

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRINTING INDUSTRIES OF AMERICA
Petitioner

v.

CTP INNOVATIONS
Patent Owner

Case IPR2013-00474
Patent 6,611,349

Before HOWARD B. BLANKENSHIP, BENJAMIN D. M. WOOD, and
BRIAN J. McNAMARA

McNAMARA, *Administrative Patent Judge.*

ORDER REQUIRING COMPLIANCE WITH SERVICE REQUIREMENT
ORDER REQUIRING FILING OF PRO HAC VICE MOTION

Conduct of the Proceeding
37C.F.R. § 42.5

Defective Service Issues

On July 29, 2013, Printing Industries of America (Petitioner) filed a petition for *inter partes* review (Petition) of US Patent 6,611,349 (the '349 Patent).

Petitioner served the Petition on CTP Innovations (Patent Owner) by first-class mail. Paper No. 3. Petitioner's service was defective under 37 C.F.R. § 42.6(e)(1), which requires that service be made either electronically upon agreement of the parties or by EXPRESS MAIL or by means at least as fast and reliable as EXPRESS MAIL. Patent Owner did not object to Petitioner's defective service.

On October 4, 2013 Patent Owner filed a Patent Owner Preliminary Response (Preliminary Response) with a certificate of service indicating that the Preliminary Response had been served on Petitioner by U.S. Express Mail on October 4, 2013. Paper No. 11. Nearly two months later, on December 3, 2013, Petitioner filed a Notice of Defective Certificate of Service (Notice of Defective Service) requesting that the Board take notice of the Patent Owner's failure to post the Preliminary Response until October 9, 2013 and take appropriate action against Patent Owner. Paper No. 12. On December 6, 2013 Patent Owner filed a Response To Notice Of Defective Certificate Of Service and Corrected Certificate of Service (Response to Petitioner's Notice of Defective Service) in which Patent Owner explained the delay was a result of a clerical error, that service was affected by Priority Mail posted on October 9, 2013 and that Petitioner had not been prejudiced. Paper No. 12.

As an initial matter, the Board notes that neither Petitioner nor Patent Owner sought the Board's authorization to file either the Notice of Defective Service or Patent Owner's Response to the Petitioner's Notice of Defective Service. The parties should request a conference to seek the Board's authorization before filing

any motions or requests for relief from the Board. 37 C.F.R. § 42.20. The Board also takes judicial notice of the fact that since July 28, 2013, the United States Postal Service has offered Priority Mail Express (overnight delivery to most U.S. locations) and Priority Mail (1, 2 or 3 day delivery), which is not as fast as Priority Mail Express. In view of the circumstances, if the parties do not agree to accept service electronically, all service in this proceeding under 37 C.F.R. § 42.6(e)(1) should be made through the United States Postal Service as Priority Mail Express, rather than Priority Mail. Neither the service of the Petition nor the service of the Patent Owner Preliminary Response complied with this requirement. In the future, all parties should comply with the service requirements of 37 C.F.R. § 42.6(e)(1).

There is no need for any relief because neither party has been prejudiced in this proceeding. Patent Owner timely filed its Preliminary Response notwithstanding Petitioner's defective service of the Petition. Petitioner was also not prejudiced by the short delay in receiving the Preliminary Response. There is no indication that Petitioner even noticed the delay for almost two months. In addition, Petitioner is not prejudiced because there is no further action the Petitioner can take unless and until the Board institutes a trial.

Pro Hac Vice Issue

In its Mandatory Notices filed on August 20, 2013 Patent Owner designated Samuel F. Miller as Back-up Counsel pending *pro hac vice* admission. To date the board has no record of receiving a motion to admit Mr. Miller *pro hac vice* or the required accompanying affidavit. Patent Owner should submit the requisite Motion for *pro hac vice* Admission of Samuel F. Miller and accompanying affidavit not later than December 13, 2013 or designate other Back-up Counsel and file any required *pro hac vice* motions.

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In consideration of the above,

It is ORDERED that for all future filings the parties comply with the service requirements of 37 CFR 42. (6)(e)(1) by agreeing to electronic service or by service through the United States Post Office by Priority Mail Express;

It is FURTHER ORDERED that Patent Owner submit any Back-up Counsel designation and any necessary *pro hac vice* motion and accompanying affidavits not later than December 13, 2013.

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