

Stipulation to not pursue in a parallel proceeding the same grounds or any grounds that could have been reasonably raised in an IPR weighs strongly in favor of institution

DECEMBER 31, 2020

Sotera Wireless, Inc. v. Masimo Corp., Case IPR2020-0109, Paper 12 (PTAB Dec. 1, 2020).

Before: Cocks, Chagnon, and Wieker.

Petitioner had filed a stipulation in a parallel district court proceeding that if the PTAB instituted IPR, the petitioner would not pursue in the district court proceeding the specific asserted grounds or any other ground that was raised or could have been reasonably raised in the IPR petition. In view of that stipulation, the Board found that the fourth *Fintiv* factor (issue overlap) weighed strongly against a discretionary denial of institution. Broad stipulations like this one ensure the IPR is a “true alternative” to the district court proceeding and mitigates any concerns of duplicative efforts between the district court and the Board.

The remaining *Fintiv* factors were largely neutral. The first factor (stay) was neutral because the District Court had not ruled on a pending motion to stay. The second factor (proximity of trial) was neutral because the district court trial was set to occur around the same time as the Board’s final written decision. The third factor (investment in parallel proceeding) was neutral as the parties had served infringement and invalidity contentions, but all Markman deadlines had been vacated and although the petition was filed near the end of the one-year window, the timing of the petition filing was reasonable in view of six months of settlement negotiations, the large number of patents and claims in this petition and other related petitions. The fifth factor (party overlap) weighed in favor of discretionary denial. And the sixth factor (other considerations) was neutral. Weighing the factors together, the Board granted institution because the Petitioner had demonstrated a reasonable likelihood of success on the merits.

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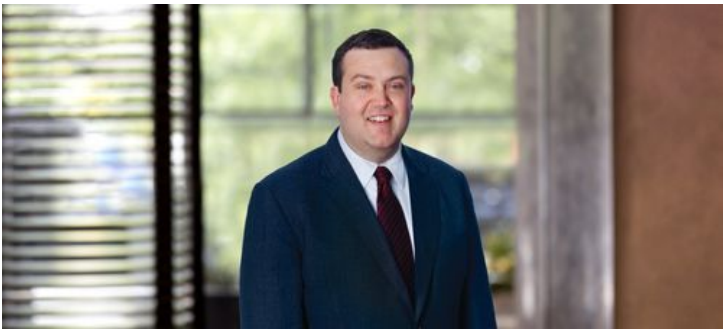
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