



## Shared Counsel and Existence of Joint Defense Agreement Insufficient to Establish Real Party-In-Interest Status

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The Patent Trial and Appeal Board rejected a patent owner’s assertion that petitioner should have named a third party, which was a defendant in a related district court patent infringement litigation and a party to a joint defense agreement (JDA) with petitioner, as a real party-in-interest (RPI). Had the board ruled otherwise and found the third party to be an RPI, the petition would have been time-barred under 35 U.S.C. § 315(b).

Patent owner argued that the third party was an RPI because petitioner and the third party were pursuing a unified invalidity defense strategy, as evidenced by the JDA in their related patent infringement litigations and the submission of identical invalidity contentions that overlap with the unpatentability grounds in the petition. And because petitioner and the third-party shared counsel—specifically, the lead counsel for the IPR petition—patent owner argued that the overlapping representation made the third party an RPI to this IPR. In response, petitioner submitted declaration testimony from its lead IPR counsel, who testified that her involvement in the third party’s district court litigation was limited to arguing a motion based on 35 U.S.C. § 101. She also declared that neither she nor any other counsel for petitioner had represented the third party on any other issue, nor did they advise the third party regarding what to include in its preliminary invalidity contentions.

In its analysis, the board noted that the sharing of counsel in district court by a non-party to an IPR accused of infringing the same patent as the petitioner is common and not by itself sufficient to make that non-party an RPI. Instead, the RPI determination requires a flexible approach that accounts for equitable and practical considerations, particularly whether the

non-party is a clear beneficiary of the proceedings and has a preexisting, established relationships with the petitioner. Further, the board observed that the mere existence of a JDA does not demonstrate a preexisting, established relationship. Thus, the board rejected patent owner’s assertion that the petition should have identified the third party as an RPI.

**Practice Tip:**

The existence of a JDA between petitioner and a defendant in related patent litigations and the *de minimis* involvement of petitioner’s IPR counsel in the other defendant’s district court case are insufficient on their own to establish RPI status. Without evidence of more substantial overlapping engagement by counsel or evidence showing collaboration between the parties as it relates to the IPR, the board is unlikely to find that a defendant in a related patent litigation is an RPI.

*Box, Inc. v. Topia Tech., Inc.*, IPR2023-00427, Paper 64 (P.T.A.B. August 1, 2024)

## Categories

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