



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROPPANT EXPRESS INVESTMENTS, LLC, and
PROPPANT EXPRESS SOLUTIONS, LLC
Petitioner,

v.

OREN TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2018-00914
Patent 9,511,929 B2

Before ANDREI IANCU, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*,
DREW HIRSHFELD, *Commissioner for Patents*, and
SCOTT R. BOALICK, *Acting Chief Administrative Patent Judge*.

BOALICK, *Acting Chief Administrative Patent Judge*.

DECISION

Granting Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

Denying Petitioner's Motion for Joinder
35 U.S.C. § 315(c)

Denying Institution of *Inter Partes* Review
35 U.S.C. § 315(b)

I. INTRODUCTION

Proppant Express Investments, LLC and Proppant Express Solutions, LLC (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claim 4 of U.S. Patent No. 9,511,929 B2 (Ex. 1004, “the ’929 patent”). Oren Technologies, LLC (“Patent Owner”) filed a Preliminary Response (Paper 11) to the Petition. Petitioner also filed a Motion for Joinder (Paper 3, “Mot.”) requesting that it be joined to a pending proceeding, IPR2017-02103 (“the 2103 IPR”). Patent Owner filed an Opposition to the Motion for Joinder (Paper 7), and Petitioner filed a Reply in Support of the Motion for Joinder (Paper 8).

In the 2103 IPR, Petitioner requested an *inter partes* review of claims 1–7, 10, and 12–19 of the ’929 patent. Mot. 1. Patent Owner filed a Preliminary Patent Owner Response which, among other things, pointed out that Petitioner had failed to account for all of the limitations of claim 4 under the ground asserted against claim 4. *Id.* at 3. Although the Board instituted an *inter partes* review, it did not institute on the ground challenging claim 4 for this reason. *Id.* Thereafter, Petitioner filed the Petition and Motion for Joinder in this case to correct the error for claim 4. *Id.* at 4. The Board denied the Petition and Motion for Joinder. Paper 21, 2. The Board interpreted 35 U.S.C. § 315(c) as providing authority to join only “other parties to existing proceedings without introducing new issues of patentability.” *Id.* at 4. Thus, the Board denied the Motion for Joinder because Petitioner is already a party to the 2103 IPR and sought to introduce new issues to the 2103 IPR. *Id.* at 6. The Board denied the Petition under 35 U.S.C. § 315(b) because Petitioner had been served with a complaint

alleging infringement of the '929 patent more than one year before the date on which the Petition in this proceeding was filed. *Id.*

Petitioner requested rehearing of the Board's decision. Paper 22, 1–2. Because Board decisions conflict on the proper interpretation of § 315(c), the Precedential Opinion Panel (“POP”) ordered a review on rehearing to address the following issues:

1. Under 35 U.S.C. § 315(c) may a petitioner be joined to a proceeding in which it is already a party?
2. Does 35 U.S.C. § 315(c) permit joinder of new issues into an existing proceeding?
3. Does the existence of a time bar under 35 U.S.C. § 315(b), or any other relevant facts, have any impact on the first two questions?

Paper 24, 2 (citing Standard Operating Procedure 2 (“SOP 2”),¹ 3–7).

Petitioner and Patent Owner each filed an additional brief addressing the POP review issues (Paper 26, “Pet. Br.”; Paper 25, “PO Br.”), and each party filed a response to the other party's additional brief (Paper 34, “Pet. Resp.”; Paper 33, “PO Resp.”). Several *amici curiae*—The Naples Roundtable, IXI IP, LLC, American Intellectual Property Law Association, Mr. David Boundy, Biotechnology Innovation Organization, and Microsoft Corporation—filed briefs addressing the POP review issues. Paper 27 (“Naples Br.”); Paper 28 (“IXI Br.”); Paper 29 (“AIPLA Br.”); Paper 30 (“Boundy Br.”); Paper 31 (“BIO Br.”); Paper 32 (“MS Br.”). An oral hearing was held on January 31, 2019, and a transcript of the hearing is included in the record. Paper 37 (“Tr.”).

¹ Available at <https://go.usa.gov/xPMqx>.

As noted above, Petitioner's request for rehearing has been granted to address the POP review issues. As to the first two issues, we conclude that 35 U.S.C. § 315(c) provides discretion to allow a petitioner to be joined to a proceeding in which it is already a party and provides discretion to allow joinder of new issues into an existing proceeding. We further conclude that the existence of a time bar under 35 U.S.C. § 315(b) is one of several factors that may be considered when exercising our discretion under § 315(c). In order to balance various considerations, including those raised by other statutes such as the time bar of § 315(b), the Board will exercise this discretion only in limited circumstances—namely, where fairness requires it and to avoid undue prejudice to a party. Circumstances leading to this narrow exercise of our discretion may include, for example, actions taken by a patent owner in a co-pending litigation such as the late addition of newly asserted claims. On the other hand, the Board does not generally expect fairness and prejudice concerns to be implicated by, for example, the mistakes or omissions of a petitioner.

As discussed below in more detail, the Petition for *inter partes* review and the Motion for Joinder in this case are denied because the request for joinder was filed as a result of Petitioner's errors, there are no fairness or undue prejudice concerns implicated, and the Petition is otherwise time-barred under § 315(b). The Board declines to exercise its discretion under § 315(c) in this case.

II. ANALYSIS

A. POP Review Issues

1. Same Party Joinder

The first issue for POP review is whether 35 U.S.C. § 315(c) permits a petitioner to be joined to a proceeding in which it is already a party.

Paper 24, 2. We conclude that it does. However, as explained in more detail in Part 3, the Board will exercise its discretion to grant joinder in situations involving same-party joinder only in limited circumstances.

Section 315(c) states that

[i]f the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(c). Petitioner and some *amici* argue that § 315(c) provides discretion to join any person who is not the patent owner to a proceeding.

Pet. Br. 9; Naples Br. 3; MS Br. 5. Patent Owner and other *amici* argue that § 315(c) only provides authority to join a person who is not already a party to a proceeding. PO Br. 5; IXI Br. 6; BIO Br. 5.

Statutory interpretation “begins with ‘the language of the statute.’” *Hughes Aircraft Co. v. Jacobson*, 525 U.S. 432, 438 (1999). Section 315(c) provides discretion to “join as a party . . . *any person* who properly files a petition under section 311 that . . . warrants the institution of an inter partes review under section 314.” 35 U.S.C. § 315(c) (emphasis added). “[T]he word ‘any’ naturally carries ‘an expansive meaning.’” *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1354 (2018). “When used . . . with a ‘singular noun

in affirmative contexts,’ the word ‘any’ ordinarily ‘refer[s] to a member of a particular group or class without distinction or limitation’ and in this way ‘impl[ies] every member of the class or group.’” *Id.* Thus, by using the expansive phrase “any person” in § 315(c), Congress provided discretion, should the Director find it appropriate, to join every person who properly files a petition that warrants institution.

Further, “[i]t is a ‘fundamental canon of statutory construction that the words of a statute must be read in their context and with a view to their place in the overall statutory scheme.’” *Mylan Pharms. Inc. v. Research Corp. Techs., Inc.*, 914 F.3d 1366, 1373 (Fed. Cir. 2019). In *Mylan*, the Federal Circuit rejected an “argument [that] would require [it] to read the word ‘party’ differently between § 315 and § 319.” *Id.* Here, the word “person” appears in both § 311 and § 315. Specifically, § 311(a) states that “*a person who is not the owner of a patent* may file with the Office a petition to institute an inter partes review of the patent.” 35 U.S.C. § 311(a) (emphasis added). And § 315(c) states that “the Director, in his or her discretion, may join as a party to that inter partes review *any person* who properly files a petition under section 311.” 35 U.S.C. § 315(c) (emphasis added). Thus, when § 315(c) is read in context with § 311(a), Congress specified that any person except the patent owner can be joined to a proceeding, at the Director’s discretion. Congress could have placed other limits on joinder under § 315(c), such as prohibiting joinder of a person who is already a petitioner in a proceeding, but did not. There is no exclusion for a person who is already a petitioner in a proceeding.

We are not persuaded by the arguments of Patent Owner and some *amici* that § 315(c) does not permit same party joinder, and we decline their

invitation to read the word “person” differently between § 311 and § 315. In particular, Patent Owner and some *amici* argue that the phrase “join as a party” in § 315(c) limits the phrase “any person” to those persons who are not already a party to a proceeding. PO Br. 4–5; IXI Br. 6–7; BIO Br. 5–6. But such a limitation is not found in the statute. One *amicus* points out that the term “join” ordinarily means “[t]o unite, connect, or associate physically so as to make, act, work, appear, hold together, or the like, as one,” and the phrase “joinder of parties” ordinarily means “[t]he combination of two or more persons or entities as plaintiffs or defendants in a civil lawsuit.” BIO Br. 6 (citing WEBSTER’S NEW INTERNATIONAL DICTIONARY 1339 (2d ed. 1945); BLACK’S LAW DICTIONARY 965 (10th ed. 2014)). Thus, it is argued, the phrase “join as a party” in § 315(c) does not include adding a person who is already a party to a proceeding. BIO Br. 5–6.

This argument, however, over-emphasizes dictionary definitions taken out of context. For example, nothing in these dictionary definitions prevents two different petitions from the same party being “united” or “connected,” “so as to act as one,” especially in the context of the specific statutory scheme at issue here. In particular, this argument focuses on the phrase “join as a party” in isolation from the rest of § 315(c), and related statutes such as § 311. *See Hibbs v. Winn*, 542 U.S. 88, 101 (2004) (“[W]e follow ‘the cardinal rule that statutory language must be read in context [since] a phrase gathers meaning from the words around it.’”). Rather, the statutory phrase “any person” broadly applies to the phrase “join as a party,” thereby providing discretion to join, if appropriate, any person who properly files a petition that warrants institution.

Turning from the plain statutory text, Patent Owner and some *amici* argue that, according to the legislative history, § 315(c) was intended to allow only a different petitioner to join a proceeding. PO Br. 5–6; IXI Br. 7–8; BIO Br. 9. Patent Owner and those *amici* point to the House Committee Report, which states that “[t]he Director may allow other petitioners to join an inter partes or post-grant review.” H.R. Rep. No. 112-98, pt. 1, at 76 (June 1, 2011). We do not find this argument persuasive. First, it is not clear that legislative history is pertinent with respect to who may be joined to a proceeding. *Gilead Sciences, Inc. v. Lee*, 778 F.3d 1341, 1348 (Fed. Cir. 2015) (“[T]he authoritative statement is the statutory text, not the legislative history or any other extrinsic material.” (quoting *Exxon Mobil Corp. v. Allapattah Servs., Inc.*, 545 U.S. 546, 568 (2005)) (alteration in original)). In any event, even if we were to consider this legislative history, there is no specific statement of exclusion that would limit the expansive meaning of “any person” in § 315(c). Although the House Committee Report refers to joining “other petitioners” to a proceeding, it does not preclude joining a person who is already a petitioner in a proceeding.

Patent Owner states that the Board previously “reasoned that because ‘there does not appear to be any language in the statute directly *prohibiting* the joinder of issues by the same party,’ it had the power to permit” same party joinder. PO Br. 6–7 (citing *Ariosa Diagnostics v. Isis Innovation Ltd.*, Case IPR2012-00022, slip op. at 19 (PTAB Sept. 2, 2014) (Paper 166)). Patent Owner argues that, under *SAS*, the Board does not have authority to grant same party joinder simply because § 315(c) fails to prohibit it. PO Br. 7 (citing *SAS*, 138 S. Ct. at 1355). We do not agree. This is not a

situation where the statute simply fails to prohibit same party joinder. Rather, as explained in detail above, by using the expansive phrase “any person” in § 315(c), Congress expressly provided discretion to join a person who is already a petitioner in a proceeding.

Patent Owner and some *amici* argue that consolidation under 35 U.S.C. § 315(d), rather than joinder under § 315(c), is the proper procedure for combining two proceedings that have the same petitioner. PO Resp. 3–4; IXI Br. 8–9; BIO Br. 6–7. One *amicus* argues that otherwise § 315(d) would be superfluous. BIO Br. 6. We do not agree. Section 315(d) states that

[n]otwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.

35 U.S.C. § 315(d). The language of § 315(d) is different than § 315(c) because, among other things, § 315(d) allows for consolidation of an *inter partes* review with any other proceeding or matter involving that patent before the Office, whereas § 315(c) instead relates to joinder of two *inter partes* reviews. Joinder and consolidation are two separate and distinct ways of managing parallel USPTO proceedings, with different requirements and limitations. Even if applying § 315(c) might lead to the same result as applying § 315(d) in some cases, the rationales and requirements of each statute are separate and distinct. Therefore, interpreting § 315(c) to allow for same party joinder does not render § 315(d) superfluous.

One *amicus* argues that several other statutes show that Congress uses the phrase “join as a party” to mean adding a different party. BIO Br. 8. We are not persuaded. Although § 315(c) and the statutes cited by the *amicus* all use the phrase “join as a party,” § 315(c) contains broader language regarding who may be joined. As discussed in detail above, under § 315(c), any person (except the patent owner) may request joinder to an existing *inter partes* review proceeding. In contrast, the statutes cited by the *amicus* do not permit any person to request joinder. Rather, those statutes expressly limit joinder to certain persons, such as those who have an interest in or are affected by the matter to which joinder is sought. *See* 15 U.S.C. § 80a-12(d)(1)(I) (2010) (limiting joinder to “the issuer of any security purchased or otherwise acquired in violation of this paragraph”); 49 U.S.C. § 46109 (2018) (limiting joinder to “[a] person interested in or affected by a matter under consideration in a proceeding before the Secretary of Transportation”); 49 U.S.C. § 1152 (1994) (limiting joinder to “[a] person interested in or affected by a matter under consideration” in an aviation proceeding). Furthermore, the statutes cited by the *amicus* do not expressly prohibit joinder of a person who is already a party.

One *amicus* argues that interpreting § 315(c) to permit same party joinder would promote gamesmanship. BIO Br. 9–10. In particular, this *amicus* argues that allowing same party joinder could enable a petitioner to file a first petition with some grounds of unpatentability and then use the patent owner’s preliminary response and the Board’s institution decision as a guide to file a second petition. *Id.* This is indeed a possibility, and such gamesmanship should be avoided. But a *per se* prohibition of same party joinder could just as easily allow for gamesmanship. For example, a district

court plaintiff might strategically wait to alter or add late-asserted patent claims in an attempt to wait out the one-year bar on filing an *inter partes* review petition. Perhaps cognizant of these possibilities, Congress provided discretion in § 315(c) and not a *per se* rule one way or the other. As discussed below, the Board will exercise this discretion only in limited circumstances. In the exercise of its discretion, and among other factors, the Board will consider gamesmanship attempts by either party to a proceeding.

2. *Issue Joinder*

The second issue for POP review is whether 35 U.S.C. § 315(c) permits joinder of new issues to an existing proceeding. Paper 24, 2. We conclude that it does. However, as explained in more detail in Part 3, we will exercise our discretion to grant joinder in situations involving new issues only in limited circumstances.

Petitioner and several *amici* argue that § 315(c) provides discretion to join new issues to a proceeding. Pet. Br. 1; Naples Br. 6; IXI Br. 9; BIO Br. 11; MS Br. 5. Patent Owner argues that § 315(c) provides authority to join only a new party, not new issues. PO Br. 7.

Starting with the statutory language itself, there is no express prohibition against raising new issues. Section 315(c) requires a person requesting joinder to “properly file[] a petition under section 311.” 35 U.S.C. § 315(c). Section 311 specifies that a petition may request an *inter partes* review only on grounds “raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications,” but otherwise does not limit the issues that can be raised. 35 U.S.C. § 311(b). Thus, by referencing § 311 in § 315(c), Congress allowed a petition accompanying a request for joinder to raise any grounds under § 102 or

§ 103 on the basis of patents or printed publications. If Congress had wanted to limit the scope of a petition accompanying a joinder request to only those issues raised in the existing proceeding to which joinder is sought, it could have included such a limitation in § 315(c). Tellingly, it did not.

Section 315(c) also requires that a petition accompanying a request for joinder “warrants the institution of an inter partes review under section 314.”

35 U.S.C. § 315(c). Under § 314(a), a petition warrants institution if

the information presented in the petition filed under section 311 and any response filed under section 313 shows that *there is a reasonable likelihood that the petitioner would prevail* with respect to at least 1 of the claims challenged in the petition.

35 U.S.C. § 314(a) (emphasis added). The petition in an existing proceeding to which joinder is sought would have already been determined to warrant institution under § 314. Thus, by referencing § 314 in § 315(c), Congress required a separate determination that the petition accompanying a joinder request shows a reasonable likelihood of prevailing on at least one claim. If the petition accompanying a joinder request could only raise the exact same issues as the petition in an existing proceeding, then a separate determination under § 314 would be superfluous of the determination already made in the existing proceeding. *See Hibbs*, 542 U.S. at 101 (“The rule against superfluities complements the principle that courts are to interpret the words of a statute in context.”). Thus, the language of § 315(c) indicates that new issues can be joined to a proceeding if a petition filed with a request for joinder satisfies the “reasonable likelihood” standard.

This interpretation of § 315(c) is consistent with the legislative history. For example, Senator Kyl stated that

[i]f a party seeking joinder also presents additional challenges to validity that satisfy the threshold for instituting a proceeding, the Office will either join that party *and its new arguments* to the existing proceeding, or institute a second proceeding for the patent.

157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (emphasis added). In other words, the legislative history supports the position that Congress expected that a petition filed with a request for joinder may include new issues, and that the Office would have discretion to join those new issues to an existing proceeding.

The arguments by Patent Owner that § 315(c) does not permit issue joinder are not convincing. Patent Owner argues that § 315(c) refers only to joinder of parties, not joinder of issues. PO Br. 7. We do not agree. As explained in detail above, the language of § 315(c) broadly allows a petition accompanying a joinder request to raise any issues that are appropriate for an *inter partes* review, not just the issues raised in an existing proceeding to which joinder is sought. Thus, § 315(c) expressly provides authority to join new issues to an existing proceeding.

Patent Owner argues that the petition requirement of § 315(c) “serves many purposes, such as ensuring that joinder is voluntary and that the petitioner and its IPR are not barred under §§ 315(a) or (b),” and also “is necessary to confirm that [the second petition] is substantively the same as the first petition.” PO Br. 7–8; PO Resp. 3. Patent Owner, therefore, contends that the petition requirement of § 315(c) “is not evidence that new issues can be joined to an existing proceeding.” PO Br. 8. But although the petition requirement of § 315(c) may serve several purposes, including those Patent Owner identifies, that does not negate the fact that § 315(c) expressly

allows, as discussed above, a petition accompanying a joinder request to raise new issues.

Patent Owner argues that the “reasonable likelihood” standard in § 314(a) is used to decide whether an “IPR on the second petition could proceed even if a motion for joinder fails,” not to decide whether to join new issues to an existing proceeding. PO Resp. 2–3. But § 315(c) does not state that the “reasonable likelihood” standard is applied when a motion for joinder fails. Rather, § 315(c) states that the “reasonable likelihood” standard is applied when determining whether to grant a request for joinder and the accompanying petition, just as it would be when considering institution of any petition.

Patent Owner argues that consolidation under § 315(d), rather than joinder under § 315(c), is the proper procedure for combining two proceedings that present different issues. PO Br. 8–9; PO Resp. 3–4. Patent Owner contends that Congress intentionally created a distinction between joinder of parties under § 315(c) and consolidation of issues under § 315(d). PO Resp. 3–4. But there are many differences between § 315(c) and § 315(d). As discussed above, joinder and consolidation are two separate and distinct ways of managing parallel proceedings, each with different requirements and limitations. As just one example, joinder under § 315(c) relates only to *inter partes* reviews, whereas § 315(d) allows consolidation of an *inter partes* review of a patent with any other proceeding or matter involving that patent before the Office. Again, even if applying both § 315(c) and § 315(d) might arguably lead to a similar result in some cases, the rationales and requirements of each statute are separate and distinct.

Thus, the presence of consolidation in § 315(d) does not prohibit issue joinder under § 315(c).

Patent Owner argues that the concurrence in *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1020 (Fed. Cir. 2017) supports its interpretation of § 315(c). PO Br. 9–10. We are not persuaded. The concurrence in *Nidec* states that

The issue in this case is whether the time bar provision allows a time-barred petitioner to add new issues, rather than simply belatedly joining a proceeding as a new party, to an otherwise timely proceeding. Section 315(c) does not explicitly allow this practice. We think it unlikely that Congress intended that petitioners could employ the joinder provision to circumvent the time bar by adding time-barred issues to an otherwise timely proceeding, whether the petitioner seeking to add new issues is the same party that brought the timely proceeding, as in this case, or the petitioner is a new party.

Nidec, 868 F.3d at 1020. Thus, the concurrence in *Nidec* addresses the issue of whether a party who is time-barred under § 315(b) can join new issues to an existing proceeding under § 315(c), not whether issue joinder is allowed generally under § 315(c). We address the impact of the § 315(b) time bar on issue joinder in more detail below. Suffice to say, the Board will exercise its discretion to allow a time-barred party to join new issues to an existing proceeding only in limited circumstances.

One *amicus* argues that the Federal Rules of Civil Procedure and the Federal Rules of Bankruptcy distinguish between joinder of parties and joinder of issues. BIO Br. 8. Therefore, this *amicus* argues, Congress is familiar with the distinction and could have expressly provided for issue joinder in § 315(c). *Id.* We do not agree. Here, § 315(c) provides for both joinder of parties and joinder of issues. As explained in detail above, the

language of § 315(c) broadly allows a petition accompanying a joinder request to raise any issues that are appropriate for an *inter partes* review, not just the issues raised in an existing proceeding to which joinder is sought. Thus, § 315(c) expressly provides authority to join new issues to an existing proceeding.

3. *Time Bar under § 315(b)*

The third issue for POP review is whether the existence of a time bar under 35 U.S.C. § 315(b), or any other relevant facts, have any impact on the first two questions. Paper 24, 2. We conclude that the existence of a time bar is one of several factors that may be considered when exercising our discretion under § 315(c). In general, the Board will exercise this discretion only in limited circumstances where fairness requires it and to avoid undue prejudice to a party. Circumstances which may justify this narrow exercise of discretion may include, for example, actions taken by a patent owner in a co-pending litigation such as the late addition of new asserted claims. On the other hand, the Board does not generally expect fairness and prejudice concerns to be implicated, for example, where a petitioner merely corrects its mistakes or omissions.

Section 315(b) states that

[a]n *inter partes* review 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. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

35 U.S.C. § 315(b). Petitioner argues that the § 315(b) time bar does not impact same party or issue joinder because § 315(b) includes an exception for joinder under § 315(c). Pet. Br. 10. Patent Owner and some *amici* argue

that § 315(b) bars any petition filed after the one-year time limitation, even if accompanied by a request for joinder under § 315(c). PO Br. 11; IXI Br. 11–12; BIO Br. 14. Patent Owner and one *amicus* also argue that § 315(c) requires a properly filed petition that warrants institution, and, thus, a petition filed with a request for joinder must still comply with the one-year time limitation of § 315(b). PO Br. 11–12; PO Resp. 7–8; IXI Br. 12–14. Other *amici* argue that the § 315(b) time bar is one of several factors that may be considered as part of the discretion to grant joinder under § 315(c). Naples Br. 10; AIPLA Br. 9; MS Br. 8.

The statutory language is dispositive. The first sentence of § 315(b) places a time limitation on the filing of a petition. The second sentence of § 315(b) refers back to “[t]he time limitation set forth in the preceding sentence” and provides an exception to that time limitation for a request for joinder under § 315(c). The only time limitation in “the preceding sentence” applies to the filing of a petition; there is no statutory time limitation in the prior sentence or elsewhere on the filing of a request for joinder.² Thus, the purpose of the exception in the second sentence must be to exempt the petition that accompanies a joinder request from the time limitation in the first sentence.³ *See Hibbs*, 542 U.S. at 101 (“[W]e follow ‘the cardinal rule

² There is no statute that specifies any particular time limit for a request for joinder. The only time limit specified in § 315(b) is the one-year window between service of an infringement complaint and the petition. Instead, the time limitation on filing a request for joinder is provided by USPTO regulation, in 37 C.F.R. § 42.122(b), which states that a request for joinder must be filed no later than one month after institution of the proceeding to which joinder is requested.

³ This interpretation of § 315(b) is consistent with 37 C.F.R. § 42.122(b), which states that “[t]he time period set forth in § 42.101(b) shall not apply

that statutory language must be read in context [since] a phrase gathers meaning from the words around it.’ . . . The rule against superfluities complements the principle that courts are to interpret the words of a statute in context.”); Pet. Br. 10–11. Taken as a whole, therefore, the statute provides discretion to grant joinder in appropriate circumstances even after the time limitation set forth in the first sentence of § 315(b).

Indeed, a *per se* prohibition of joinder for any petition filed after the one-year time limitation of § 315(b) could create undesirable incentives. For example, a district court plaintiff might strategically wait to alter or add late-asserted claims in an attempt to wait out the one-year bar on filing an *inter partes* review petition. This could lead to inefficiencies because parties could game the system by delaying full disclosure of all of the claims in dispute to avoid full review of those claims in an *inter partes* review. It also may encourage a petitioner to hedge against the time bar and challenge more claims than the patent owner asserted, and thus more claims than are necessary to resolve the dispute, thereby increasing the costs and decreasing the efficiency of the entire system.

This does not mean, however, that the exception should swallow the rule. The one-year time limitation of § 315(b) is important to ensure “quiet title to patent owners” and to prevent *inter partes* review from being “used as [a] tool[] for harassment.” H.R. Rep. No. 112-98, pt. 1, at 48 (June 1, 2011). Broadly exercising the discretion granted to the Director in § 315(c) could effectively circumvent the time limitation in § 315(b) in many cases. This would obviate the careful statutory balance.

when the petition is accompanied by a request for joinder.”

Thus, when an otherwise time-barred petitioner requests same party and/or issue joinder, the Board will exercise this discretion only in limited circumstances—namely, where fairness requires it and to avoid undue prejudice to a party. We do not provide an exhaustive list of those circumstances here. As a general matter, however, circumstances leading to this narrow exercise of discretion may include, for example, actions taken by a patent owner in a co-pending litigation—such as the late addition of newly asserted claims. On the other hand, the Board does not generally expect fairness and prejudice concerns to be implicated by, for example, a petitioner’s mistakes or omissions. The conduct of the parties and attempts to game the system may also be considered. In this way, the Board can carefully balance the interest in preventing harassment against fairness and prejudice concerns on a case-by-case basis, based on the facts then before it.

Other factors may also be important when considering this discretion. For example, the stage and schedule of an existing *inter partes* review might make joinder to that proceeding inappropriate. Also, consideration of the non-exclusive factors set out in *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i), may support the exercise of the Board’s discretion to deny institution under § 314(a). Events in other proceedings related to the patent at issue may also weigh on the Board’s exercise of discretion in a given case.

B. *Petition and Motion for Joinder*

In this case, we decline to exercise our discretion pursuant to § 315(c). Petitioner requested an *inter partes* review of claim 4 in the 2103 IPR, but Petitioner erroneously did not make out a proper case in the petition. Mot. 3.

Petitioner acknowledges that it filed the Petition and Motion for Joinder in this case in order to correct the error for claim 4 in the 2103 IPR. *Id.* at 4; Tr. 10:1–11:2. Because Petitioner’s own conduct created the need for it to request joinder, this case does not involve one of the limited circumstances in which the Board will exercise its discretion to allow same party and/or issue joinder. As explained above, allowing joinder in cases such as this could effectively vitiate the time limitation of § 315(b) and obviate the careful balance the statute and legislative history contemplate. The Motion for Joinder is denied.⁴

Since the request for joinder is denied, we must determine whether we can or would separately institute the Petition, absent the joinder request. Here, we cannot do so. Petitioner acknowledges that it was served with a complaint alleging infringement of the ’929 patent more than one year before the date on which the Petition was filed. Pet. 5. Because the Motion

⁴ Additionally, as the concurrence in the decision on institution explains, separate and apart from discretion under § 315(c), the Board would decline to institute an *inter partes* review in this case under the non-exclusive factors set forth in *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. at 16 (PTAB Sept, 6, 2017) (Paper 19) (precedential), because: (1) Petitioner filed a previous petition in the 2103 IPR challenging the same claim; (2) this Petition applies prior art that Petitioner was aware of when it filed the previous petition; (3) Petitioner acknowledges that it filed this Petition to correct an error in the previous petition that the preliminary response and the decision on institution in the 2103 IPR both identified; (4) Petitioner’s only explanation for the time elapsed between the previous petition and this Petition is that it failed to “appreciate” its error; and (5) the addition of new issues to the 2103 IPR would require modifying the schedule and would make it more difficult to issue a final written decision within the one-year statutory timeframe.

for Joinder is denied in this case, the exception to § 315(b) does not apply. Therefore, the Petition is denied as untimely under § 315(b).

III. CONCLUSION

Section 315(c) provides discretion to grant same party and issue joinder, but the Board will exercise its discretion only in limited circumstances where fairness requires it and to avoid undue prejudice to a party. In this case, we decline to exercise our discretion under § 315(c) because Petitioner's own conduct created the need for it to request joinder. Therefore, the Motion for Joinder is denied.

The first sentence of § 315(b) prevents the Board from instituting a petition filed more than one year after service of a complaint for patent infringement. The second sentence of § 315(b) provides an exception to the one-year time limitation in case the Director exercises discretion to join pursuant to § 315(c). As discussed, we do not find it appropriate to exercise that discretion here, and therefore there is no exception to the time limitation. Because Petitioner was served with a complaint alleging infringement of the '929 patent more than one year before the date on which the Petition was filed, the Petition is denied and no trial is instituted.

IV. ORDER

It is hereby

ORDERED that Request for Rehearing is *granted* to address the POP review issues;

FURTHER ORDERED that the Motion for Joinder is *denied*; and

FURTHER ORDERED that the Petition is *denied*, and no trial is instituted.

IPR2018-00914
Patent 9,511,929 B2

For PETITIONER:

Mark T. Garrett
W. Andrew Liddell
Catherine Garza
Jeremy B. Albright
Jeffrey P. Kitchen
Charles B. Walker, Jr.
NORTON ROSE FULBRIGHT US LLP
mark.garrett@nortonrosefulbright.com
andrew.liddell@nortonrosefulbright.com
cat.garza@nortonrosefulbright.com
jeremy.albright@nortonrosefulbright.com
jeff.kitchen@nortonrosefulbright.com
charles.walker@nortonrosefulbright.com

For PATENT OWNER:

Gianni Cutri
Eugene Goryunov
Adam Kaufmann
Kyle Kantarek
KIRKLAND & ELLIS LLP
gianni.cutri@kirkland.com
eugene.goryunov@kirkland.com
adam.kaufmann@kirkland.com
kyle.kantarek@kirkland.com