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IPR SPOTLIGHT SERIES: STRATEGICALLY USING REQUESTS FOR JOINDER IN IPR

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Inter partes review (IPR) before the Patent Trial and Appeal Board (PTAB) became available on September 16, 2012 as a post-grant review procedure to challenge the patentability of issued claims based on prior art patents and publications. To help navigate the uncharted waters of this procedure, each edition of *IP Buzz- Post Grant Practice* will include an installment of our new *IPR Spotlight Series*, where we will feature a specific event on the **IPR timeline**, from filing the petition for IPR through oral hearing and final written decision. We will present an overview of the featured filing or procedure, along with practice tips and strategy informed by recent PTAB decisions, statistics, and practical experience. In our fourth IPR Spotlight installment, we focus on strategically using requests for joinder in IPR.

Part 4: Strategically Using Requests for Joinder in IPR

The Leahy-Smith America Invents Act (AIA) permits joinder of like review proceedings involving the same patent. For instance, an IPR of a particular patent may be joined with another IPR for the same patent, or a post-grant review (PGR) of a particular patent may be joined with another PGR of the same patent. Requests for joinder are commonly used by joint defendants in district court patent litigation to ensure that an IPR proceeding will continue even if the patent owner settles with one defendant involved in the IPR. However, there are many other scenarios in which both petitioners and third parties can use joinder to their advantage during IPR.

Joinder 101

After an IPR has been instituted, the PTAB has discretion to join other parties that have filed a petition for IPR of the same patent,¹ in addition to having broad discretion to “stay, transfer, consolidat[e], or terminat[e]” any other proceeding at the USPTO involving the patent pending resolution of the IPR.² If a third party seeks to join an instituted IPR proceeding, that party must file its own petition for IPR, along with a request for joinder.³ The request should:

1. Set forth reasons why joinder is appropriate;
2. Identify any new grounds of unpatentability asserted in the petition;
3. Explain what impact, if any, joinder would have on the trial schedule for the existing review; and
4. Address specifically how briefing and discovery may be simplified.⁴

A petition for IPR must be filed no more than one year after the date on which the petitioner is served with a complaint in district court alleging infringement of the patent.⁵ Interestingly, this time limit *does not apply* to a petition filed along with a request to join a proceeding that the PTAB has already instituted. Instead, the potential challenger has one month after the institution date of the IPR for which joinder is requested to file the motion for joinder.⁶ Similarly, the one-year time limit for the PTAB to issue the final determination in an IPR after the decision to institute may also be extended to accommodate joinder.⁷

There are several scenarios in which both petitioners and third parties should consider requesting joinder as a part of their IPR strategy:

1. Third Party Joining as a Second Petitioner to an Instituted IPR

Once the PTAB has instituted an IPR, a third party also seeking to challenge the patent-at-issue should consider filing its own petition for IPR along with a request to join the instituted proceeding.⁸ The PTAB

has discretion to join these proceedings in order to promote administrative efficiency and avoid duplicate proceedings.⁹

In deciding whether to grant joinder, the PTAB primarily considers impact on the trial schedule for the existing review, as well as the existence and extent of new grounds of unpatentability. The more similar the scope of the challenged claims, grounds for unpatentability, and references used in the two petitions, the more likely that the motion to join will be granted.¹⁰ On the other hand, if joinder would have a significant impact on the schedule of the instituted proceedings, the PTAB is much less likely to grant it. To that end, even when the PTAB grants joinder, the PTAB may decide to institute procedural safeguards to limit the second petitioner's role in the proceedings and ensure that joinder actually accomplishes the goal of administrative efficiency.

For example, in *Dell Inc. v. Network-1 Security Solutions, Inc.*,¹¹ the third-party petitioner sought to join an instituted IPR proceeding, asserting the same grounds of unpatentability in its petition as those on which the trial was instituted.¹² In addition, the third-party petitioner agreed to procedural protections to minimize the impact of joinder, including consolidating the filings of the two petitioners, and limiting any separate filing by the third-party petitioner to seven pages.¹³ The PTAB granted the request for joinder under these conditions, and only extended the existing deadlines by two weeks to allow the proceeding to be completed within one year.¹⁴ Here, the PTAB emphasized a "policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding."¹⁵

2. Petitioner Joining Its Own IPR to Include Recently Asserted Claims

If a patent owner asserts additional claims against a petitioner in a parallel district court litigation after a petition for IPR was filed, the petitioner should consider filing a second petition in order to broaden the IPR to include those claims. Once the one year window after the filing of the complaint closes, the petitioner must file the second petition along with a request for joinder with the instituted proceeding in order to avoid being time barred.

For example, in *Microsoft Corporation v. Proxyconn, Inc.*,¹⁶ the petitioner challenged three patent claims asserted against it by the patent owner in district court litigation. After the first petition was filed, the patent owner asserted three additional patent claims against the petitioner. The PTAB granted the first petition for IPR, and the petitioner then filed a second petition challenging all six claims: three new claims, and the three previously challenged claims on different grounds.¹⁷ The PTAB granted the petitioner's motion for joinder, finding that because the same patents and parties were involved in both proceedings, and because there was an overlap in prior art, joinder would ensure "the just, speedy, and inexpensive resolution of a proceeding."¹⁸ In addition, the PTAB found "no discernible prejudice" to either party in joining the proceedings because both parties agreed to the requested joinder. Lastly, the PTAB cited no undue delay, although "some adjustments to the schedule [were] necessary."¹⁹

3. Petitioner Joining Its Own IPR After Request for Rehearing is Denied

A petitioner should also consider filing a second petition along with a request for joinder if the PTAB has instituted IPR only on certain claims, or on certain grounds, and the petitioner seeks to broaden the scope of the proceedings. If the petitioner has already filed a motion for rehearing to include the additional claims or grounds for unpatentability and been denied, the one-year time bar to file a second petition for IPR may already have elapsed. At that point, the only way for the petitioner to file a second petition would be to request joinder with the instituted proceeding, to avoid being time barred. However, unlike a third party seeking to join an IPR proceeding, a petitioner seeking to broaden the scope of its own instituted IPR proceeding by joining a second petition is *less* likely to succeed the more similar the scope of the challenged claims, grounds for unpatentability, and references used in the two petitions.

A petitioner cannot avoid **redundancy issues** merely by filing multiple petitions in order to present multiple challenges to the same claims. In *Microsoft Corporation v. SurfCast, Inc.*,²⁰ the petitioner challenged a number of patent claims asserted against it by the patent owner in district court on several grounds, including anticipation. The PTAB denied as redundant the grounds of unpatentability, and then denied the petitioner's request for rehearing on the same. As a last resort, the petitioner filed a second petition seeking IPR based on the same grounds of unpatentability along with a motion for joinder. The PTAB denied the petitioner's request to join its second petition with the already-instituted proceeding, reasoning that the second petition failed to identify any new grounds of unpatentability, and joinder would significantly impact the schedule of the instituted IPR.

The Future of Joinder in IPR

In addition to the PTAB's broad discretion to stay, transfer, consolidate, or terminate any other proceeding at the USPTO involving the same patent pending resolution of an IPR, 37 C.F.R. § 42.5 grants the PTAB authority to "determine a proper course of conduct in a proceeding for any situation not specifically covered," and even to "waive or suspend a requirement of [part 42 of the PTAB's rules]." This extensive authority to advance the goal of "just, speedy, and inexpensive resolution of a proceeding" lends an element of unpredictability to the way in which multiple AIA trials, reexaminations, and reissues involving the same patent will be handled by the PTAB, regardless of whether a petitioner files a request for joinder.

On June 27, 2014, the USPTO **published a notice in the Federal Register** seeking feedback about the AIA trials, including IPR, in order to revisit and revise the trial proceeding rules and trial practice guide. Out of the seventeen areas on which the USPTO is "especially interested in receiving public comment," seven involve how multiple proceedings before the PTAB should be handled. Accordingly, we may soon see significant changes, and hopefully increased predictability, in the ways in which the PTAB handles requests for joinder and other issues arising from multiple proceedings involving the same patent.

¹35 U.S.C. § 315(c).

²35 U.S.C. § 315(d); see also 37 C.F.R. § 42.122(a) (implementing 35 U.S.C. § 315(d)).

³See *U.S. Bancorp v. Retirement Capital Access Management*, CBM2013-00014, Paper 8 at 3 (June 5, 2013) (holding that the 37 C.F.R. § 42.222(b) [CBM provision corresponding to 37 C.F.R. § 42.122(b) for IPR] "[j]oinder may be requested by a patent owner or petitioner" does not authorize joinder of parties to an already-filed petition without the filing of an additional petition).

⁴See *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013).

⁵35 U.S.C. § 315(b).

⁶37 C.F.R. § 42.122(b).

⁷35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c).

⁸37 C.F.R. § 42.122(b).

⁹35 U.S.C. § 315(d).

¹⁰See, e.g., *Motorola Mobility v. Softview*, IPR2013-00257, Paper 10 (June 20, 2013) (granting third-party petitioner's request for joinder where third-party petition asserted the same grounds of unpatentability on which the PTAB had instituted the IPR).

¹¹IPR2013-00385, Paper 17 (July 29, 2013).

¹²*Id.* at 7.

¹³*Id.*

¹⁴*Id.* at 8.

¹⁵*Id.* at 10.

¹⁶IPR2013-00109, Paper 15 (Feb. 25, 2013).

¹⁷IPR2013-0019, Paper 7 at 4 (Jan. 11, 2013).

¹⁸*Id.* at 4, citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48758 (Aug. 14, 2012).

¹⁹*Id.*

²⁰IPR2014-00271, Paper 20 at 8 (June 13, 2014).