

## *Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018 (Fed. Cir. 2021)

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Facebook filed an *inter partes* review (IPR) petition against claims 1–8 of Uniloc 2017 LLC’s patent on Voice over Internet Protocol. Meanwhile, an IPR proceeding was already pending on claims 1–6 and 8 of the same patent, based on a petition filed by Apple and later joined by Facebook. LG Corporation subsequently filed its own petitions that were identical to Facebook’s and sought to join Facebook’s IPRs. Uniloc maintained that 1) Facebook was estopped under 35 U.S.C. § 314(e)(1) from maintaining its separate IPR from the Apple IPR and 2) LG was a real party in interest or privity to Facebook, so it was also estopped from maintaining a separate IPR from Apple’s. In its final written decisions, the U.S. Patent Trial and Appeal Board (Board) held that Facebook was estopped from challenging claims 1–6 and 8, but not claim 7. It also held that LG was not a real party in interest or privity to Facebook. Uniloc appealed both determinations to the U.S. Court of Appeals for the Federal Circuit.

The court first determined that it had jurisdiction to review both of the Board’s conclusions under 35 U.S.C. § 314(d). Based on prior U.S. Supreme Court decisions and the strong presumption of reviewability of agency action, the court held that § 314(d) did not preclude judicial review of the Board’s application of § 315(e)(1)’s estoppel provisions, where the events triggering estoppel occurred after institution of the IPR.

**Finding Uniloc’s challenge to the Board’s estoppel decisions reviewable, the court held that there was substantial evidence that LG was not a real party in interest or privity to Facebook.**

Finding Uniloc’s challenge to the Board’s estoppel decisions reviewable, the court held that there was substantial evidence that LG was not a real party in interest or privity to Facebook. Specifically, the court rejected Uniloc’s argument that, merely because LG joined Facebook’s IPR, it was automatically a real party in interest or privity to Facebook. Finally, the court held that Facebook was not estopped from challenging claim 7 in its own IPR because § 315 explicitly limits its estoppel to previously challenged claims only.