



PTAB Rejects Argument of Alleged Master Plan to Circumvent IPR Time Bar

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The Patent Trial and Appeal Board rejected a patent owner's argument that the Board should exercise its discretion to deny a petitioner's *inter partes* review (IPR) petition because Petitioner failed to name a time-barred real party-in-interest (RPI). The PTAB concluded that the evidence of record—including overlapping but minimal legal representation, different accused products and no proof of a preexisting relationship between parties—supported the conclusion that Petitioner had met its burden of identifying all RPIs.

In an IPR over a patent related to managing digital files across networks, Patent Owner argued that Petitioner failed to identify a time-barred party as an RPI, and that as such, the petition should be denied. According to Patent Owner, Petitioner and the alleged RPI shared litigation counsel, pursued a single and unified invalidity defense strategy, were parties to a joint defense agreement and submitted identical invalidity contentions. Patent Owner alleged that Petitioner and the alleged RPI entered a back-room, off-the-books deal to circumvent the IPR statutory time bar and estoppel provisions. Petitioner responded, submitting a declaration from counsel explaining that her limited involvement in the parallel litigation was to argue a Section 101 motion to dismiss, something she had extensive experience doing in that jurisdiction. She also addressed the joint defense agreement and emphasized that neither she nor anyone from her firm advised the alleged RPI in its invalidity contentions—nor did Petitioner receive any input or collaboration from the alleged RPI in preparing the IPRs. The PTAB found no evidence of any back-room, off-the-books deal. Instead, the PTAB recognized that sharing trial counsel in district court by a non-party to an IPR is common and by itself is insufficient to make the non-party an RPI, particularly where the representation was narrow and the accused products in the litigations were different, which was the case here.

The PTAB then rejected Patent Owner’s characterization of the case law as requiring only an analysis of whether the alleged RPI would benefit from having claims canceled or invalidated. The PTAB emphasized that the case law requires more than that, including making a determination as to whether the non-party had a preexisting, established relationship with the petitioner. In those cases, among other things, the parties communicated about the litigation and patents, the petitioners’ business model was to file patent challenges on behalf of other entities and the RPI made a significant payment to the petitioner shortly before the petition was filed. None of these elements were present here and there was no support for a finding that the petition and alleged RPI had an established relationship. Accordingly, the PTAB denied Patent Owner’s request to dismiss the petition because of a failure to name an RPI. Finally, the PTAB rejected Patent Owner’s undeveloped, passing argument that the alleged RPI was a privy of Petitioner.

Practice Tip: A petitioner responding to allegations that they did not disclose an RPI in a PTAB proceeding should emphasize lack of cooperation with an alleged RPI and provide evidentiary support, including in the form of declaration testimony. Conversely, a patent owner challenging an omission of an alleged RPI should focus on showing, for example, a preexisting, established relationship as well as collaboration between the petitioner and the omitted party.

Box Inc. v. Topia Tech. Inc., No. 2023-00427, Paper 17 (P.T.A.B. Aug. 4, 2023).

Categories

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