits, declarations, and the like are evidence, not ‘grounds.’”

The court agreed with a previous Delaware decision and adopted the second theory, interpreting the term “grounds” to mean “the specific pieces of prior art that are the bases on which a petitioner challenges a claim.”<sup>1</sup> In doing so, the court explained that such interpretation of “grounds” is consistent with the way the term has been used in a similar context in 35 U.S.C. § 312, which mandates that the petition must detail the grounds for the challenge and the supporting **evidence** for the **grounds**—thus differentiating the grounds from the evidence itself. The court further noted that this approach is in line with how the term “grounds” has been used by the Federal Circuit in the IPR context, as “the legal argument and specific combination of references on which it was based.” Accordingly, the court held that the defendant was not estopped from relying on the prior art devices.

**Practice Tip:** Until the Federal Circuit clarifies the scope and applicability of IPR estoppel, parties are well advised to present arguments on the proper scope of § 315(e)(2), but they must also pay close attention to how estoppel has been applied within their district and adapt legal strategies accordingly.

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<sup>1</sup> For further discussion of the previous Delaware case, see this [IP Newsflash](#).

## Categories

District Court

District of Delaware

Inter Partes Review

Patent Litigation

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