

N.D. Cal. Judge Reverses Prior Order Barring Device Art “Materially Identical” to Printed Publications After Federal Circuit Adopts Narrower View of IPR Estoppel

August 5, 2025

Reading Time : 5 min

By: Thomas W. Landers IV, Rubén H. Muñoz

A Northern District of California judge recently granted a motion to reconsider his summary judgment ruling that defendant was barred from raising certain “device art” due to IPR estoppel under 35 U.S.C. § 315(e)(2). In the original ruling, the judge adopted the broader rule that IPR estoppel applies to device art that is “materially identical” to patents or printed publications that petitioners raised, or could have raised, in an IPR. Following that ruling, however, the Federal Circuit issued its *Ingenico* decision adopting the narrower view that IPR estoppel applies **only** to “grounds” based on patents and printed publications and not to device-based grounds. Citing *Ingenico* as a “change of law,” defendant moved for reconsideration of the court’s ruling, and the court granted the motion.

In a patent infringement suit related to wearable camera devices, the patentee requested summary judgment that defendant was estopped from asserting invalidity theories based on certain physical camera devices. The patentee argued that IPR estoppel under § 315(e)(2) applied to the device art because all “material limitations” of the devices were disclosed in product manuals cited by defendant’s expert, and the manuals qualified as “printed publications” that could have been raised in defendant’s related IPRs. The defendant argued that estoppel did not apply because its invalidity expert relied on the “products themselves,” not the product manuals.

After agreeing with patentee that the asserted devices were “materially identical” to printed publications that could have been raised in an IPR—and that defendant’s expert failed to rely on any aspect of the devices not disclosed in the printed publications—the court grappled

with an unresolved “split among district courts” on whether IPR estoppel can apply to device art at all. The “split” centered on the proper scope of the term “ground” in § 315(e)(2), which states that petitioners may not assert in district court “**any ground** that the petitioner raised or reasonably could have raised” in an IPR that resulted in a final written decision. Some courts have taken a narrower view that “ground” refers only to the “particular patents and printed publications on which invalidity arguments are based,” and thus estoppel does not apply to device art at all.[1] Other courts have taken a broader view that “ground” refers to “underlying legal theories, incorporating patents, printed publications, **and related cumulative evidence, such as physical devices.**” Under this broader view, IPR estoppel applies to devices “materially identical to patents and printed publications.” Citing “efficient resolution of patent disputes,” the court adopted the broader view and barred defendant from relying on the asserted devices and related publications.

Shortly after that ruling, however, the Federal Circuit resolved the “split among district courts” when it affirmed a District of Delaware judgment permitting a defendant to rely on a “prior art USB device” at trial. That device that was “entirely cumulative and substantively identical” to printed publications that “reasonably could have been raised during [an] IPR.” In affirming the judgment, the Federal Circuit held that “IPR estoppel does **not** preclude a petitioner from asserting that a claimed invention was known or used by others, on sale, or in public use in district court” because those “are different grounds that could not be raised during an IPR.” See *Ingenico Inc. v. Ioengine, LLC*, 136 F.4th 1354 (Fed. Cir. 2025). Notably, the court further explained that “**a ground is not the prior art** asserted during an IPR,” and thus “IPR estoppel does not preclude a petitioner from relying on the same patents and printed publications **as evidence** in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use.”

Citing *Ingenico* as a “material change in law,” defendant sought leave to file a motion for reconsideration of the court’s estoppel ruling, which the court granted. In its subsequent motion, defendant argued that because *Ingenico* “clarified that IPR estoppel only applies to the grounds that were raised (or could have been raised) before the PTAB and not to the art itself—whether in the form of a printed publication or otherwise—there is no basis to exclude [defendant]’s prior art products and related invalidity theories.” Moreover, defendant requested to supplement its invalidity reports to include additional materials—including “upgrade manuals, software release notes, and internal sales records”—in part based on the Federal Circuit’s clarification that petitioners may rely on patents and printed publications as “evidence” in device-based grounds. According to defendant, prior to submitting expert

reports, “the parties had an understanding of IPR estoppel that was significantly broader than the law established by *Ingenico*,” such as that “any art-based invalidity defenses...had to be materially different from art that was raised or could have been raised in the IPR” and that device art must have “functionality that was not reflected in” prior art publications. But *Ingenico* clarified “that the same evidence of invalidity can be used in post-IPR judicial proceedings to demonstrate invalidity as long as it is relevant to a new legal ground, not subject to IPR proceedings.” The defendant thus requested to supplement its expert reports specifically “to choose different grounds (or supplement existing grounds) based on the current state of the law.”

In response, patentee clarified that it did not oppose defendant’s motion for reconsideration “insofar as [defendant] requests the Court to reverse its Summary Judgment Order finding that ‘[defendant]’s prior art theories based on [device art] are barred by IPR estoppel.” However, it opposed defendant’s request to “supplement its expert reports” because the reports “already set forth [defendant]’s invalidity theories based on the [physical] devices” before the parties briefed the estoppel issue. In other words, “[defendant] should not be allowed to further ‘supplement’ expert reports (and thus create a need for delay) because [defendant] can rely on its earlier expert reports—just as if the Court had denied summary judgment on IPR estoppel in the first instance.”

The court recently issued its decision granting defendant’s motion and permitting limited supplementation of its invalidity reports. First, the court determined that *Ingenico* “is at odds with [its] holding in the Prior Order” and that “IPR estoppel does not bar [defendant] from introducing prior art theories based on the ... physical devices.” Second, it allowed defendant to supplement its expert reports on a narrow basis. As the court explained, *Ingenico* would only have supported a denial of patentee’s motion for summary judgment—it did not “open up a new avenue for invalidity arguments and defenses.” According to the court, defendant “moves only for narrow amendments” that do not “add entirely new prior art to the record.” The amendments would only support “that the claimed inventions were ‘known or used by others, on sale, or in public use.’” The court thus “allow[ed] [defendant] to amend its expert report to narrowly but adequately discuss issues it previously believed to be precluded prior to the *Ingenico* decision.”

Practice Tip: Following *Ingenico*, defendants should consider whether any device art is available for use in litigation, even if it is “materially identical” or “cumulative” of printed publications that were raised or reasonably could have been raise in a related IPR. Moreover,

parties should pay close attention to how much leeway future cases give defendants in using printed publications—such as product manuals—as “evidence” supporting that the inventions were “known or used by others, on sale, or in public use.”

Contour IP Holding, LLC v. GoPro, Inc., 3-17-cv-04738 (NDCA Jul. 11, 2025) (William H. Orrick, III)

¹ For discussion of a case adopting the narrower view of IPR estoppel, see this [IP Newsflash](#).

(<https://www.akingump.com/en/insights/blogs/ip-newsflash/district-of-delaware-holds-that-ipr-estoppel-does-not-apply-to-device-art>).

Categories

IPRs

Patent Litigation

Patent Infringement

© 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.