



Inter Partes Review

Recent PTAB Precedential & Informative Decisions on Institution

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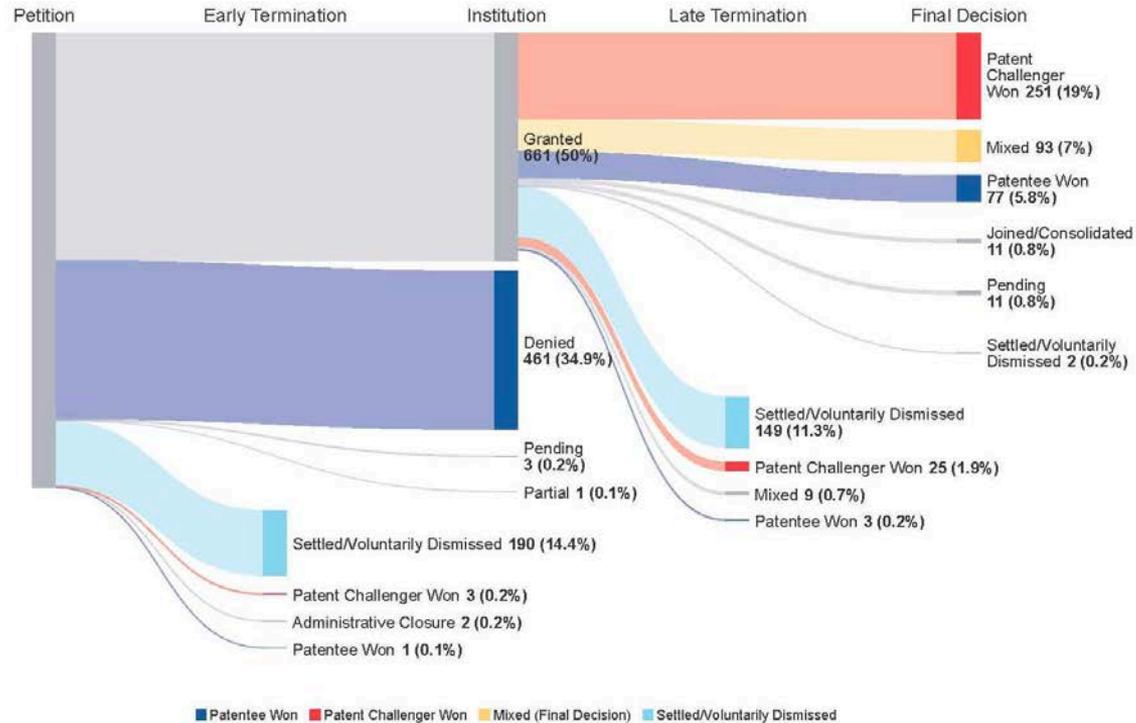
Inter Partes Review: Overview

Trial Proceeding Timeline



Institution
Decision

IPR: Statistics (Petitions Filed in 2019)



IPR: Institution is a **Discretionary** Decision

35 U.S.C. § 314(a) “**THRESHOLD**”:

The Director **may** not authorize an inter partes review to be instituted unless the Director determines that ... there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

35 U.S.C. § 314(d) “**NO APPEAL**”:

The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.

See also Cuozzo Speed Technologies, LLC v. Lee, 136 S.Ct. 2131, 2140 (2016).

IPR: Institution – Parallel Litigation

FINTIV Factors (since 5/5/2020)

[1] Stay of Parallel Litigation

[4] Overlap Between Issues

[2] Trial Date vs. Final Written Decision

[5] Petitioner / Defendant Same Party

[3] Investment in Parallel Litigation

[6] Other Circumstances

FINTIV Factor #1: Stay of Parallel Litigation

Snap, Inc. v. SRK Technology LLC (IPR2020-00820) (Granted)

A stay overrides all other Fintiv factors!

[T]he District Court's stay of the litigation pending denial of institution or a final written decision allays concerns about inefficiency and duplication of efforts. The granting of a stay pending inter partes review has weighed **strongly** against exercising discretion to deny institution under NHK.

Apple Inc. v. Fintiv, Inc. (IPR2020-00019) (Denied)

In some cases, there is no stay, but the district court has denied a motion for stay without prejudice and indicated to the parties that it will consider a renewed motion or reconsider a motion to stay if a PTAB trial is instituted. [This] suggests the district court may be willing to avoid duplicative efforts and await the PTAB's final resolution of the patentability issues raised in the petition before proceeding with the parallel litigation. This fact has usually weighed against exercising authority to deny institution under NHK ...

FINTIV Factor #1: Stay of Parallel Litigation

Recent Illustrative Examples

Case	Amazon.com, Inc v. Freshhub, LTD., IPR2020-01145, Paper 10 (PTAB Jan. 11, 2021).
Petitioner's Arguments	The petitioner sought inter partes review on substantially parallel litigation although it had not yet sought a stay. Petitioner argued that it would seek a stay if review is granted. The petitioner did not argue for the possibility of a stay if one was to be sought.
Patent Owner's Response	Patent Owner argued in response that there's no evidence that the District Court would stay the litigation and that the court has denied stays in similar circumstances.
Board's Analysis:	The Board refused to speculate on whether a stay would be granted if sought. The Board ruled that since neither party requested a ruling on a stay, this factor is neutral.

FINTIV Factor #1: Stay of Parallel Litigation

Recent Illustrative Examples

Case	Samsung Elec., Co., LTD., v. Clear Imaging Research, LLC, IPR 2020-01402, Paper 12 (Mar. 4, 2021).
Petitioner's Arguments	Petitioner sought <i>inter partes</i> review after being denied a stay without prejudice in the parallel litigation. Petitioner argued that if the Board permits a review, it is likely that a stay will be granted in the parallel proceeding. Petitioner presented evidence that the court has granted stays in proceedings on the same timeline.
Patent Owner's Counter	Patent Owner argued the court in the parallel litigation is unlikely to grant a stay because stays are disfavored pending inter partes review in that jurisdiction. Additionally, the court itself stated that a stay would prejudice the Patent Owner.
Board's Analysis:	<p>The Board declined to speculate on how another court would handle a stay request. In addition, the parties were a few weeks from jury selection. It ruled that the duplicative efforts of an <i>inter partes</i> review would waste time, money and effort that had already been put into the parallel proceeding. The Board did note however that although the court initially denied Samsung's stay request, Samsung was free to bring the request for stay again to the court.</p> <p>The Board was not swayed by the possibility of another stay request and finds that factor weighed slightly in favor of exercising their discretion to deny petition.</p>

FINTIV Factor #2: Trial Date vs. Final Written Decision

Apple Inc. v. Fintiv, Inc. (IPR2020-00019) (Denied)

Because the currently scheduled District Court trial [in the W.D. Tex.] is scheduled to begin two months before our deadline to reach a final decision, this factor weighs somewhat in favor of discretionary denial in this case.

Sand Revolution II, LLC v. Continental Intermodal ... LLC (IPR2019-01393) (Granted)

Multiple continuations of the case schedule and trial date result in a “currently scheduled trial date [that] is in relatively close proximity to the expected final decision in” the IPR and an “uncertainty that continues to surround the scheduled trial date.” Thus, “this factor weighs marginally in favor of not exercising discretion to deny institution.”

In a rocket docket jurisdiction, a defendant should consider filing a petition for IPR as soon as it is sued, without waiting for the patentee’s infringement contentions.

FINTIV Factor #2: Trial Date vs. Final Written Decision

Recent Illustrative Examples

Case	Amazon.com, Inc v. Freshhub, LTD., IPR2020-01145, Paper 10 (PTAB Jan. 11, 2021).
Petitioner's Argument	Petitioner argued that there was no firm trial date, and severe delays in the court's docket, with scores of older cases already facing continuances. Petitioner noted that its case had been transferred from another district and also argued that the possibility of the trial date being moved was high because the Covid-19 pandemic backlog.
Patent Owner's Arguments	Patent Owner argued that the trial date had been set and there had been significant progress in the court. It also contended that a decision from the Board would not be issued until after the existing trial date. Additionally, the possibility of an appeal could extend the matter for more than a year.
Board's Analysis:	The Board found the Petitioner's assumption that the trial date would be impacted due to the Covid-19 pandemic reasonable. However, since the trial date remained unchanged at the time of the ruling they determined that this factor weighed in favor of exercising their discretion to deny the Petition.

FINTIV Factor #2: Trial Date vs. Final Written Decision

Recent Illustrative Examples

Case	Samsung Elec., Co., LTD., v. Clear Imaging Research, LLC, IPR 2020-01402, Paper 12 (Mar. 4, 2021).
Petitioner's Argument	Petitioner argued that the Eastern District of Texas is a busy court known to push out proceedings. With the addition of delays due to the Covid-19 pandemic, it is more than likely the court date will be delayed and pushed out after the final written decision is due.
Patent Owner's Arguments	Patent Owner contended that the trial date was set and although some scheduling changed, the trial date had not moved. Further, with the current trial date being 11 months before a final written decision was due, it is extremely unlikely that the trial date would be pushed out far enough to coincide with the final written decision.
Board's Analysis:	The Board agreed with Patent Owner and takes "trial schedules at face value absent some strong evidence to the contrary." Although acknowledging with the presence of an extraordinary circumstance such as the Covid-19 pandemic, this factor would still weigh in favor of exercising their discretion to deny institution.

FINTIV Factor #3: Investment in Parallel Litigation

Apple Inc. v. Fintiv, Inc. (IPR2020-00019) (Denied)

[I]f, at the time of the institution decision, the district court has issued substantive orders [e.g., a preliminary injunction] related to the patent at issue in the petition, this fact favors denial. Likewise, district court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.

After 3 Markman briefs by each party, a Markman hearing, a 34 page Markman order construing 7 claim terms, and final infringement and invalidity contentions, the PTAB held “that much work remains in this case as it relates to invalidity,” such that “this factor weighs somewhat in favor of discretionary denial in this case.”

Sand Revolution II, LLC v. Continental Intermodal ... LLC (IPR2019-01393) (Granted)

But a two page Markman order construing each disputed term as its plain and ordinary meaning shows the court “has invested little time into considering the merits of any invalidity positions.”

FINTIV Factor #3: Investment in Parallel Litigation

Recent Illustrative Examples

Case	Amazon.com, Inc v. Freshhub, LTD., IPR2020-01145 (PTAB Jan. 11, 2021).
Petitioner's Arguments	Petitioner argued there have been no substantial arguments nor rulings thus far in the parallel proceeding, and neither the court nor litigants have invested substantial time in the case. Id
Patent Owner's Response	Patent Owner contended that there had been significant progress in the parallel proceeding and both parties have invested significant time and resources in discovery. Patent Owner further argued that by the time the Board issued any order regarding institution, the discovery process would be near closure. In addition, the District Court had already issued its claim construction order, investing substantial time in the case.
Board's Analysis:	The Board found there was little progress in the District Court with discovery ongoing but recognized the effort taken with issuance of the claim construction order. The Board concluded this factor weighed slightly in favor of exercising discretion to deny institution.

FINTIV Factor #3: Investment in Parallel Litigation

Recent Illustrative Examples

Case	Samsung Elec., Co., LTD., v. Clear Imaging Research, LLC, IPR 2020-01402, Paper 12 (Mar. 4, 2021)
Petitioner's Arguments	Petitioner argued that the District Court proceedings are in the early stages and there has been no significant investment by other parties. Petitioner further argued that they have invested significant resources in inter partes review proceeding which should weight in favor of exercising the Board's authority.
Patent Owner's Response	Patent Owner counters that investments made for the inter partes review is not relevant here. Additionally, although in its early stages, significant progress will be made in the parallel litigation by the time of the Board's institution decision.
Board's Analysis:	The Board agreed with Patent Owner. The Board found there has been progress in the parallel litigation and by the time of the institution decision, there would have been a significant investment by both parties and the District Court. Therefore, this factor weighs strongly in favor of exercising discretion to deny institution.

FINTIV Factor #3^{1/2} : Diligence in Filing Petition

The third *Fintiv* factor also considers whether the defendant worked diligently on the petition.

Apple Inc. v. Fintiv, Inc. (IPR2020-00019) (Denied)

[I]t is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding. **Thus, the parties should explain facts relevant to timing.** If the evidence shows that the petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted, this fact has weighed against exercising the authority to deny institution under NHK. If, however, the evidence shows that the petitioner did not file the petition expeditiously, such as at or around the same time that the patent owner responds to the petitioner's invalidity contentions, or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial.

In a rocket docket jurisdiction, waiting for infringement contentions before preparing a petition for IPR may result in a final written decision deadline after the trial date, which favors denial. Get a head start by working on at least all independent claims in the asserted patent(s).

FINTIV Factor #3^{1/2} : Diligence in Filing Petition (cont'd)

Sotera Wireless, Inc. v. Masimo Corp. (IPR2020-01019) (Granted)

Petitioner filed its Petition approximately two months after serving its initial invalidity contentions, and approximately two weeks before the statutory deadline. Based on the facts present here, we find that Petitioner's explanation for the timing of the Petition is reasonable, notwithstanding the closeness to the statutory deadline, particularly in view of the large number of patents and claims challenged in this and Petitioner's other related petitions for inter partes review, as well as the increased difficulty in preparing the Petitions due to concurrent [COVID-19] office closures.

FINTIV Factor #4 : **Overlap Between Issues**

Apple Inc. v. Fintiv, Inc. (IPR2020-00019) (Denied)

Petitioner's assertion of additional invalidity contentions in the District Court is not relevant to the question of the degree of overlap for this factor. Further, the fact that Petitioner has not decided whether to pursue the art from this proceeding in its expert discovery or at trial in the District Court is not persuasive. The same art is presented in Petitioner's final invalidity contentions, which are extremely detailed and developed. Thus, because the identical claims are challenged based on the same prior art in both the Petition and in the District Court, this factor weighs in favor of discretionary denial in this case.

FINTIV Factor #4 : **Overlap Between Issues** (cont'd)

Sotera Wireless, Inc. v. Masimo Corp. (IPR2020-01019) (Granted)

Petitioner broadly stipulated in the parallel litigation that it would not pursue “any ground raised or that could have been reasonably raised” in the IPR **if instituted**. The PTAB found that this “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.”

This stipulation does not give up any rights!

35 U.S.C. § 315(e)(2):

The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a) ... may not assert ... in a civil action arising in whole or in part under section 1338 of title 28 ... that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

FINTIV Factor #4: Overlap Between Issues

Recent Illustrative Examples

Case	Samsung Elec., Co., LTD., v. Clear Imaging Research, LLC, IPR 2020-01402, Paper 12 (Mar. 4, 2021).
Petitioner's Arguments	Petitioner stipulated that it will not pursue invalidity challenges at the district court if the board instituted review, therefore eliminating the risk of duplicating efforts. Additionally, there were 26 additional claims being raised in the petition.
Patent Owner's Response	Patent Owner contended that Petitioner's stipulation would not be effective since there are additional grounds addressed at the district court that were not in the Petition. Additionally, by the time the Board would reach a decision, there would have been significant efforts by the district court on the invalidity grounds.
Board's Analysis:	The Board found that even with Petitioner's stipulation, there would have been significant overlap in the two proceedings since the overlapping claims are based on the same prior art in both the Petition and in the parallel litigation. The Board found that factor four weighed slightly in favor of exercising discretion to deny institution.

FINTIV Factor #5 : Petitioner / Defendant Same Party

Apple Inc. v. Fintiv, Inc. (IPR2020-00019) (Denied)

If a petitioner is unrelated to a defendant in an earlier court proceeding, the Board has weighed this fact against exercising discretion to deny institution under *NHK*.

The petitioner is usually a defendant in a parallel proceeding, so logically the converse should not necessarily be true!

But in a later order, the PTAB held:

Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.

At least the PTAB has not said anything to imply that this Fintiv factor outweighs the others.

FINTIV Factor #6 : Other Circumstances

Apple Inc. v. Fintiv, Inc. (IPR2020-00019) (Denied)

For example, if the merits of a ground raised in the petition seem particularly strong on the preliminary record, this fact has favored institution. ... By contrast, if the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present. This is not to suggest that a full merits analysis is necessary to evaluate this factor.

Failing to articulate a claim construction for a term that harmonizes its use in both the asserted patent and the prior art reference makes a ground a “close call.”

Failing to explain the motivation to combine and/or modify elements from different prior art references also makes a ground a “close call.”

FINTIV Factor #6: Other Considerations

Recent Illustrative Examples

Case	Verizon Bus. Network v. Huawei Tech., IPR2020-01278, Paper 12 (Jan. 26, 2021)
Petitioner's Arguments	<p>Petitioner argued that policy considerations support institution because the petition was filed within five months of the Complaint and that merely because a trial had been scheduled prior to the [final decision] date, it would deny petitioners any right to pursue an IPR in speedy jurisdictions.</p> <p>Petitioner asserted that even it filed its petition on the day it was sued, it would still have been unable to complete an IPR prior to the scheduled trial date.</p>
Patent Owner's Response	<p>Patent Owner counters that Petitioner waited more than 15 months from the time it received notice of its infringement before filing this Petition, and that such significant delay undercuts Petitioner's argument regarding policy considerations. Patent Owner also pointed out other weaknesses in the Petitioner's arguments.</p>
Board's Analysis:	<p>The Board did not consider Petitioner's filing untimely, but it did not alter the fact that the district court's trial date is nearly eight months before the deadline to reach a final decision.</p> <p>Additionally, inspection of the merits suggested Petitioner's challenges contained weaknesses.</p> <p>Thus, on balance, the Board found that the issues in this factor were a "close call," which has historically favored denying institution when other factors favoring denial are present.</p>

FINTIV Factor #6: Other Considerations

Recent Illustrative Examples

Case	Samsung Elec., Co., LTD., v. Clear Imaging Research, LLC, IPR 2020-01402, Paper 12 (Mar. 4, 2021)
Petitioner's Arguments	Petitioner argued that the merits are particularly strong and instituting the Board's discretion to deny institution would invalidate the claims challenged in the petition.
Patent Owner's Response	Patent Owner argued that Petitioner used the challenged patent merely as a roadmap to reconstruct the claimed invention using disparate elements from the prior art.
Board's Analysis:	<p>The Board acknowledged that balancing the merits in the sixth factor is used to “tip the balance one way or another,” in comparison to the other factors. In reviewing the merits presented, the Board found that the merits do not outweigh the other five factors.</p> <p>Therefore, in weighing the factors the Board decides to exercise their discretion to deny institution.</p>

The CAFC Gives *Fintiv* Its Stamp of Approval

Mylan Labs. v. Janssen Pharma. (CAFC 3/12/2021)

1. 35 U.S.C. § 314(d) does not preclude petition for mandamus.
2. However, mandamus review is limited to colorable constitutional claims.

Mylan Labs. v. Janssen Pharma. (cont'd)

Factual Background

1. Janssen sued Mylan for infringement of the '906 Patent.
2. Janssen also sued Teva for infringement of the '906 Patent.
3. Mylan filed petition for IPR of the '906 Patent.
4. Janssen opposed institution, arguing that:
 - a. Invalidity positions overlap between #1, #2, and #3.
 - b. #1 and #2 would reach final judgment before final written decision in #3.
5. PTAB denied institution.

Mylan Labs. v. Janssen Pharma. (cont'd)

35 U.S.C. § 314(d) “NO APPEAL”:

The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.

Mylan appealed to the CAFC seeking **mandamus** relief:

1. Fintiv standards improperly adopted via precedential designation rather than regular notice & comment rulemaking.
2. Deprives patent defendants of the statutory 1 year period after getting sued to file petition for IPR in 35 U.S.C. § 315(b).
3. Not proper to consider *Janssen v. Teva* district court action.

Mylan Labs. v. Janssen Pharma. (cont'd)

CAFC:

While there is no avenue for direct appeal of decisions denying institution, we conclude that judicial review is available in extraordinary circumstances by petition for mandamus. ...

... The scope of our review of a mandamus petition over a denial of institution is very narrow. ... [T]he Supreme Court has determined that such a decision is committed to agency discretion by law. Given this determination and the statute's bestowal of discretion on the Director combined with its prohibition on appeal of such decisions, we conclude that there is no reviewability of the Director's exercise of his discretion to deny institution except for colorable constitutional claims. ...

While we need not explore the outer contours of possibility, it is difficult to imagine a mandamus petition that challenges a denial of institution and identifies a clear and indisputable right to relief. Certainly, this is not such a petition. ...

Big Tech Hates *Fintiv*

Apple Inc. et al. v. Andrei Iancu (N.D. Cal. 8/31/2020)

- 11/23/2020: Motion to dismiss by Director.
 - Echoes CAFC decision in *Janssen*.
- 11/23/2020: Motion for summary judgment by Plaintiffs.
 - Echoes Mylan's arguments #1 and #2.
 - Defeats express purpose of AIA establishing IPR.
- 3/11/2021: Hearing on both motions.
- 6/14/2021: Release of hearing transcript.

IPR: Institution – Prior PTAB Proceedings

Apple Inc. v. Uniloc 2017 LLC (IPR2020-00854)

1. Uniloc sued Apple under the '088 Patent.
2. Apple petitioned for IPR of this patent. (IPR2019-00056)
3. PTAB denied institution of the 056 IPR.
4. Microsoft petitioned for IPR of same patent. (IPR2020-00023)
5. PTAB granted institution of the 023 IPR.
6. Apple files “substantially identical” petition, and motion to join the 023 IPR.

Under 35 USC § 315(b), Apple cannot file an IPR > 1 year after being served with the patent infringement complaint.

> 1 year!

But this 1 year period does not apply to joinders under 35 USC § 315(c).

IPR: Institution – Prior PTAB Proceedings (cont'd)

GENERAL PLASTIC Factors

- [1] Same petitioner, same patent, same claims?
- [2] Knew or should have known of prior art in second petition when filing first petition?
- [3] Received patent owner preliminary response or PTAB institution decision in first petition when filing second petition?
- [4] Time from learning of prior art in second petition to filing of second petition?
- [5] Adequate explanation for time between filing first and second petitions to same patent claims.
- [6] Finite PTAB resources.
- [7] 35 U.S.C. § 316(a)(11) requirement to issue final decision within one year of institution decision.

GENERAL PLASTIC Factor #1:

Same petitioner, same patent, same claims?

Apple Inc. v. Uniloc 2017 LLC (IPR2020-00854) (quoting General Plastic)

In effect, it would be as if Apple had brought the second challenge to the patent in the first instance. This is the kind of serial attack that General Plastic was intended to address. “Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.”

GENERAL PLASTIC Factor #2:

Knew or should have known of prior art in second petition when filing first petition?

Apple Inc. v. Uniloc 2017 LLC (IPR2020-00854)

The issue for us here is that Apple has failed to set forth facts or offer an explanation concerning its knowledge, at the time it filed the first petition, of the prior art asserted in the 023 IPR and here.

Petitioner should explain how it could not reasonably have known about prior art in second petition, e.g., new search based on patent owner's claim construction position in litigation.

GENERAL PLASTIC Factor #3:

Received patent owner preliminary response or PTAB institution decision in first petition when filing second petition?

Apple Inc. v. Uniloc 2017 LLC (IPR2020-00854)

“The timing of events here shows that Apple indeed had two Board decisions concerning its first petition, the decision denying institution and a decision of the request for rehearing of that decision,” “such that Apple would have been in a position to gain a benefit from having that information before filing its second petition.”

Petitioner should file second petition before patent owner preliminary response or institution decision in first petition, or explain how this information does not inform second petition.

GENERAL PLASTIC Factor #4:

Time from learning of prior art in second petition to filing of second petition?

Apple Inc. v. Uniloc 2017 LLC (IPR2020-00854)

The fourth General Plastic factor seeks to address a delay, if any, in filing a second petition. As stated above with regard to the second General Plastic factor, the lack of explanation by Apple provides no context by which to ascertain Apple's knowledge of the prior art asserted in the 023 IPR.

Petitioner should explain its diligence in filing second petition.

IPR: Institution – Real Party in Interest / Privy

35 U.S.C. § 315(e)(1):

The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or [the real party in interest or privy of the petitioner](#), may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

SharkNinja Operating LLC v. iRobot Corp. (IPR2020-00734)

Certain Board decisions considering whether other parties should have been named as RPIs have gone through the extensive analysis that such an exercise requires, even where there is no allegation that the failure to name the purported RPI results in time bar, estoppel, or anything else material to the case. ... In other decisions, the Board has determined that such a lengthy exercise is unnecessary for the purposes of rendering a decision on institution of trial. ... **The latter approach better serves the interest of cost and efficiency.**

Reduction of confidential discovery and under seal filing relating to petitioner's real-party-in-interest.

IPR: Institution – Real Party in Interest / Privy (cont'd)

RPX Corp. v. Applications in Internet Time, LLC (IPR2015-01750, -01751, -01752)

- Follows remand by CAFC in *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018):

Determining whether a non-party is a ‘real party in interest’ demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a **clear beneficiary** that has a **preexisting, established relationship** with the petitioner.

- Petitioner RPX provides patent risk management services, including its core service: defensive patent aggregation.
- Salesforce was served with patent infringement complaint > 1 year before petitions.

IPR: Institution – Real Party in Interest / Privy (cont'd)

RPX Corp. v. Applications in Internet Time, LLC (IPR2015-01750, -01751, -01752)

- RPX claimed that it did not file petitions “on behalf of” Salesforce because Salesforce did not “specifically, explicitly, and separately” contract for such services.
- The PTAB rejected this claim: **Cannot have a proxy file an IPR!**

Even when not asserted against its clients, the evidence suggests that RPX selects patents to challenge, at least in part, to reduce risk to existing clients. Finally, we observe that **RPX makes no suggestion that it had any risk of liability for infringement of the patents at issue.** As the Federal Circuit indicated in AIT, there is not necessarily “only one interested party in each case,” and inter partes review may be barred “even where the petitioning party might separately have its own interest in initiating an [inter partes review].”

IPR: Institution – Real Party in Interest / Privy (cont'd)

Uniloc 2017 LLC v. Facebook Inc. (CAFC 3/9/2021)

1. Apple petitioned for IPR of the '433 Patent.

IPR2017-00225: Claims 1-6 & 8

Final Written Decision:
Upholding Patentability

2. Facebook petitioned for IPR of this patent.

IPR2017-01427: Claims 1-8

IPR2017-01428: Claims 9-12, 14-17, 25-26

Estoppel under § 315(e)(1),
except Claim 7.

3. Facebook joined Apple's IPR.

4. LG joined both Facebook IPRs.

Free to proceed on all claims.

IPR: Institution – Real Party in Interest / Privy (cont'd)

Uniloc 2017 LLC v. Facebook Inc. (CAFC 3/9/2021)

But just because LG expressed an interest in challenging the '433 patent's patentability, through its filing of its own IPR petition and joinder motion, does not by itself make LG an RPI to Facebook's IPR. The record lacks any evidence that LG exercised any **control** over Facebook's decision to file for inter partes review (either in the Apple IPR and in this IPR) or Facebook's arguments made during the proceedings, and vice versa. ...

The record likewise does not present evidence that LG and Facebook, beyond their relationship as joined parties in this proceeding, have any sort of “preexisting, established relationship” that indicates coordination amongst the two regarding the Apple IPR. Without such evidence of control, in addition to no evidence of **joint funding**, or even any evidence of **substantial coordination between the parties as to their respective decisions to bring these proceedings**, a finding that LG is an RPI of or in privity with Facebook here would be improper.

Thank you!



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