

Clint Wilkins, Eugene Goryunov and David McCombs in Intellectual Property Magazine: 'Evolving Contours of IPR Joinder'

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Like many aspects of *inter partes* review (IPR) proceedings, those regarding joinder under 35 USC section 315(c) have developed rapidly in recent months. Some of the more impactful changes are examined in this article, along with implications for petitioner strategy.

Joinder overview

Section 315(c) allows a party to be joined to an instituted IPR. And, by rule, any request for joinder must be filed within one month of institution of any IPR for which joinder is requested. The one-year time bar does not apply to joined petitions.

In a typical scenario, a party seeking joinder will file what is often referred to as a “copycat” or “me too” petition that is substantially the same as an instituted petition along with a motion for joinder acquiescing to an “understudy” role. In the understudy role, there are typically no separate substantive filings by the joined party, no additional cross-examination or defence of witnesses in deposition, and no participation in the oral hearing, so long as the lead party remains in the case. The main benefit of this type of joinder is efficiency, such that the joined party only steps into the shoes of the lead party to continue the IPR should the lead party settle or otherwise cease its participation. And, as the U.S. Patent and Trademark Office’s (USPTO) fiscal year 2019 statistics show, once an IPR is instituted, at least one challenged claim is found to be unpatentable in nearly 80% of final written decisions. Accordingly, a motion for joinder can be an attractive insurance policy for an accused infringer.

Two recent U.S. Court of Appeals for the Federal Circuit decisions have addressed important issues regarding joinder – one case prohibits joinder requests that attempt to add new claims or grounds to the instituted petition, and a second case mitigates the risk of estoppel for a “me too” joinder petitioner who is also an accused infringer in a parallel district court or US International Trade Commission (ITC) proceeding. Moreover, a recent Patent Trial and Appeal Board (PTAB) precedential decision indicates that “me too” joinder petitions are no longer automatically instituted if they represent a petitioner’s own second IPR challenging the same claims. These cases are discussed in detail below.

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