



THINK FORWARD

PTAB Denies A Second IPR Petition Based on Estoppel and Redundancy

The Patent Trial and Appeal Board (“Board”) denied a petition to institute an *inter partes* review (IPR) trial filed by the Petitioner, Praxair Distribution, Inc. (“Praxair”) and NOxBOX Limited (“NOxBOX”) based on estoppel under 35 U.S.C. § 315(e) (reproduced below). [Praxair Distribution, Inc. v. Ino Therapeutics, LLC, IPR2016-00781](#), Paper 10 (PTAB August 25, 2016) (the “second IPR petition”). The Board further exercised its discretionary authority under 35 U.S.C. § 325(d) (reproduced below) in denying the petition. *Id.*

35 U.S.C. § 315(e) Proceedings before the office. The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

35 U.S.C. § 325(d) Multiple proceedings. Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of any post grant review under this chapter, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the post-grant review or other proceeding or matter may proceed, including providing for the stay, transfer, consolidation, or termination of any such matter or proceeding. In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

The Petitioner filed an IPR petition to challenge patentability of U.S. Patent No. 8,846,112 (“the ‘112 patent”). Praxair had previously filed an IPR petition of the same patent (the “first IPR petition”), which resulted in a final written decision under 35 U.S.C. § 318(a). *Praxair Distribution, Inc. v. Mallinckrodt Hospital Prods. IP Ltd.*, IPR2015-00529, Paper 53 at 39-42, 46 (PTAB July 7, 2016). The later-filed second IPR petition targeted claims not held unpatentable in the final written decision of the first IPR petition based on a new set of prior art. In the second IPR petition, the Petitioner contended that despite conducting diligent searches, the Petitioner did not find the newly cited references prior to filing the first IPR petition. In response, the Patent Owner argued that Petitioner would be estopped from requesting the second IPR petition under 35 U.S.C. § 315(e), and Board should exercise its discretion and deny this petition under 35 U.S.C. § 325(d).

With respect to estoppel, the Board agreed with the Patent Owner and found that Praxair reasonably could have raised the newly asserted references during the earlier proceeding because (i) the Petitioner failed to establish that a skilled searcher conducting a diligent search would not have expected to discover the new references, and (ii) indeed, the new references were not obscure and unlikely to be discovered upon a reasonably diligent search of the prior art. *Praxair Distribution, Inc. v. Ino Therapeutics, LLC*, at 9-10. The Board noted that other articles by the same author of the new references were cited by the examiner during the prosecution of the ‘112 patent. In addition, the Board held that estoppel would apply to a named petitioner, as well as extend to a real party in interest or privy of the petitioner. The Board found that NOxBOX, which was not the named petitioner of the first IPR

petition, was a privy of Praxair, Inc, a real party in interest to the first IPR petition as well as the second IPR petition. *Id.* at 11-12.

With respect to redundancy, the Board found that even with the new references, the Petitioner's underlying argument was essentially the same as that raised in its first IPR petition. *Id.* at 12-13. Specifically, the new references were used to address the same claim limitations the Board previously accorded no patentable weight in the first IPR petition.

This decision provides clarity on the reach of estoppel during an IPR proceeding, and also highlights the importance of conducting a diligent and thorough prior art search. Any subsequent petition, even with a new prior art reference, will be subject to high scrutiny with respect to redundancy under 35 U.S.C. § 325(d) and estoppel under 35 U.S.C. § 315(e) if a subsequent petition is filed after the Board's final written decision.

Contact Us

Additional information about post-grant proceedings can be found on our [Post-Grant Patent practice group page](#).