

FEDERAL EXPRESS CORP. v. QUALCOMM INC., Appeal No. 2024-1236 (Fed. Cir. April 29, 2026). Before Hughes, Cunningham, and Stark. Appealed from PTAB.

### Background:

On February 9, 2021 FedEx filed a complaint in the District Court of Delaware against Roambee Corporation for patent infringement. FedEx served Roambee on February 11, 2021, which began the one-year window during which Roambee could petition the PTAB for inter partes review.

Curiously, on Roambee's inter partes review filing deadline, Qualcomm filed an inter partes review petition, alleging the same patents asserted against Roambee would have been obvious. However, Qualcomm was not a party in the FedEx and Roambee litigation. Still, Qualcomm identified the Roambee litigation as a related matter in Qualcomm's petition but did not list Roambee as a real party in interest. FedEx argued that because Qualcomm failed to list Roambee as a real party in interest, the PTAB was precluded from considering Qualcomm's petition. The PTAB disagreed and instituted the review on October 11, 2022. FedEx then moved to terminate the proceedings but the PTAB denied FedEx's motion, stating instead that the PTAB should not determine whether an unnamed party is a real party in interest in a proceeding if that determination is not necessary to resolve the proceeding because such a determination is only necessary when adding the unnamed party would create a time-bar or estoppel issue. Here, because Qualcomm filed its petition within the deadline for Roambee to file a petition, the PTAB concluded that no time bar would apply absent bad faith, gamesmanship, or prejudice that would prevent amendment of the mandatory notices. Thus, the PTAB refused to make a real party in interest determination and determined all the claims in FedEx's patent would have been obvious and, therefore, unpatentable. FedEx timely appealed.

### Issues/Holdings:

(1) Did the PTAB err in refusing to make a real party in interest determination? (2) Did the PTAB err in finding FedEx's claims would have been obvious and therefore unpatentable? The Federal Circuit held the first question was unreviewable, and vacated and remanded in answering the second question.

### Discussion:

The Federal Circuit held the PTAB's decision to not determine whether an unnamed party, Roambee, was a real party in interest is unreviewable. In coming to this conclusion, the Federal Circuit cited 35 U.S.C. § 314(d), which states "[t]he determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable." By this, Congress had specified that the choice of whether to institute is judicially unreviewable. Here, FedEx attempted to argue that its issue is whether the PTAB must perform a real party in interest analysis at all, not whether the PTAB correctly analyzed the real partes of interest in the relevant proceeding. However, the Federal Circuit disagreed and held the issue ultimately is a challenge over whether the PTAB should have instituted an inter partes review at all. Therefore, the Federal Circuit held FedEx's challenge is unreviewable. In answering the second question, the Federal Circuit noted that the PTAB based its obviousness determination on the belief that FedEx had not contested Qualcomm's challenge on the asserted references. However, both parties agreed that FedEx had contested the challenge and the PTAB's error should result in vacatur. Thus, the Federal Circuit vacated and remanded.