

# Seyfarth PTAB Blog



A legal look at Patent Trial and Appeal Board decisions and trends

## Estoppel is Not Invoked Simply Because Prior Art is Cumulative

*By Christopher A. Baxter*

After an Inter Partes Review (IPR) at the United States Patent and Trademark Office (USPTO) is completed, validity and/or infringement of the patent may subsequently be determined by a U.S. district court. This situation raises the significant issue of what prior art may be asserted in the district court suit. A district court in Illinois recently determined the mere fact that prior art is cumulative of IPR cited prior art does not foreclose the cumulative art from being used in a district court suit.

Clearlamp, LLC (Clearlamp) sued LKQ Corp. (LKQ) in the U.S. District court for the Northern District of Illinois alleging patent infringement of U.S. Patent No. 7,297,364 (the '364 Patent), titled "Method for Refurbishing Lamp Surfaces." *Clearlamp, LLC v. LKQ Corp.*, No. 12-C-2533, at \*1-2 (N.D. Ill. March, 18, 2016). After filing of the suit, Clearlamp and LKQ participated in an IPR, where some of the '364 Patent's claims were adjudicated valid over prior art references "Kuta," "Butt," and "Eastwood." *Id.* at \*1, \*3.

Once the IPR was concluded, Clearlamp and LKQ re-commenced litigation of the '364 Patent at the district court. LKQ argued some of the claims of the '364 Patent are invalid based on "UVHC3000" as applied in further combination (i.e., cumulatively) with the prior art cited in the IPR (i.e., Kuta, Butt, and Eastwood). *Id.* at \*6.

The issue decided by the court revolved around whether the estoppel provision of 35 U.S.C. § 315(e)(2) allows additional prior art to be combined with prior art cited in a previous IPR to invalidate claims in a district court litigation. Clearlamp argued LKQ was estopped from raising UVHC3000 as prior art in the civil action based on 35 U.S.C. § 315(e)(2), which provides the "petitioner in a post-grant review of a claim in a patent . . . may not assert . . . in a civil action . . . that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that post-grant review." Specifically, Clearlamp argued "unavailable prior art that is cumulative of available prior art is estopped by § 315(e)(2) from being used during subsequent district court proceedings." *Id.* at \*15. LKQ responded, stating Clearlamp's position unlawfully extends the provisions of § 315(e)(2) beyond any ground a petitioner reasonably could have raised (which is explicitly provided in the statute), to include "any ground based on the same underlying theory as grounds the petitioner reasonably could have

raised.” *Id.* at \*15-16 (internal quotation marks omitted). The district court stated the relevant inquiry “is not whether the ground is redundant [or cumulative] of a ground that was asserted but, rather, whether the ground reasonably could have been raised.” *Id.* at \*16.

Since Clearlamp raised the issue of estoppel, Clearlamp had the burden of proof to establish that “a skilled searcher’s diligent search would have found the UVHC3000 [reference].” *Id.* at \*18. To satisfy this burden, Clearlamp could have (1) identified a search string and source that identified UVHC3000 and (2) presented expert testimony that such a search string and source would be used by a skilled searcher performing a prior art search with respect to the ‘364 Patent. *Id.* The district court determined Clearlamp failed to satisfy its burden because Clearlamp did not identify a search string and source that identified UVHC3000, and also failed to present expert testimony. *Id.* Without such evidence, Clearlamp was “left arguing that a skilled searcher’s diligent search would have found cumulative pieces of prior art and, therefore, LKQ should be estopped from using” UVHC3000 in the district court litigation. *Id.* at \*18-19. However, the court rebuffed this position, stating “merely being cumulative of other prior art does not invoke § 315(e)(2) estoppel.” *Id.* at \*19.

## Takeaways

If claims of a patent are adjudicated valid in an IPR proceeding, a party may subsequently attempt to invalidate the claims in a district court by cumulatively adding prior art to previously relied upon art. However, such a strategy should be pursued cautiously as cumulative prior art may only be relied upon if it could not have reasonably raised in the previous IPR proceeding. With estoppel being a malleable “reasonableness” standard, a party would be well-served to put forth its best arguments in the first instance, and only rely upon cumulative art if necessary.

[Christopher A. Baxter](#) is an author of the Seyfarth PTAB Blog and Staff Attorney in the firm’s Boston office. For more information, please contact a member of the [Patent Practice Group](#), your Seyfarth Shaw LLP attorney or Christopher A. Baxter at [cbaxter@seyfarth.com](mailto:cbaxter@seyfarth.com).

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Seyfarth Shaw LLP PTAB Blog | April 12, 2016

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