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DISTRICT COURT CASES

Claim Construction in PTAB Order Denying Petition for Inter Partes Review Does Not Have Preclusive Effect in District Court

On December 15, 2015, Judge Sleet in the District Court for the District of Delaware denied Defendant's motion to modify the court's earlier claim construction in view of a Patent Trial and Appeal Board (PTAB) order denying institution of an Inter Partes Review (IPR) directed to one of the asserted patents. In its IPR petition, defendant provided a claim construction for "with respect to a route path" that was similar to its construction previously presented to, and rejected by, the district court.

In its preliminary response, Patent Owner stated that it disagreed with Defendant's construction, but did not provide a separate construction. It then argued that the claims were not anticipated. The PTAB agreed with Patent Owner and denied the petition. Defendant then filed a motion to modify the court's claim construction, arguing that collateral estoppel should apply, because the PTAB relied on its claim construction in denying the IPR petition.

The court held that the PTAB's choice not to institute an IPR is not the type of adjudication that leads to issue preclusion. The court also noted that *without analysis*, the court adopted the defendant's construction in finding that the presented prior art did not anticipate the claims. The fact that the Patent Owner did not provide the PTAB with any construction did not weigh in favor of issue preclusion in a preliminary proceeding.

Adidas AG et al v. Under Armour Inc., No. 1-14-cv-00130 (D. Del. Dec. 15, 2015).

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