

## Services

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## Cumulative Device Art Allowed by the District of Delaware Following an IPR

Filing a petition for *inter partes* review (“IPR”) is a standard part of the playbook for defendants in patent litigation. One of the few risks for a petitioner is estoppel under 35 U.S.C. § 315(e)(2), which prohibits a petitioner who is unsuccessful on the merits from raising in district court “any ground that the petitioner raised or reasonably could have raised during that inter partes review.” By rule, a petitioner can only assert patents or printed publications as prior art in an IPR. 35 U.S.C. § 311(b). One issue that continues to arise is whether a petitioner/defendant, having lost in view of a prior art document it raised or reasonably could have raised, can assert a related product as prior art in district court under § 315(e)(2). This issue has split the courts and has been used by losing petitioners to get a second bite at the prior art apple. *See, e.g., Boston Sci. Corp. v. Cook Grp. Inc.*, 653 F. Supp. 3d 541, 593-94 (S.D. Ind. 2023) (holding that IPR estoppel applies to such device art).

The District of Delaware, which many courts and practitioners look to for guidance on patent issues, recently held IPR estoppel does not preclude use of a prior art device as prior art even if that device embodies a patent or printed publication a defendant petitioner raised or could have raised in a prior IPR. *See Prolitec Inc. v. Scentair Techs.*, Civil Action 20-984-WCB (D. Del. Dec. 13, 2023). Prolitec alleged ScentAir infringed two patents and ScentAir filed IPRs for those patents. *See id.* at 2. ScentAir owns a patent (the “Baylock patent”) which is prior art to the asserted patents. *Id.* at 8. The Baylock patent is commercially embodied in ScentAir’s ScentDirect product, which is itself similar to its ScentStream product. *Id.* ScentAir could have raised its Baylock patent in the IPRs but did not. *See id.* at 48. Prolitec thus argued in district court ScentAir should be estopped from asserting the ScentDirect and ScentStream products as prior art because they correspond to the Baylock patent. *Id.*

Writing for the Court, Judge Bryson noted, “[w]hen IPR proceedings result in a final written decision, 35 U.S.C. § 315(e)(2) precludes petitioners from raising invalidity grounds in a civil action that they raised or reasonably could have raised during that inter partes review.” *Prolitec Inc.*, Civil Action 20-984-WCB at 48. Judge Bryson then opined that there are two plausible ways to interpret the meaning of the term “grounds” in § 315. *Id.* at 50. One plausible way of interpreting “grounds” is that it “refers to the underlying legal arguments, which incorporate patents, printed publications, and cumulative device art.” *Id.* The alternative—and in Judge Bryson’s view, the proper way—is to interpret “grounds” to mean “the particular patents and printed publications on which invalidity arguments are based, and that the supporting affidavits, declarations, and the like are evidence, not ‘grounds.’” *Id.* Judge Bryson then ruled ScentAir could use its ScentDirect and ScentStream products as prior art. *Id.* at 51.

The proper scope of IPR estoppel is subject to conflicting decisions and continues to develop. It is critically important for plaintiffs and defendants to consider *what* and *when* printed prior art is used in connection with IPR proceedings for the purpose of downstream IPR estoppel. If you would like more information regarding the recent decision in *Prolitec v. ScentAir* or IPR estoppel, please contact [Jason S. Jackson](#), [Heather N. Tilley](#), or [Logan P. Murr](#).

