



Event Spotlight: New York Intellectual Property Association January 2021 PTAB Committee Meeting to Review Recent PTAB Precedential Decisions on Real Party in Interest Issues

The New York Intellectual Property Association's [PTAB Committee](#) will kick off the new year on its January 5, 2021 monthly video conference with a discussion of a trilogy of new PTAB decisions designated as precedential involving real party-in-interest and copycat petition issues.

Partner Charley Macedo serves as co-chair of the PTAB Committee and associate Chris Lisiewski is coordinator of the group. Associate Chandler Sturm and law clerk Devin Garrity will join Charley in presenting this session.

On December 4, 2020, the PTAB announced the designation as precedential of the following three PTAB decisions:

- *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 (Oct. 2, 2020) (precedential) This decision on remand from the Federal Circuit holds that the petitioner was time-barred because the petitioner's client was an unnamed real party-in-interest that had been served with an infringement complaint more than one year before filing the petition.
- *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 (Oct. 6, 2020) (precedential) This decision instituting inter partes review holds that, while petitioners must identify any real parties-in-interest, and must do so in good faith, the Board does not need to resolve a dispute regarding a possible real party-in-interest if it would not impact the Board's institution decision.
- *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (Oct. 28, 2020) (precedential) This decision denying institution and the petitioner's joinder motion applies the factors set forth in *General Plastic* to a copycat petition that the petitioner filed against the challenged patent after its first petition was denied institution.

RPX and SharkNinja are helpful clarifications of PTAB practice now that the Federal Circuit, in view of *Thryv, Inc. v. Click-to-Call Techs., LP*, 140 S. Ct. 1367 (2020), has confirmed that decisions regarding time bars of petition and real party in interest are no



longer considered appealable to the Federal Circuit. See, e.g., *ESIP Series 2 LLC v. Puzhen Life USA LLC*, 958 F.3d 1378 (Fed. Cir. 2020) (holding that decisions on “real parties in interest” are related to institution such that judicial review is precluded under Section 314(d)); *Fitbit, Inc. v. Valencell, Inc.*, 964 F.3d 1112 (Fed. Cir. 2020) (patent owner’s objection to petitioner’s tardy filing of an IPR petition was not reviewable on appeal).

Apple v. Uniloc is also a helpful clarification of PTAB practice in the wake of *Facebook, Inc. v. Windy City Innovations, LLC*’s (953 F.3d 1313 (Fed. Cir. 2020), modified, 973 F.3d 1321 (Fed. Cir. 2020)) clarification on the limited scope of joinder motions.

There will be a CLE presentation on these new decisions and the context in which the issues are being raised, and a discussion of implications.

Members of the PTAB Committee are invited to join at no cost to participate and receive 1 CLE credit. If you are a member of NYIPLA, please make sure you join the PTAB Committee to participate. If you are not yet a member of NYIPLA, now is the time to join so you can participate.

[Learn more about joining the NYIPLA committees.](#)