

Estoppel Prevents Second IPR Petition Even When New References Were Missed By First Search

Article By:

Stephen B. Maebius

In a case that appears to be a case of first impression, the PTAB found in its [decision denying institution](#) in IPR2016-00781 that a final written decision in an earlier IPR created estoppel under 35 U.S.C. § 315(e)(1), preventing a second IPR petition from being instituted that used additional references which reasonably could have been raised before, even though the Petitioner explained how the new references were missed by the first search. In addition, the PTAB further denied institution using its discretion under 35 U.S.C. § 325(d) because the unpatentability grounds were essentially the same as in the earlier petition, although additional references were included.

Estoppel Is Keyed To Final Written Decision, Regardless of Appeal & Timing Of Second Petition

Neither the fact that the first IPR final written decision was subject to appeal at the time of the non-institution decision in the second IPR, nor the fact that the second IPR petition was filed prior to a final written decision in the first IPR, prevented estoppel. The timing was as follows:

- 3/23/16 – 2nd IPR petition filed
- 7/7/16 – final written decision in 1st IPR found certain claims patentable
- 8/25/16 – decision denying institution in 2nd IPR

It is important to recognize that estoppel under 35 U.S.C. § 315(e)(1) is keyed to the final written decision in an earlier IPR and does not apply if there is no final written decision, such as where the PTAB denies institution of a first IPR petition. However, in cases where an earlier IPR did not generate a final written decision, the PTAB may still deny a subsequent IPR petition using its discretion under 35 U.S.C. § 325(d) to deny based upon a related “proceeding” before the USPTO. See “[Estoppel v. Discretion: How is the PTAB Deciding Multiple Petitions Against the Same Patent?](#)”

References Reasonably Could Have Been Raised Earlier If Diligent Searching

Would Have Located Them

Although the PTAB has denied a second IPR petition after a final written decision in a first IPR (see IPR2015-00549), which it cited in its decision here, that earlier situation involved the same prior art references used in the earlier petition. By contrast, petitioner in the present case tried to argue that it could not have reasonably raised the grounds in this petition prior to uncovering the new references. However, the PTAB noted the following concerning the scope of estoppel under the America Invents Act:

The legislative history of the America Invents Act broadly describes grounds that “reasonably could have been raised” as encompassing “prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover.” 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl); see *id.* at S1376 (statement of Sen. Kyl) (“This [estoppel] effectively bars such a party or his real parties in interest or privies from later using inter partes review . . . against the same patent, since the only issues that can be raised in an inter partes review . . . are those that could have been raised in [an] earlier post-grant or inter partes review.”); 157 Cong. Rec. S952 (daily ed. Feb. 28, 2011) (statement of Sen. Grassley) (“It also would include a strengthened estoppel standard to prevent petitioners from raising in a subsequent challenge the same patent issues that were raised or reasonably could have been raised in a prior challenge.”).

The PTAB went on to analyze in considerable detail the circumstances alleged by Petitioner to have prevented it from locating the new references earlier:

Petitioner contends that “[d]espite conducting diligent searches, Praxair did not find the *Greenough* or *Jaypee* references prior to filing the first set of IPRs,” including IPR2015-00529. *Id.* at 15. We infer that these references came to Petitioner’s attention some time after they were cited by the Examiner during the prosecution of one or more applications related to the ’112 patent. See Pet. 15; Prelim. Resp. 18, 35; Ex. 2014, 3, 5, 21–23 (April 29, 2015, Office Action, Notice of References Cited, and Examiner’s Search Report for Application No. 14/454,373, each citing *Greenough* and *Jaypee*).

As evidence of diligence in searching the prior art, Petitioner submits Exhibit 1009, an “Exemplary List of Search Results from Cardinal Intellectual Property, Inc.” Pet. 15. But, as Patent Owner points out, Petitioner’s assertion that it did not find *Greenough* or *Jaypee* “[d]espite conducting diligent searches” is predicated on a single search report by an unidentified searcher of indeterminate skill and experience listing a mere fifteen “exemplary” search results. See Prelim. Resp. 18–19; Pet. 15; Ex. 1009. Petitioner does not, as Patent Owner points out, “identify the actual searcher, his or her skill level and experience in the field, [] why he or she searched using certain keywords and keyword combinations,” or explain whether either *Greenough* or *Jaypee* were encompassed by the initial search results but not selected for the exemplary list. Prelim. Resp. 19. On the record before us, we, therefore, find scant evidence that Praxair engaged “a skilled searcher conducting a diligent search” as contemplated in the legislative history. See 157 Cong. Rec. S1375.

Also at odds with Petitioner's assertion of diligence is Petitioner's contention that "a person of skill in the art would have been seeking out [Greenough and Jaypee] when trying to ascertain the collective academic thinking regarding iNO therapy as of the [earliest priority date]" of the '112 patent. Pet. 26. In addition, the testimony of Petitioner's technical expert, Dr. Lawson, evidences that the newly-asserted references are not obscure texts unlikely to be discovered upon a reasonably diligent search of the relevant prior art. In particular, Dr. Lawson states that:

A person of skill in the art interested in iNO treatment would have referred to the INOmax Label, *Greenough* and *Jaypee* as they are all part of a collected literature regarding treatment of patients with iNO. Anne Greenough, the author of *Greenough*, is a thought leader in this area. Moreover, the authors of *Greenough* and *Jaypee* are familiar with each other's works; for example, *Jaypee* cites other articles authored by Anne Greenough.

Ex. 1002 ¶ 51. Consistent with Dr. Lawson's testimony, Petitioner admits that "other articles by the author of *Greenough* were cited during prosecution" (Pet. 24, n.11), whereas Patent Owner provides evidence that Greenough is catalogued and accessible "at dozens of major libraries in the United States, including the Library of Congress, the National Library of Medicine, and the Harvard University Library," and that both textbooks are readily identified by searching Google Books using keywords from the '112 Patent specification. Prelim. Resp. 17–18 (citing Exs. 2003, 2008-2013).

PTAB Discretion Forms Additional Basis For Denial

Independently, the PTAB also found it was appropriate to deny the petition using its discretion under 35 U.S.C. § 325(d) because the unpatentability grounds were essentially the same as in the earlier petition, although additional references were included.

© 2025 Foley & Lardner LLP

National Law Review, Volume VI, Number 243

Source URL: <https://natlawreview.com/article/estoppel-prevents-second-ipr-petition-even-when-new-references-were-missed-first>