Precedential Patent Case Decisions During March 2020

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I. Introduction

This paper abstracts what I believe to be the significant new points of law from the precedential decisions in patent cases this month. Cases captions relating to the PTAB are in **red** text. Case captions of extraordinary importance are in **blue** text.

II. Abstracts and New Points of Law

Facebook, Inc. v. Windy City Innovations, LLC, 2018-1400, 2018-1401, 2018-1402, 2018-1403, 2018-1537, 2018-1540, 2018-1541 (Fed. Cir. 3/18/2020).

The panel consisted of Chief Judge Prost, and Judges Plager and O'Malley.

This is a decision on appeals from PTAB cases IPR2016-01156, IPR2016-01157, IPR2016-01158, IPR2016-01159, IPR2017-00659, IPR2017-00709.

Legal issue: 35 USC 315(c): Whether 315(c) allows joinder of new issues. Answer, no.

Legal issue: 35 USC 315(c): Whether 315(c) authorizes same part joinder. Answer, no.

Two of Facebooks IPRs were filed after the 315(b) one-year time bar, with a motion for joinder, and were instituted and joined to existing proceedings. The PTAB found many claims that were challenged only in the later-joined IPRs unpatentable.

The Federal Circuit panel held "that the Board erred in allowing Facebook to join itself to a proceeding in which it was already a party, and also erred in allowing Facebook to add new claims to the IPRs through that joinder."

The Federal Circuit panel stated that "The clear and unambiguous text of § 315(c) does not authorize same-party joinder, and does not authorize the joinder of new issues."

The Federal Circuit panel stated that "Assuming that the Board in fact joined Facebook 'as a party' to its existing IPRs, the question before us is whether § 315(c) authorizes a person to be joined as a party to a proceeding in which it is already a party. The clear and unambiguous language of § 315(c) confirms that it does not."

The Federal Circuit panel stated "Setting aside the question of same-party joinder, the language in 315(c) does no more than authorize the Director to join 1) a person 2) as a party, 3) to an already instituted IPR. This language does not authorize the joined party to bring new issues from its new proceeding into the existing proceeding, particularly when those new issues are other-wise time-barred."

The Federal Circuit panel stated "In sum, we conclude that the clear and unambiguous language of § 315(c) does not authorize same-party joinder, and also does not authorize joinder of new issues, including issues that would otherwise be time-barred."

There is a concurring opinion by the entire panel. The concurring opinion addresses the possibility that the statute is ambiguous, because the Federal Circuit panel opinion concluded the

statute was not ambiguous.

The concurring opinion categorically rejects all of Facebook's arguments why the Court should accord the PTO's *Proppant* decision deference.

> We hold that the clear and unambiguous language of § 315(c) does not authorize same-party joinder or joinder of new issues. [Facebook, Inc. v. Windy City Innovations, LLC, 2018-1400, et al. (Fed. Cir. 3/18/2020).]

> As discussed above, § 315(c) authorizes joinder of a person as a party, not "joinder" of two proceedings. [Facebook, Inc. v. Windy City Innovations, LLC, 2018-1400, et al. (Fed. Cir. 3/18/2020).]