

RPI, I Presume? Petitioner Has Evidentiary Burden that RPIs Are Correct

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Addressing for the first time which party bears the burden of proof as to the accuracy of a petitioner's identification of real parties-in-interest (RPIs) in an *inter partes* review (IPR), the US Court of Appeals for the Federal Circuit found that the petitioner bears the ultimate burden of persuasion. *Worlds Inc. v. Bungie, Inc.*, [Case Nos. 17-1481, -1546, -1583](#) (Fed. Cir. Sept. 2018) (Prost, CJ). In addition, the Court clarified that a petitioner's identification of RPIs does not create a formal presumption of accuracy. As a result, a petitioner must use evidence to carry its burden, if and when a patent owner disputes the identified RPIs.

In 2012, Worlds sued Activision Publishing in district court for infringing various patents related to video gaming. Activision did not file an IPR petition challenging the validity of any claims of the asserted patents. In late 2014, Worlds added a new accused product to the litigation—a product Activision distributed for Bungie under a development and distribution agreement (DevPub Agreement). Although Bungie was not added as a party to the litigation, Bungie filed six IPR petitions on the asserted patents, listing itself as the sole RPI. Worlds argued that Activision should have been named as an RPI, and, as a result, the petition was time barred under § 315(b) because Activision had been served with a complaint alleging infringement of the challenged patents more than one year earlier. The PTAB rejected Worlds' arguments, finding that World had not shown that the DevPub Agreement gave Activision control over the litigation. The PTAB also accepted Bungie's representation that although Activision provided money to Bungie for development, Activision had not funded the IPRs. Worlds appealed.

On appeal, the Federal Circuit rejected the PTAB's RPI analysis because it failed to place the burden of persuasion on the petitioner and it appeared to rely on presumptions instead of actual evidence to support its conclusions. The Court held that as the proponent, the petitioner has the burden of persuasion to show that the RPIs listed in the petition are accurate. While the PTAB may accept the petitioner's identification of RPIs, it does not create a "formal presumption" of accuracy. If the patent owner reasonably challenges the list of RPIs by providing evidence—as it did in this case with the DevPub Agreement—the petitioner must respond with sufficient evidence to carry its burden. Petitioner must provide such evidence in the form of sworn declarations and documentary evidence, and not merely lawyer argument. Because the PTAB's RPI decision appeared to have placed the burden on patent owner to disprove petitioner's identification of RPIs, the Court vacated and remanded.

Practice Note: Worlds failed to appeal the PTAB's final RPI determination in an earlier-decided IPR. Although briefed, the Court did not address whether collateral estoppel applied in this circumstance, and it is unclear whether the PTAB's earlier, non-appealed RPI determination would be controlling in later IPRs.

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