



## Estoppel Does Not Apply to Prior Art Disclosed in Invalidity Contentions Served Before the Filing of an IPR Petition

Jan 10, 2018

Reading Time : **2 min**

In *Philips v. Wangs*, plaintiffs Koninklijke Philips N.V. and Philips Lighting North America Corp. (“Philips”) filed a patent infringement lawsuit against defendant Wangs Alliance Corp. (WAC) asserting seven patents. During the course of litigation, WAC served preliminary and supplemental invalidity contentions in the district court case. As a defense to this lawsuit, WAC petitioned for IPR of certain claims of the seven asserted patents. The Patent Trial and Appeal Board (PTAB) instituted review with respect to claims in six of the asserted patents and issued a final decision finding unpatentable some of the challenged claims.

After the PTAB’s final decision issued, Philips moved for summary judgment in district court of no invalidity. Philips’ motion was based on two grounds: (1) under 35 U.S.C. § 315(e)(2), WAC is estopped from asserting prior art disclosed in its preliminary and supplemental invalidity contentions; and (2) any invalidity contention that WAC did not disclose in its preliminary and supplemental invalidity contentions should fail as untimely.

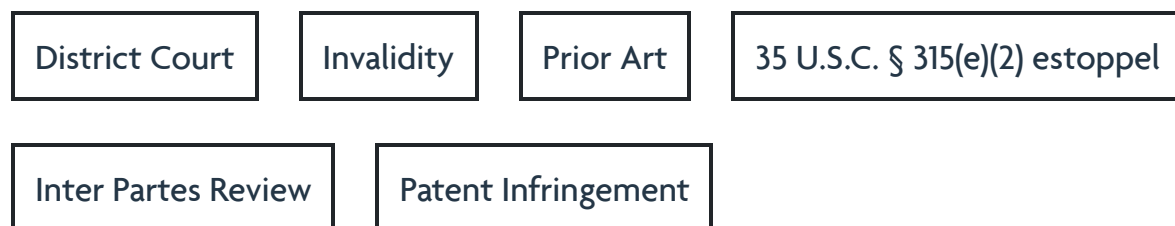
Under 35 U.S.C. § 315(e)(2), “the petitioner in an *inter partes* review of a claim in a patent under this chapter that results in a final written decision” may not assert in a civil action that the claim is invalid on a ground that “petitioner raised or reasonably could have raised” during an IPR. Philips argued that the prior art in the invalidity disclosures could have been raised in WAC’s IPR petition and is thus barred from the district court litigation. The dispute between the parties hinged on whether *during* IPR means only the portion of the proceedings after the review is instituted or the entirety of the IPR proceedings, including the filing of the petition. The court relied on the Federal Circuit’s decision in *Shaw Industries Group* and concluded that the phrase refers to only the period of time after review is instituted, and

estoppel does not apply “to arguments that the petitioner only ‘raised or reasonably could have raised’ in its petition rather than after institution of review.” The court denied Philips’ motion with respect to invalidity contentions that WAC failed to raise in its petition for IPR and determined that there was no estoppel.

Philips also argued that any invalidity contention that WAC did not disclose in its preliminary and supplemental invalidity contentions should fail as untimely. The court denied this basis because WAC’s final invalidity contentions were not yet due.

*Koninklijke Philips N.V. v. Wangs Alliance Corp.*, 1:14-cv-12298-DJC, 2018 U.S. Dist. LEXIS 607 (D. Mass. Jan. 2, 2018).

## Categories



© 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.