**Infringer Estoppel is Equitable and Best Serves the Public’s Interests**

Estoppel occurs when “a man’s own act or acceptance stoppeth or closeth up his mouth to allege or plead the truth.” At its core, estoppel bars the assertion of any fact contrary to what has already been established as the truth by a party’s representations.

Various patent-specific types of estoppel are available. For example:

**Assignor Estoppel** - prevents a patent seller from attacking their own patent’s validity.

**Licensee Estoppel** - prevents a licensee from denying the validity of his licensor’s patent.

The infringer should likewise be estopped from denying the validity of the infringed patent when the infringer creates the same circumstance that estops the licensee from denying the validity of his licensor’s patent.

The Licensee is further estopped from clawing back any licensing fees previously paid or due under an existing licensing agreement even after the claims are subsequently found to be invalid.

The district court in Studiengesellschaft Kohle, M.B.H. v. Shell Oil Co. confirmed this:

"Further, the district court certified the following question under 28 U.S.C. § 1292(b) (1994): Where the Court has found the relevant patent claims invalid, may the Licensor recover damages for breach of contract for past royalties due on processes allegedly covered by such claims, from the date of the alleged breach until the date that the Licensee first challenged validity of the claims?  
...  
Finally, this court answers the certified question in the affirmative."

Likewise – and notwithstanding the Willful Infringer’s declining to sign a licensor’s agreement – at the moment the Willful Infringer begins to use the patent, he creates the same contract with the licensor (albeit a unilateral contract, but legally enforceable just the same) that estops the licensee from escaping the same licensing fees that the Infringer avoids through his negligence, and that the Willful Infringer avoids intentionally.

Fairness considerations would reason that the infringer’s conduct should estop the infringer, the same as it already estops the licensee, from denying the validity of the claims, and from avoiding any equitable licensing fees at the very least “from the date of the breach until at least the date that the Infringer first challenged the validity of the claims.”

This would require the court to stay an alleged infringer’s invalidity claim in order to initially consider some of the evidence related to the alleged infringement including whether the alleged infringer acted willfully.

**The Public’s Interest is Paramount**

A wrongfully awarded patent is the creation of an unjust private monopoly on an idea that rightfully belongs in the public domain.

The infringer should not be allowed to enjoy the benefits of the private monopoly created by another’s patent, whether through neglect or intent, and then to later claim that the idea rightfully belongs in the public domain.

Importantly, Infringer Estoppel would serve the public’s interest by discouraging both the ignorant and the willful concealment of questionable patents, and by encouraging earlier challenges to questionable patents.