IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

In re U.S. Patent No. 5,527,533 | Trial Number: IPR2013-00401

Filed: 27 October 1994 | Atty Ref: Cyan. IPR.One

Issued: 18 June 1996 | Petitioner: Cyanotech Corporation

Inventors: Mark O. M. TSO and Tim-Tak LAM

Patent Owner: The Board of Trustees of the University of Illinois

Title: Method of retarding and ameliorating central nervous system and eye damage

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United State Patent and Trademark Office
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PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 5,527,533

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I. MANDATORY NOTICES

A. Real Party in Interest. The real parties-in-interest on the side of Petitioner are Petitioner, Cyanotech Corporation, and its subsidiary, Nutrex Hawaii, Inc. ("Nutrex").

B. Related Matters. U.S. Patent No. 5,527,533 ('533 patent) issued from Application No. 08/330,194, filed 27 October 1994 ("Critical Date"). Pursuant to 37 C.F.R. § 42.8(b)(2), Petitioner identifies the following judicial or administrative matter that would affect, or be affected by, a decision in this proceeding: *U.S. Nutraceuticals LLC d/b/a Valensa International; and The Board of Trustees of the University of Illinois vs. Cyanotech Corporation, and Nutrex Hawaii, Inc.* Civ. 5:12-cv-366-oc-10PRL (M.D.Fla), filed 29 June 2012 ("M.D.Fla. case") (Ex. 1037), alleging infringement of unspecified claims of the '533 patent by Petitioner and Nutrex (see Ex. 1037). This Petition is timely filed, no more than one year after service of that complaint, under 35 U.S.C. § 315(b).

Petitioner filed *Cyanotech Corporation v. U.S. Nutraceuticals, LLC d/b/a Valensa International and The University of Illinois* (Civ. No. 1:12-cv-00352-JMS-RLP), on 20 June 2012 to invalidate the '533 patent, but that action was dismissed (Ex. 1038) under Rules 12(b)(7) and 19, Fed. R. Civ. Proc., on 07 Feb. 2013, leaving the parties as if the declaratory judgment action had never been brought.

This dismissed law suit has no legal significance and thus does not affect this proceeding.

C. Petitioner's Counsel

Lead Counsel: Joseph A. Rhoa (Reg. No. 37,515)

Backup Counsel: George E. Darby (Reg. No. 44,053)

Pursuant to 37 C.F.R. §§ 42.10(b) and 42.15(a), Powers of Attorney and filing fees are submitted with this Petition.

D. Petitioner's Counsels' Service Information

Lead Counsel: Email: jar@nixonvan.com . Tel: 703.816.4000. Fax: 703.816.4100. Postal and hand-delivery: Joseph A. Rhoa, Nixon & Vanderhye, P.C., 901 North Glebe Road, 11th Fl., Arlington, VA 22203.

Backup Counsel: Email: cyan@teleport-asia.com . Tel: 808.626.1300; Fax: 808.626.1350. Postal and hand-delivery: George E. Darby, Paradise Patent Services, Inc., 95-1045 Alakaina St., Mililani, HI 96789.

E. Certificate of Service. Petitioner has served by FedEx the Petition and supporting evidence on (i) the correspondent attorney of record of the patent owner as listed on USPTO PAIR and (ii) the patent owner as listed in the USPTO Patent Assignment database.

F. Grounds for Standing. Petitioner certifies pursuant to Rule 42.104(a) that the patent for which review is sought is available for *Inter Partes* Review

("IPR") and that Petitioner is not barred or estopped from requesting an IPR challenging the patent claims on the grounds identified in this Petition.

On June 20, 2012, Petitioner filed a declaratory judgment suit in U.S. District Court for the District of Hawaii seeking to invalidate the '533 patent. That court dismissed the suit (Ex. 1038) without prejudice under Fed. R. Civ. P. 12(b) and 19(b) because the patent owner, the University of Illinois, was an indispensable party but could not be joined because it was immune from suit in Hawaii under the Eleventh Amendment. There was no adjudication on the merits. Such a dismissal cannot bar Petitioner from requesting *Inter Partes* Review.

Dismissal for failure to join an indispensable party under Fed. R. Civ. P. 12(b)(7) and 19 is without prejudice and has no subsequent preclusive effect. *See*, Fed. R. Civ. P., 41(b). *See also, Univ. of Pittsburgh v. Varian Medical Systems, Inc*., 569 F. 3d 1328, 1332 (Fed. Cir. 2009) ("a dismissal for failure to join a party is not an adjudication on the merits…"); *Hughes v. United States*, 71 U.S. (4 Wall.) 232, 237; 18 L.Ed. 303 (1866)("If the first suit was dismissed for a defect of pleadings, or parties,… the judgment rendered will prove no bar to another suit,"). *Graves v. Principi*, 294 F.3d 1350, 1356 (Fed. Cir. 2002) (The dismissal of an action without prejudice "**leaves the parties as though the action had never been brought.**") (emphasis added). This is true regardless of whether the dismissal is voluntary or involuntary.

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