

CLIENT ALERT

## Parties Joined to IPR Proceedings Have Full Rights to Appeal and the Board Failed to Correct Claim Drafting Errors

AUGUST 8, 2020

*Fitbit, Inc. v. Valencell, Inc.*, 964 F.3d 1112 (Fed. Cir. July 8, 2020)

Dealing with an unusual fact pattern from an *inter partes* review (IPR) proceeding, the Federal Circuit held that 1) a joined party's rights apply to the entirety of the proceedings, including the right to appeal claims or grounds not raised by the joined party; 2) the Board erred by failing to review the patentability of claim 3 as construed; and 3) the Board erred by failing to correct a drafting error.

Apple filed an IPR petition challenging claims 1-13 of the patent-at-issue. After the Board instituted on claims 1-2 and 6-13, Fitbit filed a copycat petition and successfully moved to join the Apple IPR with respect to the instituted claims. Before the Final Written Decision issued, the Supreme Court decided *SAS Institute, Inc. v. Iancu*, requiring the Board to institute on all challenges in an IPR petition. In light of *SAS*, the Apple/Fitbit Final Written Decision reviewed the IPR's challenges to claims 3-5 and found them not unpatentable. Fitbit appealed the Board's decision on claims 3-5, even though neither Fitbit's petition nor its brief addressed those claims. In denying the patent owner's challenge to Fitbit's right to appeal, the Federal Circuit held that a joined party's rights apply to the entirety of the proceedings and include the right of appeal.

As to claim 3, the Federal Circuit affirmed the Board's construction of the claim, but vacated and remanded because the Board ended the patentability inquiry after accepting the patent owner's construction without further substantive explanation and analysis. As to claims 4-5, the Federal Circuit remanded because the Board did not conduct a patentability analysis based on a drafting error in those claims. However, the parties had expressed a shared view as to the nature of the error and its correction. The Federal Circuit found that the Board's failure to correct this conspicuous error did comport with the Board's duty to resolve patentability issues.

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

1 Min Read

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