

## Not Interested? PTAB Declines To Find Google a Real-Party-In-Interest—Twice

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Addressing whether an entity should be named as a real-party-in-interest (RPI), the Patent Trial and Appeal Board (PTAB) determined that Google did not need to be listed as an RPI in two separate sets of *inter partes* review (IPR) petitions. *RPX Corp. v. Publishing Techs., LLC*, Case Nos. IPR2018-001131, -001132 (Paper No. 10), Decision on Institution (PTAB Dec. 3, 2018) (Elluru, APJ); *Samsung Electronics Co. Ltd. v. Seven Networks, LLC*, Case Nos. IPR2018-01108 (Paper 21) and -01106 (Paper 22), Decision on Institution (Nov. 28, 2018) (Chang, APJ).

In *RPX v. Publishing Techs.*, Publishing Technologies, the patent owner, argued that because Google had been sued for infringement of the challenged patent, it had an interest in the outcome of the IPR. Publishing Technologies also argued that because Google was a member of RPX, whose services include challenging the validity of patent claims that have been asserted or threatened to be asserted against its members, Google had a relationship with RPX and should have been listed as an RPI. Based on these two factors, Publishing Technologies argued that RPX was acting as Google's attorney-in-fact or agent-in-fact for the IPR. RPX responded that Google did not fund or control the IPRs and did not have an interest in the outcome of the IPR because Google's prior lawsuit ended in summary judgment of non-infringement and the US Court of Appeals for the Federal Circuit affirmed that holding. Although Google had also moved for summary judgment of invalidity, that motion was denied as moot.

The PTAB agreed with RPX and found that Publishing Technologies had not raised a genuine issue that Google should have been listed as an RPI. The PTAB distinguished the facts of *Applications in Internet Time v. RPX* where there had been significant discovery into the specific funding arrangement with RPX. Here, the only evidence Publishing Technologies presented was that Google was a member of RPX and that it had an interest in the outcome of the IPR by virtue of the prior litigation. In rejecting Publishing Technologies' argument, the PTAB clarified that membership in RPX alone did not obligate RPX to list all members as RPIs. Because RPX had sufficiently rebutted the only evidence Publishing Technologies put forward, the PTAB found that RPX met its burden to show that its RPI listing was correct.

In *Samsung Electronics v. Seven Networks*, a similar situation arose with respect to Samsung's alleged failure to list Google as an RPI. Seven Networks, the patent owner, alleged that Google was an RPI or privy of Samsung because Google and Samsung (1) had a pre-existing, established relationship that included indemnification, (2) cooperated in a related district court case involving the challenged patents, (3) would both benefit from the petitions, and (4) each filed their own petitions for IPR of the challenged patents within a few days of one another.

The PTAB found that Google was not an RPI or privy of Samsung. The PTAB determined that the standard customer-supplier relationship between Samsung and Google was insufficiently close to make Google an RPI, even where there were certain indemnity obligations under the relationship. As to the fact that Samsung and Google were cooperating as co-defendants in the district court litigation, including by jointly preparing and filing invalidity contentions, the evidence showed that the parties acted independently with respect to the IPRs. As a result, there was no evidence that Samsung filed the petition at the behest or on behalf of Google.

Using the six-factor privity test from the Supreme Court of the United States' 2008 decision in *Taylor v. Sturgell*,



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the PTAB likewise found no evidence of funding or control because the indemnification agreements related to wholly different products than those accused of infringement in the district court litigations. Moreover, because the parties had acted independently to fund and prepare the IPRs, the PTAB found that Samsung was not acting as proxy for Google. Thus, the PTAB found that Samsung had met its burden to establish that it named the correct RPIs.

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