



Swapping Order of References in Non-Instituted Obviousness Combination Does Not Alter Scope of IPR Estoppel

Apr 19, 2018

Reading Time : **1 min**

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In *Nox Medical EHF v. Natus Neurology Inc.*, defendant Natus had raised in an IPR petition certain obviousness combinations in the form of “A in view of B,” and the PTAB declined to institute those claims for review. Natus raised some of those same combinations before the district court, but changed which reference in the combination was “primary” and which was “secondary”—i.e., raising “B in view of A” before the district court when it had raised “A in view of B” in its IPR petition. Plaintiff Nox Medical moved *in limine* for an order barring Natus from raising these combinations as estopped under § 315(e)(2).

Judge Richard Andrews held that, “for the combinations that Defendant tried to raise in the IPR, but which the PTAB did not institute, Defendant may pursue the combinations at trial. For those combinations ‘A in view of B’ on which the PTAB did not institute, I would regard that as reasonably raising ‘B in view of A’ also, and thus I reject Plaintiff’s assertions to the contrary.” Order at 2-3. In other words, under the court’s ruling, the ordering of references in an identical prior art combination is immaterial for purposes of estoppel under § 315(e)(2).

Nox Medical EHF v. Natus Neurology Inc., 1-15-cv-00709, Order (D. Del. April 12, 2018) (Andrews, J.)

Categories

District Court

35 U.S.C. § 315(e)(2) estoppel

Inter Partes Review

District of Delaware

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