

## FWD did not cause § 315 estoppel for earlier filed petition

SEPTEMBER 11, 2020

Intel Corp. v. Qualcomm, Inc., IPR2019-00047, Paper 34; IPR2019-00048, Paper 35; IPR2019-00049, Paper 33 (PTAB July 6, 2020). Before: Michelle N. Wormmeester, Scott B. Howard, and Aaron W. Moore.

Petitioner filed multiple petitions against the challenged patent over a two day period. The Board issued notices according filing dates to the later-filed IPRs about six weeks before issuing notices according filing dates to the first-filed IPRs. This put the later-filed IPRs on track to reach institution decisions and final written decisions before the first-filed IPRs.

The Board instituted trial on all petitions in both groups and, as scheduled, reached final written decisions on the later-filed IPRs before reaching final written decisions in the first-filed IPRs. Once the final written decisions on the later-filed IPRs issued, patent owner filed a motion to terminate review of the first-filed IPRs.

Patent owner argued that petitioner was estopped from maintaining the earlier-filed IPRs under 35 U.S.C. § 315 which provides that “[t]he petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision ... 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.” Patent owner reasoned that because petitioner was aware of the references in the earlier-filed IPRs as of the filing of the later-filed IPRs, that made the grounds of the earlier-filed petitions grounds that petitioner “reasonably could have raised” in the later-filed petitions. Because petitioner did not do so, that meant there should be an estoppel.

The Board denied the motion to terminate. The Board reasoned that the petitioner could not have reasonably raised the grounds of the earlier-filed petitions in the later-filed petitions. Nor had patent owner explained “why it would have been reasonable for the same petitioner to include the exact same grounds in two petitions challenging the same patent filed on successive days.” The Board also noted that a competent practitioner would not have done so given the risk of rejection under 35 U.S.C. § 325(d). This was especially so in light of *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018) because the repetitive grounds in this hypothetical later-filed petition might have caused the Board to also deny the novel grounds of the later-filed petitions.

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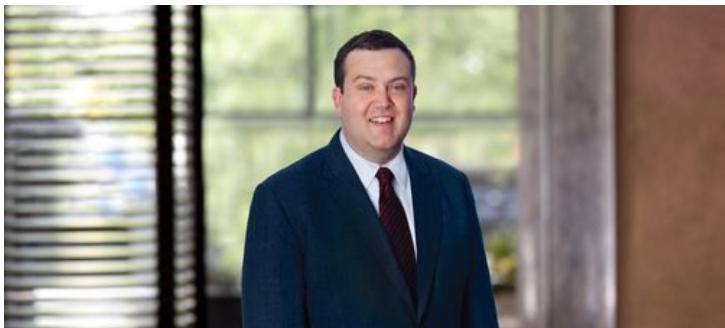
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