

Time-Barred IPR Petitioners Have Separate Standing to Appeal PTAB Decisions

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In the February 1, 2019 decision of *Mylan Pharms. Inc. v. Research Corp. Techs.*, 2019 U.S. App. LEXIS 3282, ___ F.3d ___, 2019 WL 405682, the Federal Circuit affirmed a PTAB final written decision (FWD) holding claims of U.S. Reissue Patent 38,551 not unpatentable. The Federal Circuit also held that time-barred petitioners who participated in an IPR as a result of joinder have standing to appeal. In finding such standing, the Federal Circuit analyzed the interplay between 35 U.S.C. §§ 315(b), 315(c), and 319.

35 U.S.C. § 315(b), commonly referred to as the IPR “time-bar,” states (emphasis added):

“An 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(c), which governs IPR joinder, states:

“If 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.”

Thus, in cases where an IPR has already been instituted, § 315(c) gives the Director discretion to “join as a party . . . any person who properly files a petition under section 311” (emphasis added). It was by this joinder process that Mylan Pharmaceuticals, Breckenridge Pharmaceuticals, and Alembic Pharmaceuticals became parties to an IPR filed by Argentum Pharmaceuticals against the ‘551 reissue patent of Research Corporation Tech. (RCT), despite having been sued for infringement by RCT more than one year earlier.

Mylan, Breckenridge, and Alembic appealed the PTAB’s FWD upholding the validity of the reissued ‘551 claims. Argentum did not, due to an apparent lack of Article III standing. With the only non-time-barred petitioner out of the appeal, RCT challenged appellants’ standing as not falling within the “zone of interests of 35 U.S.C. § 319” and attempting an “end run around the statutory time-limit for instituting IPR proceedings.” *Mylan*, 2019 U.S. App. LEXIS 3282, at *11 and *14. The Federal Circuit acknowledged that “a statutory cause of action extends only to litigants that ‘fall within the zone of interests protected by the law invoked,’” but that in evaluating this question “we apply traditional principles of statutory interpretation.” *Mylan*, 2019 U.S. App. LEXIS 3282, at *12; citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 128-129 (2014).

Turning to the statutory scheme, the Federal Circuit pointed out that under the § 315(c) joinder provision, a petitioner is joined “as a party”, and that § 319 provides that “[a]ny party to the inter partes review shall have the right to be a party to the appeal” (emphasis added). Because the statute does not distinguish between “parties,” the Federal Circuit concluded that time-barred petitioners that are properly joined under § 315(c) “fall within the zone of interests of § 319 and are not barred from appellate review.” *Mylan*, 2019 U.S. App. LEXIS 3282, at *14.

Takeaway: The decision in *Mylan* provides an example in which two IPR petitioners, neither of which could have reached the Federal Circuit alone, were able to do so by way of the joinder rules. This case provides a roadmap for time-barred petitioners to enter the IPR process by taking advantage of a decision to institute another petitioner’s IPR.

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