



Accused Infringer Estopped from Asserting Prior Art Disclosed in Invalidity Contentions

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ZitoVault sued IBM and Softlayer Technologies, Inc. (“Softlayer”) (collectively, “Defendants”) for alleged infringement of U.S. Patent No. 6,484,257 (the “’257 Patent”). Soon after, the Defendants petitioned the Patent Trial and Appeal Board (PTAB) for *inter partes* review (IPR) of the ’257 Patent (“First Petition”) and requested to join a pending IPR on the same patent, filed earlier by Amazon.com, Inc. The Defendants submitted a nearly identical IPR petition as the one filed by Amazon. The PTAB granted joinder and issued a final written decision on April 11, 2017, holding that the challenged claims were patentable.

During the pendency of the First Petition, the Defendants filed a separate IPR petition (“Second Petition”) based on different prior art references. The PTAB denied institution of the Second Petition. Afterwards, plaintiff moved for summary judgment under 35 U.S.C. § 315(e)(2) asserting that statutory estoppel precluded IBM from arguing that the ’257 Patent is invalid as anticipated or obvious.

35 U.S.C. 315(e)(2) states that “[t]he petitioner in an inter partes review of a claim in a patent . . . that results in a final written decision . . . 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 that inter partes review.**” 35 U.S.C. 315(e)(2) (emphasis added). The First Petition did not raise any prior art references that were already identified in their invalidity contentions in district court. The Defendants essentially argued that estoppel does not apply based on the First Petition because they could not have raised additional prior art when seeking joinder because “[the] PTAB routinely denies joinder if a second-filed petition might introduce new arguments

or grounds into a pending IPR.” Judge Lynn disagreed, however, stating that the PTAB does not require a “mirror image” rule to allow joinder and that joinder is discretionary, and whether the petition asserts new grounds is just one of the factors considered. Because the Defendants could have sought, but did not seek, to raise the prior art patents and publications discussed in their invalidity contentions, allowing the Defendants to raise arguments that they elected not to raise during the First IPR would provide them with “a second bite at the apple.” Therefore, Judge Lynn held that the Defendants IBM and Softlayer are estopped from arguing anticipation or obviousness in light of prior art references discussed in their invalidity contentions, but they can rely on prior art systems from their invalidity contentions.

ZitoVault LLC v. International Business Machines Corporation et al, 3-16-cv-00962 (TXND April 4, 2018, Order) (Lynn, USDJ)

Categories

District Court	Infringement	35 U.S.C. § 315(e)(2) estoppel
Inter Partes Review	Northern District of Texas	

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