

***Intuitive Surgical, Inc. v. Ethicon LLC*, 25 F.4th 1035 (Fed. Cir. 2022) (O'Malley, Clevenger, Stoll)**

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Intuitive filed three IPR petitions, all on the same day, challenging Ethicon's endoscopic surgical instrument patent. The petitions challenged overlapping claims based on different combinations of prior art references. The Board instituted review of two petitions on the same day and of the third petition one month later, resulting in a different timeline for that IPR.

While the third IPR was pending, the Board issued final written decisions in the first two IPRs upholding the overlapping claims. Ethicon then filed a motion to terminate the third IPR, arguing that the Board's final written decisions barred Intuitive's IPR under 35 U.S.C. § 315(e)(1), which estops a petitioner following a final written decision from "request[ing] or maintain[ing]" a subsequent PTO proceeding with respect to grounds that the petitioner raised or reasonably could have raised during the earlier IPR. The Board agreed that Intuitive was estopped but decided that terminating the IPR without adjudicating the merits was inappropriate given the advanced stage of the proceeding. The Board thus issued a final written decision terminating Intuitive as a petitioner and upholding the claims on the merits.

Intuitive appealed, arguing that § 315(e)(1) estoppel does not apply to simultaneously filed petitions instituted on different timelines. The Federal Circuit disagreed and affirmed the Board's estoppel ruling. At the outset, the court determined that it had jurisdiction to review the estoppel ruling because the ruling was not a reconsideration of the institution decision but, rather, a "final" decision with respect to the IPR. Turning to § 315(e)(1), the court concluded that the statute "estops a petitioner as to invalidity grounds for an asserted claim that it failed to raise but 'reasonably could have raised' in an earlier decided IPR, regardless of whether the petitions were simultaneously filed and regardless of the reasons for their separate filing." The court determined that Intuitive knew of the prior art asserted in the third IPR at the time it

Section 315(e)(1) "estops a petitioner as to invalidity grounds for an asserted claim that it failed to raise but 'reasonably could have raised' in an earlier decided IPR, regardless of whether the petitions were simultaneously filed and regardless of the reasons for their separate filing."

filed the other two petitions and knew which claims it wanted to challenge based on that art. Accordingly, estoppel applied.

In so ruling, the court rejected Intuitive's argument that the Board's petition word limit prevented it from raising all grounds in the first two IPRs. Intuitive "could have made its challenges more pointed and specific so as to fit all of its grounds in two petitions satisfying the word limits," the court noted. And, in any event, Intuitive could have filed three full-length petitions while avoiding § 315(e)(1) by, for example, seeking consolidation, having each petition focus on separate claims, or requesting that the cases proceed to final written decision on the same timeline. The court also rejected Intuitive's argument based on *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293 (Fed. Cir. 2016), that the Board erred by focusing on whether invalidity grounds were raised in the petition rather than after institution. That argument, the court determined, is foreclosed by *California Institute of Technology v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022), which overruled *Shaw*.

Finally, the court determined that § 315(e)(1) was triggered as soon as the final written decisions in the first two IPRs issued, at which time Intuitive was no longer a party to the third IPR. And, because only IPR parties can appeal the merits of a final written decision, the Federal Circuit found that it lacked jurisdiction over Intuitive's merits appeal. The court thus dismissed the appeal without reaching the merits.

RELATED CASES

- *Click-to-Call Technologies LP v. Ingenio, Inc.*, 45 F.4th 1363 (Fed. Cir. 2022) (Stoll, Schall, Cunningham) (ruling that final written decision upholding certain claims estopped petitioner under § 315(e)(2) from asserting in district court the same prior art reference against a petitioned-for but non-instituted claim, where petitioner never sought post-SAS remand for institution of claim).
- *Hologic, Inc. v. Minerva Surgical, Inc.*, 44 F.4th 1358 (Fed. Cir. 2022) (Stoll, Clevenger, Wallach) (on remand from the Supreme Court, holding that assignor estoppel barred accused infringer from challenging validity of patent claim that was not "materially broader" than claim of a related, earlier-filed application that the accused infringer had indirectly assigned to the patentee but had cancelled during prosecution).
- *Google LLC v. Hammond Development International, Inc.*, 54 F.4th 1377 (Fed. Cir. 2022) (Moore, Chen, Stoll) (holding that patent owner was collaterally estopped from litigating validity of patent claim on appeal from an IPR based on the Board's intervening ruling in a different IPR invalidating claim of a related patent over the same art).

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