

## Patent Trial and Appeal Board Gives Green Light to Same-Party and Issue Joinder

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March 20, 2019

The Patent Trial and Appeal Board ("PTAB") has issued a precedential opinion that gives a green light to same-party and issue joinder. This practice will provide discretion to PTAB judges to allow a petitioner to add new issues even if they may be outside the one-year time bar window for filing an *inter partes* review (IPR).

The precedential decision comes from a Precedential Opinion Panel ("POP") comprised of several notable names—Andrei Iancu (Director of the USPTO); Drew Hirshfeld (Commissioner for Patents); and Scott R. Boalick (newly appointed Chief Administrative Patent Judge).

The POP was tasked with addressing three issues:

1. Under 35 U.S.C. § 315(c) may a petitioner be joined to a proceeding in which it is already a party?
2. Does 35 U.S.C. § 315(c) permit joinder of new issues into an existing proceeding?
3. Does the existence of a time bar under 35 U.S.C. § 315(b), or any other relevant facts, have any impact on the first two questions?

The POP answered yes to all three questions.

In the precedential decision, the POP concluded that the statute did permit the same party to both join an existing proceeding and add new issues "in limited circumstances." (Paper 38 at 5, 11.) To curtail gamesmanship risks, "the Board will exercise discretion in limited circumstances—namely where fairness requires it and to avoid undue prejudice to a party." (Paper 38 at 4.)

The POP further stated that the Board is to consider many factors when exercising this discretion, including whether a petitioner is time barred, the stage and schedule for an existing *inter partes* review, the non-exclusive factors set out in *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i), as well as events in other proceedings related to the patent at issue.

With respect to the merits of the case subject to the rehearing, the Petitioners requested review of numerous claims which were all instituted except for one. The Petitioners then filed a new petition—after the one year time bar—seeking to correct the errors in its argument as to that claim and sought joinder to the original petition. The board denied joinder and the Petitioners sought a rehearing. The POP denied the Petitioners motion for joinder. Evidently, a petitioner cannot use this procedure to correct their own failings in prior petitions.

This decision will impact both underlying patent litigation as well as proceedings at the PTAB. Patent owners may want to think twice about adding patent claims late in the underlying litigation when there is a pending IPR because it may give a defendant petitioner a second bite at the apple to introduce new issues without falling victim to the one-year time bar.

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The precedential decision comes shortly after the Federal Circuit affirmed that all parties who are joined in an IPR proceeding under 35 U.S.C. § 315(c) have standing to appeal the final decision of the PTAB regardless of whether they were time-barred under U.S.C. § 315. *Mylan Pharmaceuticals Inc. v. Research Corporation Technologies, Inc.*, No. 17-2088 (Fed. Cir. 2019).

For further guidance about how this opinion could affect you, please contact the authors or your Miller Canfield attorney.