

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYNOPSISYS, INC.
Petitioner

v.

MENTOR GRAPHICS CORPORATION
Patent Owner

Case IPR2012-00042
Patent 6,240,376 B1

Before SALLY C. MEDLEY, HOWARD B. BLANKENSHIP, and JENNIFER
S. BISK, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71(d)

SUMMARY

Patent Owner, Mentor Graphics Corporation requests rehearing of the Board's decision to institute an *inter partes* review of U.S. Patent 6,240,376 B1 (Ex. 1001) (the "376 patent") (Paper 16 ("Decision")) entered February 22, 2013. Paper 18 ("Rehearing Req.").¹ For the reasons that follow, Patent Owner's request for rehearing is denied.

DISCUSSION

The applicable standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or a reply.

Patent Owner argues that the Decision misapprehends: (1) the statutory nature of an alleged error in service of the petition in this case; and (2) the privity requirement of § 315(b). Rehearing Req. 1-2. The arguments are unpersuasive.

Filing Date of the Petition

Patent Owner argues that we overlooked and misapprehended that "[i]n its

¹ A request for rehearing of a decision under 37 C.F.R. § 42.71(d) must be filed in the form of a motion, which is limited to 15 pages (*see* 37 C.F.R. § 42.24(a)(v)). Patent Owner's request is 27 pages. In the future, a request of this length may be found defective.

Preliminary Response, Mentor Graphics argued that September 26, 2012 was not the filing date of the petition because Synopsys did not properly serve the petition on that date.” Rehearing Req. 20. In fact, Patent Owner’s argument in the Preliminary Response (Paper 15 (“Prelim. Resp.”)) consisted of the following three sentences in a footnote:

On September 27, 2012, Synopsys served the petition on the ‘376 Patent’s PTO correspondence address of record, making September 27, 2012, the effective filing date pursuant to 37 C.F.R. §§ 42.105(a) and 42.106, rather than the September 26, 2012 filing date accorded to the Petition by the PTAB. Receipt of the Petition at the correspondence address of record is shown by Banner & Witcoff’s “Messenger Log” (MG 2005) (See 5th entry dated September 27, 2012, indicating “Mentor Graphics.”) The petition is dated September 26, 2012, the date Synopsys unsuccessfully attempted to serve the petition by hand on an incorrect address.

Prelim. Resp. 4, n.2.

In its Rehearing Request, Patent Owner argues, for the first time, that proper service is a statutory requirement. Rehearing Req. 20-23. We could not have overlooked or misapprehended this argument because it was not made in the preliminary response. Thus, on that basis alone, we are not persuaded by the argument. Moreover, we do not find persuasive Patent Owner’s arguments on the merits. The requirement of 35 U.S.C. § 312(a) that Patent Owner relies on states that “[a] petition filed under section 311 may be considered only if— . . . (5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner, or, if applicable, the designated representative of the patent owner.” There is no dispute that Petitioner provided copies of the required documents to the patent owner’s representative. *See* Prelim. Resp. 4, n.2;

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Rehearing Req. 20-23. Nothing in the statute states that the date the Patent Owner receives those copies is determinative of the filing date. We, therefore, are not persuaded by Patent Owner's arguments.

As for our rules, § 42.105 requires petitioner to “serve the petition and exhibits . . . on the patent owner at the correspondence address of record for the subject patent” and § 42.106 states that “[a] petition to institute *inter partes* review will not be accorded a filing date until the petition . . . [e]ffects service of the petition on the correspondence address of record as provided in [§] 42.105(a).” We are persuaded that Petitioner made a good faith attempt to serve, on September 26, 2012, the petition in compliance with our rules. The address found on the certificate of service (*e.g.*, Petition at 61), a prior address of the Patent Owner's representative law firm, can be found in the most recent assignment document in the Office's assignment database. *See* Reel/Frame 016547/09790 (recorded Sept. 20, 2005). Based on the facts of this case, we are not persuaded that the accorded filing date is erroneous.

35 U.S.C. § 315(b)

Patent Owner argues that the Board applied the wrong test in determining whether the Petition in this case is barred by § 315(b). Rehearing Req. 2-3. According to the Patent Owner, because Petitioner is a successor-in-interest of the allegedly infringing products of EVE, party to the 2006 litigation, Petitioner is barred by § 315(b) from filing the Petition. Rehearing Req. 14-16. According to Patent Owner, because here the issue involves successor-in-interest privity, § 315(b) does not require that the privity relationship existed at the time the 2006 complaint

was served (*id.* at 14-16) or even on the date that the petition was filed (*id.* at 16-19). Patent Owner bases its entire argument on the premise that the “property in question” for purposes of privity in this context “necessarily encompasses the property at issue in the action initiated by the complaint alleging infringement.” Rehearing Req. 8. According to Patent Owner, the “property in question” is only confined to the patent sought to be reviewed for purposes of privity in the context of § 315(e) estoppel issues. *Id.* at n.4.

However, Patent Owner does not cite to any persuasive authority that supports its argument. *See id.* The cases discussed by Patent Owner all involve successive infringement suits where both cases involve the same allegedly infringing products. For example, *Brunswick* involves two patent infringement actions related to the same allegedly infringing products. *Brunswick Corp. v. Chrysler Corp.*, 408 F.2d 335, 336 (7th Cir. 1969). The first infringement action resulted in a consent decree, after which the alleged infringer was acquired by another company. *Id.* The Court held that for purposes of the second suit, the acquiring company was in privity with the previous defendant because that company “*succeeded in interest to the subject matter of the prior decree.*” *Id.* at 338 (emphasis added). That is not the case here.

Patent Owner also refers to legislative history and the Office Patent Trial Practice Guide as supporting its position. Rehearing Req. 6-7 (citing 154 Cong. Rec. S9987 (daily ed. Sept. 27, 2008); Fed. Reg., Vol. 77 No. 157 (Aug. 14, 2012) at 48759). However, nothing in those passages states that a statutory bar under § 315(b) is bestowed automatically upon a company that acquires products accused of infringement. In fact, the Patent Owner does not even rely on direct language

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