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PTAB Establishes New but Limited Avenue for Petitioners to Invalidate Patents in *Inter Partes* Reviews after Statutory One-Year Bar

With the decision in Proppant Express, accused infringers should be cognizant of their new-found ability to initiate inter partes review proceedings beyond the one-year statutory bar date, even though there are only “limited circumstances” in which doing so is appropriate. However, accused infringers should also be wary of relying on the holding of Proppant Express until after the Federal Circuit has affirmed the decision on appeal.

A general requirement for the filing of *inter partes* review (“IPR”) petitions is that they must not be filed “*more than one year after the day* on which the petitioner...is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b) (emphasis added). Since the implementation of IPR proceedings in 2012, this language has generally been viewed by practitioners as establishing an absolute bar to the filing of a petition beyond the one-year deadline. The only established exception to this requirement was that *other* parties (*i.e.*, parties other than the petitioner itself) could join a previously instituted petition even after the one-year bar. However, an additional exception arose when the Precedential Opinion Panel of the Patent Trial and Appeals Board (“PTAB”) issued a precedential opinion in *Proppant Express Investments, LLC et al. v. Oren Technologies, LLC*, IPR2018-00914, Paper 38 (PTAB March 13, 2019). That opinion officially opened the door for petitioners to raise new issues, such as new grounds for invalidity, even after the one-year bar date.

Proppant Express held that, in limited circumstances, the PTAB will allow petitioners to use the joinder provision set forth in 35 U.S.C. § 315(c) to join *their own* previously instituted IPR petition, even if new issues are raised in the motion for joinder and even if the motion for joinder is filed after the one-year statutory bar. Going forward, the PTAB will exercise its discretion to allow a petitioner to “self-join” its own previously instituted petition “only in limited circumstances—namely, where fairness requires it and to avoid undue prejudice to a party.” *Id.* at 4.

Proppant Express only provides one example of circumstances that may justify self-joinder after the one-year bar—*i.e.*, the belated addition of newly asserted patent claims by the patent owner in a co-pending litigation. *Id.* However, there are several other circumstances that could possibly lend themselves to permissible self-joinder. For instance, if a patent owner withholds critical prior art in a co-pending litigation when it had a discovery obligation

to produce that art, it could be deemed unfair to prohibit the petitioner from relying on that prior art as part of a self-joinder motion filed after the one-year bar. As another example, if a patent owner's technical expert in co-pending litigation provides unexpected testimony that supports new grounds for invalidity, it might be found that fairness also justifies allowing the petitioner to self-join after the one-year bar to add those new grounds. While there are likely other unforeseen circumstances that could give rise to self-joinder by a petitioner, *Proppant Express* makes it clear that where a petitioner's own conduct "creates the need for it to request joinder" then a motion for self-joinder will be denied. *Proppant Express* provides a concrete example where the petitioner sought self-joinder to correct a mistake or oversight in its originally instituted petition. The PTAB denied the request, finding that neither fairness nor the need to avoid undue prejudice justified allowing the petitioner to correct a mistake it could have avoided with appropriate diligence.

While *Proppant Express* provides accused infringers an avenue for initiating IPR proceedings after the one-year bar, would-be petitioners should still take reasonable steps to avoid the need to rely on self-joinder in the first place. For one, whether the PTAB permits self-joinder is discretionary and, therefore, it is difficult to definitively determine whether a given set of facts will give rise to self-joinder. Second, filing an additional petition with a motion

for joinder is expensive, even if the newly raised issues are similar to those raised in the originally instituted petition. Indeed, the filing fees for a petition alone are over \$30,000, even for one filed as part of a motion for self-joinder. Third, some of the circumstances giving rise to the need for self-joinder can easily be avoided by carefully drafting the original IPR petition. For example, it is always best practice for a petitioner to challenge all patent claims that have been or *could reasonably be* asserted in litigation, even if the patent owner has not asserted all of those challenged claims in the co-pending litigation. In doing so, the petitioner can avoid the need to move for self-joinder due to the belated addition of asserted claims in the litigation. Fourth, and perhaps most important at this moment, *Proppant Express* (or a later case raising the same issue) could be appealed to the Federal Circuit, and so there is at least a possibility that its holding could be reversed. As such, the strategic decision by a petitioner to rely on self-joinder in view of *Proppant Express* could ultimately leave the petitioner in a vulnerable position.

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