



Termination of IPR Proceeding on the Eve of Final Written Decision Dooms Joinder Attempt

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The Patent Trial and Appeal Board has denied institution and joinder of an *inter partes* review petition after determining that the petition was not only time-barred but that joinder was also foreclosed. In making its determination, the board found that the concurrent motion for joinder was not proper because the IPR proceeding sought to be joined had just been terminated due to settlement.

The challenged patent was directed to wireless communication using directed communication beams emanating from an antenna. Petitioner filed its petition for IPR more than two years after it had been served with a complaint alleging infringement of the challenged patent. Concurrently with its petition, petitioner filed a motion for joinder, seeking to be joined as a party with an earlier IPR in which claims of the same patent had been challenged.

Under 35 U.S.C. § 315(b), an IPR “may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” However, § 315(b) further provides that the time limitation does not apply when the petition is accompanied by a request for joinder. Here, petitioner filed its petition more than one year after it was served with a complaint alleging infringement of the challenged patent, and petitioner accompanied its IPR petition with a motion for joinder.

But the IPR proceeding to which petitioner sought to be joined had been terminated days before petitioner filed its petition. Although petitioner also sought leave to file a motion to

reopen the earlier IPR, the board denied petitioner’s request. Because there was no IPR to join, the board denied the motion for joinder. Consequently, the provision in § 315(b) that would have permitted the time-barred petition was not applicable.

Practice Tip: If a petition is subject to the one-year time bar of 35 U.S.C. § 315(b), a request for joinder can be a useful strategy to circumvent that bar. Under the board’s procedures, however, a motion for joinder should generally be filed within a month of institution. Here, petitioner failed to move for joinder within a month of institution or at any time during the pendency of the earlier IPR proceeding. Any delays in both filing a petition and in requesting joinder carry significant risk for a petitioner, including the possibility of being foreclosed from joining an earlier proceeding that has been terminated.

Ubiquiti Inc., v. XR Commc’ns, LLC, IPR2024-00148, Paper 12 (P.T.A.B. May 6, 2024).

Categories

IPRs

Inter Partes Review

35 U.S.C. § 315(b)

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