

Patent Buyers Beware—Former Owner of a Patent Can Challenge Its Validity in an Inter Partes Review

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The Patent Trial and Appeal Board (PTAB) recently held that a former owner and the co-inventor of a patent may challenge the validity of the patent in an inter partes review after assigning the patent to a new owner and the U.S. Court of Appeals for the Federal Circuit held that it did not have jurisdiction to review the appeal of that decision. Prior to these decisions, patent acquirers traditionally could rely on the doctrine of assignor estoppel to prevent a patent assignor from later challenging the assigned patent's validity and these decisions now prevent that doctrine from being used as a defense to an inter partes review challenge. Recommendations for mitigating the risks posed by these decisions are discussed below.

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