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Federal Circuit: A Party Cannot Join Itself in Existing PTAB Proceeding

The PTAB may join only parties, not issues, to existing proceedings.

Key Points:

- A party may no longer join additional issues to a pending IPR.
- Defendants are most likely to be affected when more than one year has passed since being sued, at which point they can no longer file an IPR petition without a motion for joinder.
- The decision effectively overrules the PTAB's Precedential Opinion Panel on this issue.

The Federal Circuit recently held that “the clear and unambiguous meaning of [35 U.S.C.] § 315(c) does not authorize joinder of two proceedings, and does not authorize the Director to join a person to a proceeding in which that person is already a party.”¹

In so holding, the Federal Circuit effectively overturned a year-old decision to the contrary issued by the Patent Trial and Appeal Board's (PTAB's) Precedential Opinion Panel.² In that case, the PTAB held that § 315(c) “provides discretion to allow a petitioner to be joined to a proceeding in which it is already a party and provides discretion to allow joinder of new issues into an existing proceeding.” As a precedential decision, that opinion was binding on subsequent PTAB panels.

Summary of the Federal Circuit's Opinion

A party may not file an *Inter Partes* Review (IPR) petition seeking the PTAB's review of a patent after more than one year has passed since it was served with a complaint alleging infringement of that patent.³ The statute provides an exception to that rule: the one-year time period “shall not apply to a request for joinder under [§ 315(c)].”⁴

In *Facebook, Inc. v. Windy City Innovations*, Windy City accused Facebook of infringing several patents, and Facebook filed its first IPRs challenging some of the claims in those patents just before the one-year bar expired. After the one-year bar expired, Windy City identified which claims it was asserting, and Facebook filed additional IPRs challenging the asserted patent claims not already covered by its existing IPRs. As was the practice at the time, Facebook accompanied its petitions with motions for joinder, which the PTAB granted, thus joining additional patent claims to its earlier IPRs of certain patents.

On appeal, Windy City contended that the PTAB erred by allowing Facebook to join itself and add new claims to an existing IPR. The Federal Circuit agreed, concluding that § 315(c) does not authorize same-party joinder and does not authorize joinder of new issues. The Court also concluded that it “need not defer to the PTO’s interpretation of § 315(c)” because “the clear and unambiguous language of § 315(c) does not authorize same-party joinder or joinder of new issues.”

Chief Judge Prost authored the opinion, joined by Judges Plager and O’Malley. The three judges also offered “additional views,” in which they opined that even if the statute was ambiguous, the Court did not owe *Chevron* or *Skidmore* deference to the PTAB’s precedential *Proppant Express* opinion, and would “resolve the matter in the same way.” Notably, the panel wrote that Congress did not authorize the Director or the PTAB “to undertake statutory interpretation through [Precedential Opinion Panel] opinions,” and that such opinions are not comparable to notice-and-comment rulemaking.

Beyond the Court’s Holding

The Federal Circuit’s holding extends beyond the facts of this case. Certainly, parties can no longer join their own IPRs to obtain PTAB review of additional patent claims asserted by a plaintiff after the one-year bar expires.

The Court’s holding also seems to rule out joining another parties’ IPR by filing a somewhat different petition with new evidence or challenging an additional patent claim. In other words, a party seeking to join another party’s IPR may now be forbidden from filing anything other than an identical petition accompanied by exactly the same evidence.

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¹ *Facebook, Inc. v. Windy City Innovations, LLC*, No. 2018-1400 (Fed. Cir. Mar. 18, 2020).

² *Proppant Express Investments, LLC v. Oren Technologies, LLC*, No. IPR2018-00914, Paper 38 (P.T.A.B. Mar. 13, 2019) (precedential).

³ 35 U.S.C. § 315(b).

⁴ *Id.*