

March 9, 2016

Post-Grant for Practitioners

Multiple Parties and Multiple Petitions in Post-Grant Proceedings



Dorothy Whelan

*Principal, Post-Grant Practice
Co-Chair*

Karl Renner

*Principal, Post-Grant Practice
Co-Chair*

Thomas Rozyłowicz

Principal

David Holt

Associate

Agenda

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- I. Overview of Webinar Series
- II. Statistics
- III. Multiple Parties and Multiple Petitions in Post-Grant Proceedings
- IV. Post Grant Resources



Overview of Webinar Series

- Where? ... see invitation
- How often? ... monthly
- When? ... 2nd Wednesday
- Topics? ...
 - Important decisions
 - Developments
 - Practice tips
- Housekeeping
 - CLE
 - Questions
 - Materials
 - <http://fishpostgrant.com/webinars/>

The screenshot shows the website for the "Post-Grant for Practitioners" series by Fish & Richardson. The page features a navigation bar with links to Fishpostgrant.com, Bios, Alerts, Webinars, Case Studies, and App. The main content area is titled "Multiple Parties, Multiple Petitions - Multiple Practice Tips" and includes a description of the webinar, a list of topics, and a "REGISTER" button. Below the registration button, there is a section for speakers, featuring photos and names of Dorothy Whelan and Karl Renner. At the bottom of the page, there are four social media and utility icons: an envelope for newsletters, a clock for webinar replays, a LinkedIn icon for connecting with the firm, and a Twitter icon for following the firm.

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**Post-Grant
for Practitioners**

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Multiple Parties, Multiple Petitions - Multiple Practice Tips


Join Fish Principals Dorothy Whelan and Karl Renner as they discuss multiple parties and multiple petitions in post-grant proceedings, and offer practical tips for both patent owners and petitioners. To date, these issues have arisen primarily in the tech area. However, they will become increasingly important in the life sciences, particularly in biosimilars. Topics will include:


- Multiple parties filing a single petition vs. individual petitions
- Real party in interest and privity issues
- Joinder and consolidation issues
- Timing issues where there are multiple potential filers
- Redundancy when filing multiple petitions

[Register](#) now for this Post-Grant for Practitioners Webinar.

Wednesday, March 9, 2016
1:00 PM - 2:00 PM EST
Via the web

Speakers:

 [Dorothy Whelan
whelan@fr.com](mailto:whelan@fr.com)
Principal, Co-Chair
Twin Cities

 [Karl Renner
renner@fr.com](mailto:renner@fr.com)
Principal, Co-Chair
Washington, DC

REGISTER

Fish & Richardson will apply for 1.0 hour of general CLE credit in most states. If you would like to receive CLE credit, register with your state bar information.

If you have questions, please contact Crystal Chisholm at chisholm@fr.com

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Statistics

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- **IPRs Filed?**

- **4,198** filed through March 7, 2016
- **132** filed in February 2016

- **CBMs Filed?**

- **423** filed through March 7, 2016
- **12** filed in February 2016



Multiple Parties and Multiple Petitions in Post-Grant Proceedings

What are the issues surrounding proceedings involving multiple petitioners and multiple petitions?

- Joinder
- Real party in interest and privity issues
- Timing issues
- Redundancy when filing multiple petitions
- General considerations for single joint petition v. multiple individual petitions



Joinder



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Joinder

- PTAB has the discretion to join multiple petitions. 35 U.S.C. § 314.
 - Multiple petitions by a single party.
 - Multiple petitions by multiple parties.
- Motion for joinder must be filed no later than one month after the institution date of the first IPR petition. 37 CFR § 42.122(b).

Joinder

- PTAB has a liberal policy with respect to joinder.
 - 2015: 174 motions filed. 74% granted.
 - Reflects PTAB's desire to simplify and streamline proceedings.

Joinder

How does a joined proceeding work?

- Trend has been toward more limited role by joined party
 - “[Joined Party] not permitted to file papers, engage in discovery, or participate in any deposition or oral hearing. [Joined Party], however, is permitted to appear so that it may receive notification of filings and may attend depositions and oral hearing. Should [Joined Party] believe it necessary to take any further action, [Joined Party] should request a conference call to obtain authorization from the Board.”
IPR2015-00565.
- Effectively, a backseat passenger unless/until original Petitioner settles out.

Joinder

Should you join an existing proceeding or simply file a separate petition?

- Similarity of grounds?
- PTAB joinder
- Timing



Real party in interest and
privity issues

Real party in interest and privity issues

An unsuccessful IPR petitioner, or a real party in interest or privy of the petitioner, is estopped from raising, in federal district court, the ITC, or the PTO, any ground that the petitioner raised or reasonably could have raised. 35 U.S.C. § 315(e).

- Even if you do not formally participate in an IPR proceeding initiated by another party, you could still be subject to the estoppel if you offer substantive advice and counsel during the proceeding sufficient to establish control. See IPR2013-00601, Paper 23.
- If you do not participate officially or unofficially, and the petitioner loses, your ability to file your own petition later could be compromised, especially if you want to rely on the same prior art references. 35 U.S.C. 325(d).

Real party in interest and privity issues

- How much communication with non-parties is permissible without triggering RPI/privity?
 - How do you account for JDG work without triggering RPI/privity?
- If filing separate petitions, should each petition identify other parties filing separate petitions as co-petitioners?

Real party in interest and privity issues



Data Points on RPI:

- “A common consideration is whether the non-party exercised or could have exercised control over a party’s participation in a proceeding.” 77 Fed. Reg. at 48,759 (citing *Taylor*, 553 U.S. at 895).
- “The concept of control generally means that ‘it should be enough that the nonparty has the actual measure of control or opportunity to control that might reasonably be expected between two formal coparties.’” *Id.* (quoting Charles Wright, et al., 18A Federal Practice & Procedure §§ 4449, 4451 (2d ed. 2011)).

Real party in interest and privity issues

Data Points on RPI:

- Status as a co-defendant of a joint defense group is insufficient to establish that a non-named party had control over the filing of a Petition. 77 Fed. Reg. at 48,760.
- A substantial resubmission of a petition filed in an original proceeding, alone, was not a sufficient basis for determining that a previous petitioner in the original proceedings was a real-party-in-interest in the later proceeding. *JP Morgan Chase & Co. v. Maxim Integrated Product, Inc.*, CBM2014-00179, slip op. at 6–13 (PTAB Feb. 20, 2015) (Paper 11).



Timing issues where there are
multiple potential filers

Timing issues where there are multiple potential filers

When should you file in a multiple filer situation?

- Should you be the first filer?
- Should you file shortly after the first filer?
- Should you wait until the patent owner files a preliminary response to file?
- Should you wait until the PTAB decides whether to grant the first petition?
 - Need to file within one month of institution, along with a motion for joinder, if you wish to join the instituted proceedings



Redundancy when filing
multiple petitions

Redundancy when filing multiple petitions

- 35 U.S.C. §§ 315(d) and 325(d) give the PTAB discretion to determine the manner in which the reviews may proceed, “including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.”
- 35 U.S.C. § 325(d) also provides that in determining whether to institute an AIA trial, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”

Redundancy when filing multiple petitions

- What are ways to avoid a determination of redundancy?
 - PTAB suggests that Petitioner specifically describe relative strengths of each ground with regard to each other ground. CBM-2012-00003 (*Liberty Mutual*).
 - Not ideal to effectively disparage your own grounds.
 - Different ground for each of multiple possible claim constructions.
 - Not uncommon for PTAB to select ground associated with construction adopted in Institution Decision.
 - Distinguish nature of the system/technology underlying each ground.
 - For example, a CDMA vs. GSM system
 - Do grounds apply to different subsets of dependent claims?

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Post-Grant Resources

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- In Fish & Richardson’s initial 7-part webinar series titled “Challenging Patent Validity in the USPTO,” we explored details regarding several of the post grant tools, with 3 sessions dedicated to Inter Partes Review (IPR), and a final session walking through several hypotheticals, to help listeners understand how these apply to common situations.
- Audio and slides for these webinars are posted online at:
<http://fishpostgrant.com/webinars/>
- If you listen to these webinars, you will be well positioned to engage in a conversation over whether and when to use those tools and how to defend against them.

- Fish web sites:
 - Post-Grant for Practitioners: <http://fishpostgrant.com/webinars/>
 - General: <http://fishpostgrant.com/>
 - IPR: <http://fishpostgrant.com/inter-partes-review/>
 - PGR: <http://fishpostgrant.com/post-grant-review/>
 - Rules governing post-grant: <http://fishpostgrant.com/>
 - Post-Grant App: <http://fishpostgrant.com/app/>
- USPTO sites:
 - AIA Main: http://www.uspto.gov/aia_implementation/index.jsp
 - Inter Partes: http://www.uspto.gov/aia_implementation/bpai.jsp

Thank You!

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Dorothy Whelan

Principal, Post-Grant

Practice Co-Chair

Twin Cities

Whelan@fr.com

612-337-2509

Karl Renner

Principal, Post-Grant

Practice Co-Chair

Washington, DC

Renner@fr.com

202-626-6447

Thomas Rozylowicz

Principal

Washington, DC

Rozylowicz@fr.com

202-626-6395

David Holt

Associate

Washington, DC

David.Holt@fr.com

202-626-7783

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