



MARCH 24, 2020 • NO. 4

Federal Circuit Puts an End to IPR “Same-Party” Joinder

With its recent decision in [Facebook, Inc. v. Windy City Innovations, LLC](#), the Federal Circuit put an end to “same-party” joinder in inter partes reviews (“IPRs”). In the past, a defendant may have filed an IPR petition involving some, but not all, claims before the one-year bar. When and if additional claims were asserted after the one-year bar, the defendant could have used the joinder exception to the one-year bar to file another IPR petition with these additional claims. Since petitioners can no longer avoid the one-year bar by joining their own IPRs, defendants must now ensure that the plaintiff discloses all of its asserted claims well before the one-year bar to ensure that all asserted claims may be included in an IPR.

On March 18, 2020, in [Facebook, Inc. v. Windy City Innovations, LLC](#), No. 18-1400, the Federal Circuit ended the Patent Trial and Appeal Board (“PTAB”) practice of allowing “same-party” joinder in IPRs. Petitioners involved in co-pending litigation often used same-party joinder to add to an existing IPR claims asserted in the litigation after the one-year time bar. While the PTAB issued some conflicting decisions on this issue,¹ it had generally allowed same-party joinder.² In fact, just one year ago, the PTAB issued a precedential decision affirming same-party joinder in [Proppant Express Investments, LLC et al. v. Oren Technologies, LLC](#), IPR2018-00914, Paper 38 (PTAB March 13, 2019).

Section 315(b) of the patent statute bars filing IPRs more than one year after the petitioner is served with a complaint (“1-year bar date”).³ The statute, however, states that the bar does not apply where the petitioner moves to join an existing IPR under section 315(c). In [Facebook](#), the Federal

Circuit held that the PTAB improperly interpreted section 315(b) to allow a party to join its own existing IPR. The Court determined that the language in section § 315(c) allowing the Director to “join as a party to that inter partes review any person who properly files a petition...” could not “refer to persons that were already parties.”⁴ The Federal Circuit also held that section 315(b) does not allow time-barred new issues, for example new claims or new grounds, to be joined to an existing IPR.

In this case, Facebook was unable to include all of the asserted claims in its original petition because Windy City had not disclosed the asserted claims before the one-year bar date. Windy City filed a complaint against Facebook asserting four patents having a total of 830 claims. Facebook moved to dismiss the complaint because it did not identify which claims were asserted against which Facebook products. Facebook also moved to transfer, a motion the court granted after waiting months to decide. The case

was transferred without the court deciding the motion to dismiss, which Facebook did not renew. By the time a case management conference was scheduled, the deadline for Windy City's disclosure of asserted claims and infringement contentions was after the one-year bar date. Facebook filed an IPR petition with some claims just before the one-year bar date. The infringement contentions, which were timely served after the one-year bar date, asserted several claims that were not challenged in the original IPR. Facebook promptly filed a new IPR petition with the additional claims and moved to join the original IPR.

While the facts in *Facebook* may seem extraordinary, more plaintiffs may try to employ the same approach hoping for the same result: assert patents with dozens or hundreds of claims and avoid identifying the asserted claims as long as possible. Such an approach may force defendants to choose between filing timely and expensive IPRs on all claims, or filing IPRs based on guessing which claims may ultimately be asserted. These plaintiffs may choose to file in courts with little patent experience and/or courts with no local patents rules in hopes of avoiding an early disclosure

of asserted claims. Against these plaintiffs and others, defendants must be diligent in forcing plaintiffs to disclose the asserted claims well before the one-year bar date by, for example, raising the issue with the court at the scheduling conference. Defendants must also be cognizant of the impact of extending early deadlines, for example extending the deadline to answer by several months, particularly in cases like *Facebook* where the asserted patents had 830 claims and particularly in courts with no local patent rules. *Facebook* should not have much impact on third party joinder of IPRs as it was always less likely that a third party could join an IPR if the petition raised new issues that were not raised in the original IPR.

For additional information, please contact:

**S. Gregory Herrman, Washington, D.C. Office
Of Counsel, Intellectual Property & Technology
202.420.4793 | gherrman@blankrome.com**

**Ameya "Arun" V. Paradkar, Washington, D.C. Office
Associate, Intellectual Property & Technology
202.772.5849 | aparadkar@blankrome.com**

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1. *Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2012-00022, Paper 166 (P.T.A.B. Sept. 2, 2014); *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15 (P.T.A.B. Feb. 25, 2013); *ABB Inc. v. Roy-G-Biv Corp.*, IPR2013-00282, Paper 15 (P.T.A.B. Aug. 9, 2013); *Target Corp. v. Destination Maternity Corp.*, IPR2014-00508/00509, Paper 28 (P.T.A.B. Feb. 12, 2015); *Amneal Pharm., LLC v. Endo Pharm. Inc.*, No. IPR2014-01365, 2015 WL 496350, at *2 (P.T.A.B. Feb. 4, 2015).
 2. *Medtronic, Inc., Medtronic Vascular, Inc., & Medtronic Corevalve, LLC v. Troy R. Norred, M.D.*, No. IPR2014-00823, 2014 WL 6985725 (P.T.A.B. Dec. 8, 2014); *SkyHawke Techs., LLC v. L&H Concepts, LLC*, IPR2014-01485 (Paper 13) (P.T.A.B. Mar. 20, 2015).
 3. 35 U.S.C. § 315(b).
 4. *Facebook*, slip copy at 15.