



2013 Decision on Assignor Estoppel Designated as Precedential by PTAB

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By: Rubén H. Muñoz

Here, the petitioner filed a petition for *inter partes* review, arguing that U.S. Patent No. 7,670,536, which relates to injection molding machines, was invalid under §§ 102 and 103. In its preliminary response, the patent owner claimed that the petitioner is barred from challenging the validity of the patent under the doctrine of assignor estoppel. The doctrine of assignor estoppel prohibits an assignor of a patent, or one in privity with him, from challenging the validity of that patent when he is sued for infringement by the assignee. *See Semiconductor Energy Laboratory Co., Ltd. v. Nagata*, 706 F.3d 1365, 1369 (Fed. Cir. 2013).

The patent owner argued that the petition should be barred because one of the named inventors is in privity with the Petitioner. The inventor was the founder, co-owner, president and CEO, and on the board of directors of the petitioner.

The PTAB determined that assignor estoppel does not apply here. An assignor who no longer owns the patent at the time of filing may file a petition for *inter partes* review under Section 311(a). The PTAB explained that Congress broadly granted the right to challenge the validity of patents through *inter partes* review. The PTAB compared AIA post-grant reviews to ITC investigations, finding that Congress explicitly stated that “all legal and equitable defenses may be presented” in all ITC investigations, but no such language is used in connection with post-grant reviews.

Thus, the PTAB declined to bar the petition, concluding that the doctrine of assignor estoppel does not provide an exception to the statutory mandate that any person who is not the owner of a patent may file a petition for an *inter partes* review.

Categories

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Inter Partes Review

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