

## Federal Circuit Overturns PTAB Precedential Order That Allows Parties to Join Their Own IPR

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*Facebook, Inc. v. Windy City Innovations, LLC*, 953 F.3d 1313 (Fed. Cir. Mar. 18, 2020)

In March 2019, the Patent Trial and Appeal Board (PTAB) issued a precedential order in *Proppant Express Investments, LLC v. Oren Technologies, LLC*, holding that 35 U.S.C. § 315(c) permits joinder of a same party or new issues to an existing *inter partes* review (IPR). This holding was used by petitioners to add new patentability challenges to earlier-filed IPRs, even after the one-year time bar for filing IPRs.

In *Facebook*, the Federal Circuit considered whether the PTAB petitioner/appellant should have been allowed to join additional IPR petitions identifying new claims to instituted IPRs after the one-year time bar of 35 U.S.C. § 315(b) had passed.

The patent owner/appellee argued that joinder was improper because § 315(c) does not authorize same-party joinder and does not authorize joinder of new issues. The Federal Circuit agreed on both points. As to same-party joinder, the Federal Circuit reasoned that the language of § 315(c) is intended to give the PTAB authority to join other parties to a petition, rather than the same party: “It would be an extraordinary usage of the term ‘join as a party’ to refer to persons who were already parties.” As to joinder of new issues, the Federal Circuit reasoned that § 315(c) is directed to permitting a party to join an *already-instituted IPR*, which “is confined to the claims and grounds challenged in that petition.” Thus, § 315(c) does not authorize a joined party to bring new issues from a newer proceeding into an existing proceeding.

A copy of the opinion can be found [here](#).

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