

NEWS

Unified has won every RPI challenge

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Unified Patents Real Party-in-Interest (RPI) Decisions

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For the past six and a half years, across more than 170 *inter partes* reviews, Unified Patents Inc. has won every real party-in-interest (RPI) challenge---both at institution and on final written decision.

Unified's status as the sole RPI was challenged in its first IPR where the Board held that Unified was the sole RPI. *Unified Patents Inc. v. Clouding IP, LLC*, [IPR2013-00586](#), [Paper 9](#) (Mar. 21, 2014) (members were not found to be RPIs, where there was no evidence of funding or control of the particular IPR; challenged claims were later cancelled in a [Final Written Decision](#) issued April 26, 2015). As catalogued below, Unified overcame every such challenge in the proceeding years. As a result, many times Unified's RPI status was no longer being challenged.

But in 2018, the Federal Circuit had their first opportunity to review the Board's developing RPI jurisprudence in a case involving a different



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membership organization. That opinion endorsed the Board’s long standing RPI test set forth in the Trial Practice Guide, but outlined facts particular to that situation (including a potential time-bar) and characteristics of that different membership organization that merited further scrutiny on remand. *See Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336 (July 9, 2018) (“*AIT*”).

The *AIT* decision led to a resurgence of challenges to Unified’s RPI status. In every ruling after *AIT*, Unified was found to be the sole RPI. As catalogued below, Unified has been distinguished from the facts of *AIT* and the practices of the organization in question. The PTAB has thoroughly reviewed this issue in numerous cases when confirming that Unified was the sole RPI.

Post-*AIT* Decisions

- Institution decision holding that the general benefit a member may receive from Unified’s petition does not make the member an RPI. In addition, evidence that a company is a corporate affiliate of a Unified member is not by itself sufficient to place RPI in dispute.
 - *Unified Patents Inc. v. American Patents, LLC*, [IPR2019-00482](#), [Paper 36](#) (PTAB Aug. 6, 2019).
- Institution decision holding that Unified is the sole RPI and that the mere fact that a member asserted invalidity using the same prior art in district court after Unified filed its petition is not enough, without more, to show a member is an RPI.
 - *Unified Patents Inc. v. MV3 Partners, LLC*, [IPR2019-00474](#), [Paper 9](#) (PTAB July 16, 2019).
- Final decision holding that Unified was the sole RPI and that a member’s decision to file its own petition further supports the conclusion that Unified was not acting under the control or direction of the member.
 - *Unified Patents Inc. v. Uniloc USA, Inc. et al.*, [IPR2018-00199](#), [Paper 33](#) (PTAB May 31, 2019).
- Final decision holding that Unified properly identified all RPIs and that a member “is not an unnamed RPI [. . .] based on any of the following: its membership with Unified; the alleged control over this IPR; or the relationship between [the member] and Unified and the alleged benefit of the IPR to [the member].”

- *Unified Patents Inc. v. Cellular Communications Equipment, LLC*, [IPR2018-00091](#), [Paper 69](#) (PTAB May 22, 2019).
- Final decision holding that Unified was the sole RPI and a member that may benefit from Unified filing the IPR is not an RPI without showing some other evidence of a specific interest in the particular proceeding. Unified’s business model alone was not enough for a member to be found as an RPI.
 - *Unified Patents Inc. v. Universal Secure Registry LLC*, [IPR2018-00067](#), [Paper 54](#) at 72-75 (May 1, 2019).
- Final decision holding that Unified’s IPR was not controlled, funded, nor filed at the behest of one of its members. Found that membership fees are used to fund a variety of Unified’s deterrence activities (“Petitioner is not solely an inter partes review-filing entity”) and distinguishing the factors at issue in the *AIT* decision. “[W]e do not have evidence that Petitioner is representing any particular interest of [a particular member] here. Rather, the evidence shows Petitioner is representing the general interest that all subscribers to Petitioner’s have in mitigating litigation risk from patents in those zones.”
 - *Unified Patents Inc. v. Uniloc 2017 LLC*, [IPR2017-02148](#), [Paper 74](#) at 14-24 (April 11, 2019).
- Final decision finding that Unified’s status as the sole RPI is not in question because “Petitioner’s members join particular zones [and] Petitioner files IPRs on behalf of those zones[.]”
 - *Unified Patents Inc. v. Fall Line Patents, LLC*, [IPR2018-00043](#), [Paper 34](#) at 11-20 (April 4, 2019).
- Institution decision holding that Unified properly identified itself as the sole RPI considering that neither no members had control of, provided funding or direction to, or received a specific benefit (e.g., to purposefully circumvent the one year time-bar) from the filing of the petition.
 - *Unified Patents Inc. v. Barkan Wireless IP Holdings, LP*, [IPR2018-01186](#), [Paper 27](#) at 15-16 (Jan. 8, 2019).
- Institution decision holding that the general benefit members received from Unified’s common practice of filing IPRs in relevant technology

areas was insufficient to demonstrate a specific benefit as discussed in *AIT* even when combined with evidence that Patent Owner engaged in licensing discussions with the alleged RPIs prior to Unified's petition.

- *Unified Patents Inc. v. Bradium Technologies LLC*, [IPR2018-00952](#), [Paper 31](#) at 12 (Dec. 20, 2018).
- Institution decision holding that evidence consisting solely of generic statements from Unified's web page that generally describe its business, but did not refer to any particular member was insufficient to demonstrate that the petition failed to name all RPIs.
 - *Unified Patents Inc. v. Mobility Workx, LLC*, [IPR2018-01150](#), [Paper 9](#) at 4 (Dec. 3, 2018).
- Institution decision rejecting Patent Owner's argument that all members of Unified's Content Zone are RPIs, explaining that "there is no evidence that any of Petitioner's members controlled, directed, or directly financed this proceeding."
 - *Unified Patents Inc. v. Realtime Adaptive Streaming, LLC*, [IPR2018-00883](#), [Paper 36](#) at 16-17 (Nov. 27, 2018) (further noting that there was 1) no communication between Unified and any member regarding the petition or underlying litigation involving the patent; 2) no corporate relationships between Unified and members other than the membership agreement; 3) no evidence of a "very significant payment" shortly before Unified filed its IPR; and 4) no evidence that any member desired review of the patent but was time-barred from doing so.).
 - In a precedential decision, the Board has further cited *Realtime Adaptive* to prohibit overextending AIT to situations that include a general benefit and a relationship with the Petitioner. *Ventex Co. v. Columbia Sportswear N. Am., Inc.*, [IPR2017-00651](#), [Paper 152](#) at 10 (PTAB Jan. 24, 2019) (precedential) (citing *Unified Patents, Inc. v. Realtime Adaptive Streaming, LLC*, [IPR2018-00883](#), [Paper 36](#) at 14-15 (PTAB Oct. 11, 2018)).
- Final decision holding that "the evidence shows that Petitioner makes all decisions regarding any inter partes review proceeding, including which patents to challenge, without input from its members, and that Petitioner alone bears all costs of any such proceeding."

- *Unified Patents Inc. v. Plectrum LLC*, [IPR2017-01430](#), [Paper 30](#) at 9-10 (Nov. 13, 2018); *id.*, [Paper 8](#) (Nov. 14, 2017) (institution decision holding that “[t]he mere fact that members provide payment to Petitioner for a subscription to Petitioner’s services alone is insufficient to show that these members are funding this particular inter partes review.”).

Pre-AIT Decisions

- Institution decision holding that Unified’s revenue coming from annual membership subscription fees does not make members an RPI even if timing of some of those funds was used to argue that the funds could have been used to file the IPR. “The evidence does not show an obligation on Unified’s part to file inter partes review proceedings on behalf of any member in return for payment, nor does it show that Unified’s members have any control over when and how Unified spends the revenue received from its members.”
 - *Unified Patents Inc. v. MONKEYMedia, Inc.*, [IPR2018-00059](#), [Paper 15](#) (Apr. 16, 2018).
- Final decision holding that, in view of Petitioner’s identification of itself as the sole RPI, shifted the burden to the patent owner failed to produce sufficient evidence tending to place the RPI issue in dispute. Patent owner produced no evidence and thus never shifted the burden.
 - *Unified Patents Inc. v. Digital Stream IP*, [IPR2016-01749](#), [Paper 22](#) (Mar. 9, 2018).
- Institution decision finding that Unified’s revenue coming from annual membership subscription fees does not make members an RPI even if timing of some of those funds was used to argue that the funds could have been used to file the IPR.
 - *Unified Patents Inc. v. American Vehicular Sciences, LLC*, [IPR2016-00364](#), [Paper 13](#) (June 27, 2016) ([final decision](#) did not address RPI).
- Institution decision finding that RPI arguments not raising specific evidence of communications or direct funding to challenge any specific patent failed; a “mere possibility” of communications related to the selection of patents did not suffice.

- *Unified Patents Inc. v. Nonend Inventions N.V.*, [IPR2016-00174](#), [Paper 10](#) (May 12, 2016) ([final decision](#) did not disturb the RPI analysis).
- Institution decision holding that Unified’s members were not RPIs where there was no funding or control evidence relating to a specific IPR, even where Unified only filed IPRs against member-litigated patents. Distinguished from the adverse institution decisions in [RPX. v. VirnetX](#), [IPR2014-00171](#), [-00172](#), [-00173](#), [-00174](#), [-00175](#), [-00176](#), [-00177](#) (PTAB June 5, 2014)
 - *Unified Patents Inc. v. Dragon Intellectual Property, LLC*, [IPR2014-01252](#), [Paper 37](#) (Feb. 12, 2015) (claims cancelled in a [Final Written Decision](#) issued Feb. 5, 2016).
- Institution decision distinguished Unified from the *In re Guan* “Trollbusters” *inter partes* reexam decision cited in the PTAB Trial Practice Guide because Unified members did not “[pick] the patents to be challenged and [provide] funding for the particular proceedings[.]”
 - *Unified Patents Inc. v. iMTX Strategic, LLC*, [IPR2015-01061](#), [Paper 9](#) (Oct. 15, 2015) ([final decision](#) did not disturb the institution decision’s RPI analysis).
- Institution decision holding that the timing of Unified’s filing activities being potentially beneficial to particular members or parties did not make such members RPIs.
 - *Unified Patents Inc. v. Hall Data Sync Tech., LLC*, [IPR2015-00874](#), [Paper 11](#) (Sept. 17, 2015) (settled [Dec. 21, 2015](#)).

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