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'Reverse-Engineered' Search String Insufficient to Establish PGR Estoppel

February 16, 2024

Reading Time : **2 min**

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Southern District of New York Judge Colleen McMahon recently denied a plaintiff's request to apply post-grant review (PGR) estoppel to two prior art references asserted by the defendant. In doing so, Judge McMahon explained that presenting search strings that identify the prior art is insufficient on its own to establish that the prior art "reasonably could have [been] raised" in the PGR.

Under 35 U.S.C. § 325(e)(2), if a patent claim survives a final written decision in PGR proceedings, the PGR petitioner may not assert in district court "that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that post-grant review."

In *GeigTech East Bay LLC v. Lutron Electronics Co., Inc.*—a patent infringement suit involving window shade brackets—GeigTech argued that Lutron should be estopped from asserting the "Kirsch" and "Cid Quintas" prior art patents because Lutron "reasonably could have raised" them in its PGR petition against the patent-in-suit. To support its position, GeigTech identified "search strings" that turned up the two references in Google Patents. Lutron countered that search strings alone are insufficient to establish what it "reasonably could have raised" in the PGR.

Before siding with Lutron, the court first grappled with the meaning and scope of "reasonably could have raised" under § 325(e)(2). According to the Federal Circuit, "reasonably could have raised" includes references "that a petitioner actually knew about or that a skilled searcher conducting a diligent search reasonably could have been expected to discover." But "the Federal Circuit has not refined exactly what facts or circumstances qualify as 'a skilled

searcher conducting a diligent search.'" Judge McMahon therefore looked to other district courts, which have concluded that the movant must satisfy two prongs to meet the Federal Circuit's "skilled searcher" standard:

> (1) identify the search string and search source that would identify the allegedly unavailable prior art; and
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> (2) present evidence, likely expert testimony, why such a criterion would be part of a skilled searcher's diligent search.

The court declined to apply PGR estoppel to the Kirsch and Cid Quintas patents because GeigTech failed to satisfy the second prong of this test. As Judge McMahon explained, "GeigTech's 'evidence' consists solely of the search strings that were selectively assembled by its own attorneys to bolster *ex post facto* arguments." In other words, "GeigTech essentially 'reverse engineered' its search terms" by looking at terms in the identified prior art references. On these facts, "one cannot infer that a skilled researcher would have found the [prior art]."

Practice Tip: To establish PGR estoppel under § 325(e)(2)—and IPR estoppel under § 315(e)(2)—practitioners should consider presenting actual evidence, such as expert testimony, showing that a skilled searcher conducting a diligent search reasonably could have been expected to discover the prior art. Showing that the prior art could have been found with a search string—particularly when the search string is "reverse engineered" from the prior art—is not sufficient.

GeigTech Easy Bay LLC v. Lutron Electronics Co., Inc., slip op., No. 18 Civ. 05290 (CM) (S.D.N.Y. Dec. 21, 2023).

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