REAL PARTIES-IN-INTEREST:
GUIDANCE ON WHO IS AN RPI—AND WHO IS NOT—IN POST-GRANT PROCEEDINGS

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In post-grant review proceedings before the U.S. Patent and Trademark Office's Patent Trial and Appeal Board, practitioners who omit any of the parties with an interest in the matter could face consequences as severe as dismissal of the proceeding. To consider a post-grant proceeding, the Patent Trial and Appeal Board insists all real parties-in-interest be identified.

But the rules determining if a party is a real party-in-interest are far from clear. In this article, we examine caselaw to clear some of the confusion and frustration practitioners encounter when assessing who is—and who is not—a real party-in-interest, and offer practical guidance.

REAL PARTIES-IN-INTEREST: GUIDANCE ON WHO IS AN RPI—AND WHO IS NOT—IN POST-GRANT PROCEEDINGS

In *inter partes* review (IPR) or post-grant review (PGR) proceedings, a petitioner files a petition with the Patent Trial and Appeal Board (PTAB) challenging the patentability of a claimed invention. When setting forth its challenge, the petitioner is required to identify all "real parties-in-interest" (RPIs). Whether or not an entity is an RPI is often a significant question, because such a designation invokes time-bar provisions for filing IPRs. It also may determine whether estoppel will apply. But the applicable legal standards are murky and can cause consternation. Here, we examine the caselaw closely and provide guidance to practitioners to help them avoid RPI pitfalls.

Generally, RPIs are understood as persons who or entities that stand to benefit or gain from a legal action. In the IPR context, the PTAB's America Invents Act (AIA) Trial Practice Guide, which governs IPR and PGR proceedings, notes that "[t]he core functions of the 'real party-in-interest' and 'privies' requirements are to assist members of the Board in identifying potential conflicts, and to assure proper application of the statutory estoppel provisions."[1] The Trial Practice Guide states that the PTAB is guided by common law principles and that the inquiry is "highly fact-dependent" and often considers whether entities "exercised or could have exercised control."[2] Just a few years ago, in *Applications in Internet Time* (*AIT*), the U.S. Court of Appeals for the Federal Circuit instructed that "[d]etermining whether a non-party is a 'real party in interest' demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner."[3] While the Federal Circuit set forth certain considerations for the PTAB to assess in determining whether a party is an RPI, it used broad and non-limiting language that ultimately creates some uncertainty about whether a party is an RPI.

The Federal Circuit instructed that determining whether a non-party is a real party-in-interest demands a flexible approach.

There are important consequences tied to the RPI designation. For example, under 35 U.S.C. § 315(b), an IPR petition is time-barred if "filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent." Additionally, under 35 U.S.C. § 315(e)(1), "[t]he petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonable could have raised during" that IPR. Relatedly, § 315(e)(2) describes a similar estoppel that applies to proceedings in courts or in the U.S. International Trade Commission. Whether entities are RPIs has important implications as to their rights to bring future actions. Given the effects of being designated an RPI, and the common desire for entities to maintain their rights to challenge patents, the question of whether entities are, or are not, RPIs has been addressed by the PTAB, including in view of the Federal Circuit's recent guidance. RPI challenges commonly arise where a petitioner has business relationships with other entities, is a co-defendant in related district court litigation, or is a defensive patent aggregator.

Clients of Patent Aggregators Are Not Automatically RPIs

Defensive patent aggregators are companies that offer services to clients relating to reducing risks created by non-practicing entities. Patent aggregators can use strategies such as acquiring patent licenses and challenging patents in PTAB proceedings. Clients of patent aggregators are subject to the same fact-based inquiry used to assess RPIs in other circumstances. While the PTAB has raised concerns that the defensive patent aggregator business model presents issues related to estoppel and repeated attacks on a patent, which squarely relate to the RPI requirement,[4] the PTAB's Trial Practice Guide states that an entity "does not become a 'real party-in-interest' or a 'privy' of [an] Association simply based on its membership in the Association."[5] As detailed below, however, in a recent precedential PTAB opinion on remand from the Federal Circuit, the PTAB found a client of a defensive patent aggregator to be an RPI with the patent aggregator.

To explain, in *AIT* the Federal Circuit addressed the appropriate standard for assessing whether a client (Salesforce) was an RPI of the patent aggregator (RPX). The Federal Circuit approved "a flexible approach" to RPI issues "with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner."[6] While the Federal Circuit did not set forth definitive factors that are relevant to whether a patent aggregator is an RPI, the court admonished the PTAB for failing to adequately consider factors that may be relevant, such as the following:

- The client's relationship with the patent aggregator;
- The nature of the patent aggregator as an entity;
- Whether the patent aggregator filed the IPR to benefit the client;
- The client's interest in the IPR;
- Whether the patent aggregator acted as the client's attorney-in-fact or agent; and
- Whether the client had apparently authorized the patent aggregator to represent its interests.[7]

The Federal Circuit specified that "Congress intended that the term 'real party in interest' have its expansive common-law meaning."[8] The Federal Circuit then remanded the case, and the PTAB found Salesforce should have been named an RPI. In that decision, the PTAB reasoned that RPX set up its business model in part to file IPRs to benefit its clients, that RPX's client would benefit from the IPRs in question, and that RPX represented its client's interest in filing the IPRs.[9] The PTAB further found that RPX's "Best Practices Guide," which governs how it files IPR petitions, reflects that "RPX intentionally operates its business to circumvent the Board's RPI case law" and "suggest[ed] a 'willful blindness' strategy."[10] Thus, given the facts, the PTAB found Salesforce to be an RPI.

In contrast, however, the PTAB has found (and the Federal Circuit has affirmed) under different facts that a client of a patent aggregator was not an RPI. Indeed, several PTAB decisions have found that defensive patent aggregator, Unified Patents, did not fail to name various clients as RPIs, when facts showed that Unified Patents largely acted independently of its clients when filing IPRs.[11] Thus, it is not simply the

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patent aggregator-client relationship that leads to a finding that a client entity is an RPI, but again, a fact-based inquiry that looks into preexisting relationships, control, and which companies stand to benefit.

Related Business Entities Are Often, But Not Always, Real Parties-In-Interest

Petitioners in IPRs frequently have to address whether their parent, subsidiary, or sister companies are RPIs. While the PTAB has not held that related corporations are RPIs per se, close connections and/or "control" will likely result in entities being RPIs. Indeed, in the corporate-relationship context, an assessment of whether or not entities are RPIs typically involves looking at whether a related company directs or exercises control over the petitioner's participation in the proceeding.[12] However, *actual* control is not needed; an RPI relationship can exist if a party possesses the "opportunity to control that might reasonably be expected between two formal coparties."[13] As detailed below, that analysis in the context of parent, subsidiary, and sister corporations can lead to differing results.

1. **Significant overlap between parent-child companies is usually cause for a real party-in-interest finding.** Generally, while the parent-child relationship alone is insufficient to make a parent company an RPI in a child petitioner's IPR, when there is significant overlap between the function and leadership of the parent and child entities, the parent is likely to be deemed an RPI. For example, in *Sirius XM Radio v. Fraunhofer-Gesellschaft*, the parent company was considered an RPI in a child petitioner's IPR when the corporate boundaries were "blurred." The PTAB held that a parent holding company was an RPI when the petitioner was wholly owned by the parent, the parent had no operations independent of the petitioner, and there was complete overlap in officers and business address.[14,15] In so holding, the PTAB also noted the parent holding company's statements to the U.S. Securities and Exchange Commission that announced that it was a defendant in other lawsuits, even though it was the subsidiary and not the parent that was the named defendant.[16]

   Similarly, in *Radware, Inc. v. F5 Networks, Inc.*, the PTAB held that a parent company wholly owning the IPR petitioner entity was an RPI when the petitioner sold the parent's products and acted as its authorized representative, the two companies shared common leadership and common legal counsel in related litigation, and employees of the parent company were offered as corporate witnesses for the subsidiary in related litigation.[17]

   In contrast, in *Par Pharmaceutical, Inc. v. Jazz Pharmaceutical, Inc.*, the PTAB held that the petitioner's holding-company parents were not RPIs, despite substantial overlap between the companies. That was because the petitioner—and not the parents—performed the actions accused of infringement in a related district court action.[18] The PTAB reasoned that "[i]f anything, [Petitioner] Par Inc. (rather than any parent) represents its own interests in this IPR proceeding, even though those interests may inure, ultimately, to the benefit of one or more of its parent companies."[19] It also found persuasive the fact that the parent holding companies did not have their own legal departments or operations that they could use to exert control over the petitioner.[20] Similar to *Par Pharmaceutical*, the PTAB in *LG Electronics, Inc. v. Fundamental Innovation Systems International LLC* did not find the petitioner's parent company to be an RPI, even though it owned more than 30% of the petitioner company and sometimes conducted joint activities with the petitioner.[21]

While the PTAB has not held that related corporations are RPIs per se, close connections and/or "control" will likely result in entities being RPIs.

However, “control” is not always dispositive or necessary when entities are intertwined. Indeed, in at least one instance the PTAB has held that related corporate entities are RPIs even when complete ownership is lacking. In particular, in *Toshiba Memory Corporation v. Anza Technology, Inc.*, the PTAB found that a company owning approximately 40% of the petitioner was an RPI, when the patent owner argued that the related company indemnified the petitioner for patent litigation losses (including likely indemnification for infringement of the patent involved in the IPR petition), and the corporate lines were sometimes blurred.[22]

On the whole, a parent corporation of an IPR petitioner, absent additional factors, is likely insufficient to make the parent an RPI.[23] However, if the parent is involved in the petitioner’s business or conducts business through the petitioner, the PTAB is likely to find that the entities are RPIs.

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2. **Sister corporations are generally RPIs if they are substantially involved in each other’s business operations.** Like its approach for parent-child corporate relationships, the PTAB generally finds a sister corporation to be an RPI when it is “substantially involved” in a petitioner’s corporation generally (e.g., blurry corporate lines) or in the circumstances relevant to the petition. Of note, in *Atlanta Gas Light Company v. Bennett Regulator Guards, Inc.*, the PTAB terminated the petitioner’s IPR when it failed to name parent and sister companies as RPIs, ultimately finding that “at least” the parent is an RPI.[24] The PTAB noted that “corporate blurring” was evident, particularly during contract negotiations when the three companies were casually referred to using an umbrella corporate name[25]—in fact calling the corporate blurring “pervasive.”[26] The PTAB observed that the companies were even referred to as a single unit in correspondence related to the IPR at issue and found that both the parent and sister “had a level of involvement in” the IPR.[27]

   But related companies are not always RPIs. For example, in *Nuseed Americas Inc. v. BASF Plant Science GmbH*, the PTAB declined to name two entities as RPIs even though it found that the two entities had a common parent corporation, referred to themselves as “Nuseed,” and shared a common website.[28] The PTAB looked to positions that the entities had taken in a related district court proceeding, where they had not held themselves out as a single entity and had not ignored corporate formalities.[29] In so concluding, the PTAB found that the patent owner had not asserted that the sister entity—which was located in Australia—had an interest in securing freedom to operate in the United States that would render it an RPI.[30] The PTAB similarly has found that other situations involving more removed companies within a petitioner’s corporate structure, without other factors also showing an RPI relationship, do not create RPI relationships.[31]

3. **Subsidiaries are likely to be RPIs when a subsidiary has specific involvement or interest in the proceeding.** Consistent with the PTAB’s general test for RPIs, when considering whether subsidiaries are RPIs, the PTAB tends to look at whether a subsidiary has control over the proceedings.

   For example, in *Petroleum Geo-Services Inc. v. WesternGeco LLC*, the PTAB found that the petitioner’s subsidiary was not an RPI, even though it had a financial interest in the outcome of the proceeding. The PTAB reasoned that "[t]he fact that [the subsidiary] may be related to Petitioner and is indicated as having a financial interest in the outcome of litigation, however, does not by itself indicate that [the subsidiary] has any ability to control the present IPR proceeding."[32] By comparison, in *Medtronic, Inc. v. Robert Bosch Healthcare Systems, Inc.*,[33] the PTAB found a subsidiary to be an RPI where:

- it had an interest in invalidating the patents at issue;
- it had previously filed its own unsuccessful IPRs[34] on the same patents using similar art;
- it used the same legal counsel and expert;
- the petitioner and its subsidiary had communicated about the preparation or filing of the IPR petitions; and
- the subsidiary paid at least some IPR fees.[35]

The PTAB also found it persuasive that in related district court litigation, the subsidiary referred to the group of IPRs filed by itself and Medtronic as its own IPRs.[36]

Company relationships outside of the formal corporate family relationship may nevertheless create RPI relationships.

4. **Corporate relationships outside formal related entities can, but do not commonly, result in entities that are real parties-in-interest.** In line with *AIT's* broad language instructing the PTAB to analyze the relationship between petitioners and potential RPIs, company relationships outside of the formal corporate family relationship may nevertheless create RPI relationships. Beyond formal corporate relationships, "the customer-supplier relationship" alone does not indicate parties are RPIs, as the PTAB has stated that "solely because [a related entity] has a preexisting, established relationship with Petitioner and is a clear beneficiary of the Petition" does not automatically make that entity an RPI.[37] However, business partners with contractual relationships have been found to be RPIs when the other party would directly benefit from the petitions and have relationships related to the challenged patents.

Before *AIT*, the PTAB investigated factors such as control or if the IPR was filed at the behest of a supplier or manufacturer to determine whether a company with a corporate relationship with a petitioner, but outside the corporate family of a petitioner, was nevertheless an RPI.[38] After *AIT*, however, the PTAB took a more flexible approach. For example, in *Ventex Co., v. Columbia Sportswear North America, Inc.*, a precedential decision following the Federal Circuit's *AIT* decision, the PTAB found manufacturing and supply partners to be RPIs.[39] The PTAB noted that the Federal Circuit in *AIT* "place[d] distinct emphasis on the circumstances surrounding a 'client's interests'" and assessed Ventex's long-standing relationship with its supplier and mutual interests to determine that the supplier was an RPI.[40] The PTAB was cautious not to overextend *AIT's* holding to related parties that may generally benefit from an IPR petition's filing, finding that Ventex's supplier received a direct benefit, at least because the patent owner had accused the supplier of patent infringement.[41]

Likewise, in *Bungie, Inc. v. Worlds Inc.*, on remand from the Federal Circuit, the PTAB found the petitioner's business partner, Activision, was an RPI in light of the parties' relationship. The PTAB

> noted that “Petitioner Bungie and non-party Activision had a preexisting, established relationship related to the challenged patents, that non-party Activision is a clear beneficiary of the filing of the Petitions challenging the same five patents asserted against Activision in the District Court litigation, and that non-party Activision desires review of the challenged patents and would benefit directly from the redress sought in the Petitions.”[42]

Despite the PTAB taking a more flexible approach to RPI designations post-*AIT*, it still recognizes that “customer-supplier relationships, without more, are insufficient to establish the requisite ‘close relationship’ required to find that a party is a real party in interest.”[43] Thus, while the existence of a relationship such as a customer-supplier relationship alone is likely insufficient to create an RPI relationship, that may support an RPI finding when coupled with other facts.

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While Subject to the Same Factual Inquiry Test, Co-Defendants in Related Litigation Are Infrequently Found to Be Real Parties-In-Interest

Unlike related corporate entities and preexisting business relationships, co-defendants in litigation or members of joint defense groups are not likely to be considered RPIs. Before *AIT*, the PTAB explained that “[g]enerally, common interests or activities, including common legal interests and activities, are insufficient without a specific connection to the petition/proceeding at issue.”[44] Indeed, in *Weatherford International, LLC v. Packers Plus Energy Services, Inc.*, the PTAB found that collaborating as co-defendants in a related litigation did not cause co-defendants to be RPIs.[45] The PTAB reasoned that their joint efforts as co-defendants in litigation did not lead to collaboration or an exercise of control in the IPR proceeding.[46] Similarly, in *Petroleum Geo-Services Inc. v. WesternGeco LLC*, the PTAB stated that two co-defendants that “have a desire, and common interest, in invalidating [patent owner’s patents], and have collaborated together, and invoked a common interest privilege with respect to sharing potentially invalidating prior art references, does not persuade us that [the co-defendant] has the ability to control the instant Petition or is directing or funding the present proceeding.”[47]

Relatedly, the PTAB found that a former co-defendant who settled its litigation with the patent owner was not an RPI. In *JP Morgan Chase & Co. v. Maxim Integrated Products, Inc.*, the PTAB found that a petitioner’s former district court co-defendant was not an RPI, even though the parties had previously jointly filed a Covered Business Method (CBM) petition on the same patent at issue in the current CBM, because the former co-defendant had since settled and therefore had no desire to review the petitioned patent.[48]

After *AIT*, the PTAB has continued to find that co-defendants are typically not RPIs, absent other considerations. For example, the PTAB has found that “even if [two parties’] interests, as co-defendants in the district court litigation, generally are aligned in that they have been charged with infringing the same patents (as would normally be true for all co-defendants), the evidence shows that the parties acted independently, and [the petitioner] did not file the Petition at the behest or on behalf of [the alleged

RPI].”[49] The Federal Circuit reached a similar conclusion in a situation where LG filed an IPR petition substantively identical to Facebook’s petition, concurrent with a motion to join Facebook’s petition. In affirming the PTAB’s determination that LG was not an RPI, the Federal Circuit explained that “just because LG expressed an interest in challenging the ’433 patent’s patentability, through its filing of its own IPR petition and joinder motion, does not by itself make LG an RPI to Facebook’s IPR.”[50]

In sum, status as co-defendants, or even collaborators in related litigation, is unlikely to support a finding that the parties are RPIs—despite the Federal Circuit’s recent ruling in *AIT*—absent other factors that *AIT* and the Trial Practice Guide highlight as important.

Key Practice Tips

Determining if an entity is a RPI is a fact-intensive inquiry regardless of whether the relationship is based on formal corporate ties, contractual business agreements, litigation, or participation in a patent aggregator program. Practitioners should consider these tips:

> **Look at the Petitioner’s Relationships. It is important for practitioners to carefully consider a petitioner’s relationships prior to filing a petition, looking carefully at preexisting relationships, benefits, and control.**

> **Be Cautious. Given the significant uncertainty surrounding RPI determinations, it may be best for a petitioner to err on the side of caution by identifying other entities as potential RPIs while making clear they are not RPIs under the governing legal standards.**

> **Avoid Future Conflicts. Following a cautious path puts the PTAB and patent owner on notice of potential RPIs without conceding they are, in fact, RPIs. This approach can avoid later skirmishes about RPI issues as an IPR or PGR runs its course.**

ENDNOTES

[1] U.S. Pat. & Trademark Off., Pat. Trial & Appeal Bd., ***Consolidated Trial Practice Guide*** 12 (Nov. 2019), https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL= (hereinafter Trial Practice Guide).

[2] *Id.* at 13, 16.

[3] *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018) (hereinafter *AIT*).

[4] *RPX Corp. v. Applications in Internet Time, LLC*, No. IPR2015-01750, Paper 128 at 9 (P.T.A.B. Oct. 2, 2020).

[5] Trial Practice Guide at 17.

[6] *AIT*, 897 F.3d at 1351.

[7] *Id.* at 1351-54, 1357.

[8] *Id.* at 1351.

[9] *RPX Corp.*, No. IPR2015-01750 at 13-35.

[10] *Id.* at 18-20 (citation omitted); *id.* at 32 ("That is not to say that arrangements in which an entity would benefit from having another entity file a petition on its behalf—or on the behalf of it and other similarly-situated entities—is impermissible. But all such entities should be named as RPIs to ensure that pertinent statutory time bars and estoppels apply."); *id.* at 34-35.

[11] *See, e.g.*, *Unified Pats., Inc. v. Barkan Wireless IP Holdings L.P.*, No. IPR2018-01186, Paper 56 at 7-10 (P.T.A.B. Dec. 4, 2019), *aff'd*, 838 F. App'x 565 (Fed. Cir. 2021) (distinguishing *AIT* because Unified Patents' clients were not time-barred when the IPR was filed and had filed their own IPR petitions, and there were no communications about the IPR prior to filing); *Unified Pats., Inc. v. Bradium Techs. LLC*, No. IPR2018-00952, Paper 60 at 10-16 (P.T.A.B. Dec. 19, 2019) (rejecting contention that United Patents failed to name RPIs because its clients were not time-barred and there was no evidence of pre-IPR filing communications); *Unified Pats., Inc. v. Carucel Inv., L.P.*, No. IPR2019-01079, Paper 9 at 17-24 (P.T.A.B. Nov. 12, 2019) (same); *Unified Pats., Inc. v. Uniloc 2017 LLC*, No. IPR2017-02148, Paper 74 at 18-24 (P.T.A.B. Apr. 11, 2019) (finding that Unified Patents' client was not an RPI because the petition did not appear to have been controlled by the client or filed at the behest of the client, when there was no record of communications between the petitioner and its client regarding the IPR proceeding and the client was not itself barred from bringing an IPR); *Unified Pats. LLC v. Uniloc 2017 LLC*, No. IPR2019-00453, Paper 38 at 56-59 (P.T.A.B. July 22, 2020) (finding petitioner's client was not an RPI because there was insufficient evidence of pre-IPR filing communications between petitioner and its client and no specific evidence the petition was filed at the client's behest).

[12] Trial Practice Guide at 16.

[13] *Id.* (citation omitted).

[14] *Sirius XM Radio, Inc. v. Fraunhofer-Gesellschaft*, No. IPR2018-00681, Paper 12 at 4-6 (P.T.A.B. Sept. 6, 2018).

[15] After the PTAB denied institution on failure to name an RPI, the PTAB granted rehearing, allowing the petitioner to amend its mandatory notices to add the parent holding company as an RPI, based on recently designated precedential decisions on that procedural topic. *Sirius*, No. IPR2018-00681, Paper 24 (P.T.A.B. June 25, 2019). The PTAB subsequently denied institution on substantive grounds. *Sirius*, No. IPR2018-00681, Paper 25 (P.T.A.B. Mar. 9, 2021).

[16] *Sirius*, No. IPR2018-00681, Paper 24 at 5.

[17] Nos. IPR2017-01185, 2017-01187, Paper 9 at 8-20 (P.T.A.B. Oct. 11, 2017).

[18] *Par Pharm., Inc. v. Jazz Pharm., Inc.*, No. IPR2015-00546, Paper 25 at 10-19 (P.T.A.B. July 28, 2015).

[19] *Id.* at 17.

[20] *Id.* at 18.

[21] No. 2018-00683, Paper 7 at 4-6 (P.T.A.B. Sept. 27, 2018).

[22] No. IPR2018-01597, Paper 12 at 9-14 (P.T.A.B. Mar. 12, 2018).

[23] *See Par Pharm.*, No. IPR2015-00546, Paper 25 at 19 ("[E]vidence that a parent conducts substantially all of its operations through subsidiaries is not persuasive or sufficient evidence by itself to establish an involved and controlling parent corporation representing the unified interests of itself and Petitioner." (alterations and citations omitted)); *see also D-Link Sys., Inc. v. Chrimar Sys., Inc.*, No. IPR2016-01425, Paper 15 at 6-9 (P.T.A.B. Jan. 17, 2017) (refusing to deem the petitioner's parent an RPI, simply because the parent owned 97.76% of the petitioner corporation, consolidated financial statements between the two companies, and typically hired the same counsel).

[24] No. IPR2013-00453, Paper 88 at 2-6, 9-13 (P.T.A.B. Jan. 6, 2015); *see also Corning Optical Commc'ns RF, LLC v. PPC Broadband, Inc.*, No. IPR2014-00736, Paper 59 at 16-19 (P.T.A.B. Aug. 18, 2015) (finding petitioner's sister company to be an RPI when there was sufficient corporate blurring between the petitioner and the sister company).

[25] *Atlanta Gas*, No. IPR2013-00453, Paper 88 at 3-4.

[26] *Id.* at 3 n.2.

[27] *Id.* at 9.

[28] No. IPR2017-02176, Paper 16 at 7-8 (P.T.A.B. Apr. 11, 2018).

[29] *Id.* at 9.

[30] *Id.* at 11.

[31] *See, e.g.*, *Toshiba*, No. IPR2018-01597, Paper 12 at 15 ("TAIS is at most simply a cousin corporation of TMC, twice removed." (emphasis and citation omitted)) (reaffirmed in Final Written Decision, *see Toshiba*, No. IPR2018-01597, Paper 56 at 13-17 (P.T.A.B. Mar. 12, 2020)).

[32] *Petroleum Geo-Servs. Inc. v. WesternGeco LLC*, No. IPR2014-00687, Paper 100 at 39 (P.T.A.B. Dec. 15, 2015).

[33] No. IPR2014-00607, Paper 56 (P.T.A.B. Mar. 16, 2015).

[34] The subsidiary had listed both itself and Medtronic as RPIs in those IPRs. *Id.* at 3-4.

[35] *Id.* at 9-18.

[36] *Id.* at 12-13.

[37] *Merck Sharp & Dohme Corp. v. GlaxoSmithKline Biologicals SA*, No. IPR2018-01229, Paper 13 at 12 (P.T.A.B. Dec. 18, 2018).

[38] *See, e.g.*, *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1336-38 (Fed. Cir. 2018); *Intel Corp. v. Alacritech, Inc.*, No. IPR2017-01409, Paper 8 at 12-13 (P.T.A.B. Nov. 21, 2017).

[39] No. IPR2017-00651, Paper 148 at 9-10 (P.T.A.B. Jan. 24, 2019).

[40] *Id.* at 6-7 (citation omitted).

[41] *Id.* at 10.

[42] *Bungie, Inc. v. Worlds Inc.*, Nos. IPR2015-01264, IPR2015-01319, IPR2015-01321, Paper 64 at 45 (P.T.A.B. Jan. 14, 2020).

[43] *Toshiba*, No. IPR2018-01597, Paper 56 at 15; ***see also Samsung Elecs. Co., v. Seven Networks, LLC***, No. IPR2018-01108, Paper 22 at 11 (P.T.A.B. Nov. 28, 2018) (refusing to deny institution based on failure to name supplier Google as an RPI); ***Merck***, No. IPR2018-01229, Paper 13 at 10-13 (finding that a company licensing technology to Merck for development of Merck's vaccine was not an RPI because the company merely licensed its technology to Merck).

[44] *Weatherford Int'l, LLC v. Packers Plus Energy Servs*., Inc., No. IPR2016-01514, Paper 23 at 15 (P.T.A.B. Feb. 22, 2017); ***see also Commissariat a L'Energie Atomique et aux Energies Alternatives v. Silicon Genesis Corp.***, No. IPR2016-00833, Paper 8 at 7 (P.T.A.B. Sept. 28, 2016) (explaining that the patent owner "fail[ed] to present any support as to why the use of overlapping counsel extends to [the purported RPI's] potential control of this proceeding.").

[45] *Weatherford*, No. IPR2016-01514, Paper 23 at 12-16; ***see also Intel Corp.***, No. IPR2017-01409, Paper 8 at 13 (P.T.A.B. Nov. 21, 2017) ("The other assertions relating to coordinating theories and sharing experts are common activities between cooperating co-defendants and are not suggestive of control of one party over another.").

[46] *Weatherford*, No. IPR2016-01514, Paper 23 at 13-14.

[47] No. IPR2014-00687, Paper 100 at 37 (P.T.A.B. Dec. 15, 2015).

[48] No. CBM2014-00179, Paper 11 at 6-13 (P.T.A.B. Feb. 20, 2015).

[49] *Samsung*, No. IPR2018-01108, Paper 22 at 12.

[50] *Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018, 1028 (Fed. Cir. 2021).

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