

Precedential Decisions When Challenging Patents

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Three Decisions designated as precedential

- Concerning when companies challenging patents must name all of the interested parties in a petition and when multiple petitions challenging the same patent are not allowed

Three Decisions designated as precedential

1) RPX Corp. v. Applications in Internet Time LLC; case number IPR2015-01750

2) SharkNinja Operating LLC v. iRobot Corp; case number IPR2020-00734

3) Apple Inc. v. Uniloc 2017 LLC; case number IPR2020-00854

Real Party in Interest

- Section 312(a)(2) requires that the “petition identif[y] all real parties in interest.” This provision serves important notice functions to patent owners, to identify whether the petitioner is barred from bringing an IPR due to an RPI that is time-barred or otherwise estopped, and to the Board, to identify conflicts of interests that are not readily apparent from the identity of the petitioner

RPX Corp. v. Applications in Internet Time LLC

- RPX provides “market intelligence” to its clients that include “client briefings to discuss [RPX’s] assessment of open market opportunities, relevant litigation landscape activity, key players and trends, as well as to provide specific technical and strategic analyses on potential threats.”
- Salesforce.com is an RPX subscriber who had attempted to file CBM challenges to the patents at issue after having been accused of infringement. Salesforce’s CBM petitions were denied. Salesforce’s 1-year 35 U.S.C. § 315(b) bar had elapsed when RPX filed its IPR petitions challenging the patents.

RPX Corp. v. Applications in Internet Time LLC

RPX is a company that says its goal is to help its clients "quickly and cost-effectively extricate themselves" from lawsuits by nonpracticing entities.

Applications in Internet Time argued that RPX's petitions should be denied because it was filed on behalf of Salesforce, which had been sued for infringement over a year earlier and was thus barred from challenging the patents itself

RPX Corp. v. Applications in Internet Time LLC

- Initially, the PTAB disagreed, finding there was no persuasive evidence that RPX filed the petitions as a proxy for Salesforce, and invalidated the patents. However, the Federal Circuit ordered it to reconsider in 2018, ruling that the Board took an "impermissibly shallow" look at the evidence.

RPX Corp. v. Applications in Internet Time LLC

- Determine whether entity is Real Party in Interest (RPI)
- The RPI analysis of PTAB focused on whether an unnamed party exerted sufficient “control” over the petition, relying on factors such as having input into whether a PTAB challenge was filed, payment of PTAB-related attorney/filing fees, and selection of prior art in determining whether an unnamed party was an RPI
- The Federal Circuit faulted the PTAB for focusing too narrowly on “control.” Urged flexible approach requires both equitable and practical considerations in determining whether a non-party is an RPI.

RPX Corp. v. Applications in Internet Time LLC

- On remand the PTAB applied a broader test that looked to more than overt “control” of the IPR petition. The PTAB applied the “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.”

RPX Corp. v. Applications in Internet Time LLC

- The Board concluded in the newly precedential decision that RPX filed the petitions to benefit Salesforce, and that filing IPRs to aid its members and protect them from patent suits are "important components of RPX's core subscription business." The board held that since Salesforce is an interested party, the petitions are time-barred, and terminated them

RPX Corp. v. Applications in Internet Time LLC

- Although the PTAB did not find explicit indicia of control of the IPRs by Salesforce in the form of an express or implied agreement with RPX to file the IPRs, the PTAB found that RPX was unable to show, by a preponderance of the evidence, that Salesforce is not an RPI in the proceedings. Accordingly, the PTAB terminated their prior decisions instituting review and denied review under 35 U.S.C. § 315(b) based on Salesforce being a barred real party in interest to the petitions.

RPX Corp. v. Applications in Internet Time LLC

This decision on remand from the Federal Circuit holds that the petitioner was time-barred because the petitioner's client was an unnamed real party-in-interest that had been served with an infringement complaint more than one year before filing the petition.

RPX filed 57 PTAB petitions as of early 2019

SharkNinja Operating LLC v. iRobot Corp.

- SharkNinja did not name its corporate parent, JS Global Lifestyle Co. Ltd., in the petition.
- Omission wouldn't change the outcome of the case and denied petition of iRobot

SharkNinja Operating LLC v. iRobot Corp.

- Petitioners must identify any real parties-in-interest, and must do so in good faith, the Board does not need to resolve a dispute regarding a possible real party-in-interest if it would not impact the board's institution decision.

SharkNinja Operating LLC v. iRobot Corp.

- No evidence that JS Global was time-barred from filing a petition, or that it was omitted to gain some advantage. Errors in listing interested parties can be corrected, and SharkNinja offered to do so
- Extensive analysis of interested party issues is not necessary

Apple Inc. v. Uniloc 2017 LLC

- Denial of Apple's petition for review of a Uniloc patent, because it had already challenged some claims of the patent
- Apple's previous petition challenging the patent on technology for upgrading electronic devices was denied in 2019. But this year, the Board instituted review of the patent at the request of Microsoft.

Apple Inc. v. Uniloc 2017 LLC

Apple then filed another petition making invalidity arguments identical to Microsoft's and sought to have them joined, with Apple taking an "understudy" role in the case.

2017 Board Decision in General Plastic restricts multiple petitions on the same patent, "to a copycat petition that the petitioner filed against the challenged patent after its first petition was denied

Apple Inc. v. Uniloc 2017 LLC

- Apple files '056 IPR which is denied
- Microsoft has successful '023 IPR
- Apple files '056 review, over a year after initial filing, admittedly substantially identical to '023 IPR and seeks rejoinder

General Plastic Factors

Non-exhaustive list whether to exercise discretion to deny a petition challenging a patent that was previously challenged before the Board:

1. Whether the same petitioner previously filed a petition directed to the same claims of the same patent;

General Plastic Factors

2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;

3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;

General Plastic Factors

4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;

5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;

General Plastic Factors

- 6. the finite resources of the Board; and
- 7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Thank You

