

Judge Albright Denies Defendant LG's Motion For Summary Judgment, Finding That IPR Estoppel Can Apply To System Prior Art

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On April 12, 2023, Judge Albright issued an omnibus pretrial-conference order holding, among other things, that LG was estopped from arguing its priority-date issue in district court due to a stipulation in a corresponding IPR proceeding. Therefore, the court denied LG's motion for summary judgment. Of importance, Judge Albright held that IPR estoppel can apply to system prior art.

Under 35 U.S.C. § 311(b), the scope of an *inter partes* review (IPR) is limited to prior art consisting of patents and printed publications. Under 35 U.S.C. § 315(e), the petitioner in an IPR that results in a final written decision is estopped from asserting that a claim is invalid on any ground that the petitioner raised or reasonably could have raised during the IPR.

In the present case, LG sought to use two system references—Ms. Hafeman's Retriever product and Apple's Find My iPhone—for an invalidity argument in district court that it could not have raised in the IPR proceeding.

Judge Albright held that although system references cannot be raised in an IPR proceeding, IPR estoppel still applies when the allegedly new references have "materially identical" disclosures to those of the IPR art.

Because Ms. Hafeman admitted that the Retriever product and Find My iPhone practice her patents, which were addressed in the corresponding IPR, Judge Albright held that there was "no substantive difference" between these alleged references.

Therefore, Judge Albright found that LG was estopped from arguing its priority-date issue in district court.

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