

## Retroactive Estoppel: Acting as Real Party in Interest May Import Estoppel Effects from Earlier-Filed Petitions

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In a decision that could significantly extend the *estoppel* effects of 35 USC § 315(e), the **Patent Trial and Appeal Board (PTAB)** found that estoppel applies to all real parties in interest of an *inter partes* review (IPR) petition if even one of those petitioners was also party to an earlier-filed petition resulting in a final written decision. **Kofax, Inc. v. Uniloc USA, Inc.**, Case No. IPR2015-1207 (PTAB, July 20, 2016) (Prais, APJ).

Section 315(e) states that a “petitioner in an *inter partes* review of a claim in a patent under this chapter that results in a final written decision . . . may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that *inter partes* review.” This provision extends to any “real party in interest or privy of the petitioner.”

This case arises out of a series of IPR petitions challenging the same patent. The earliest such petition, IPR2014-1453, listed Sega, Ubisoft, Kofax and Cambium Learning Group as petitioners. The PTAB instituted a trial on the 1453 petition. While the 1453 trial was pending, Kofax filed a second petition, IPR2015-1207, for the same patent (the Kofax petition). Kofax was the only listed petitioner. After the PTAB instituted trial on the Kofax petition, Ubisoft, Zebra Technologies and Cambium filed a follow-on petition and requested joinder.

Before resolving the joinder motion and before issuing a final decision on the Kofax petition, the PTAB issued a final written decision in the earlier-filed 1453 petition. Subsequently, the PTAB dismissed the Kofax petition, determining that under § 315(e), Kofax was estopped from maintaining its petition because it could have raised these grounds in the earlier-filed 1453 petition. Estoppel also applied to Ubisoft and Cambium as real parties in interest to the 1453 petition. Although Zebra was not itself a petitioner in the earlier 1453 proceeding, the PTAB found that estoppel also applied to Zebra because Zebra was a real party in interest with Ubisoft and Cambium in the follow-on petition.

The PTAB was not persuaded by Zebra’s argument that estoppel should be limited to petitioners and real parties in interest to proceedings that result in a final decision. The PTAB explained that § 315(e) does not contain any “temporal limitation for real parties in interest or privies of a petition,” and so the estoppel provisions also extend to all real parties in interest of petitioners in the earlier proceeding. According to the PTAB, Zebra’s eventual status as a real party in interest to a now-

estopped petitioner would bring the same estoppel effect as if Zebra had itself been listed as a real party in interest in the earlier-filed 1453 petition. The PTAB also denied that Zebra was deprived of its due process rights, explaining that Zebra “had the opportunity to address [in the follow-on] proceedings the effect of estoppel in view of the final written decision in IPR2014-01453.”

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