

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZOLL LIFECOR CORPORATION
Petitioner

v.

PHILIPS ELECTRONICS NORTH AMERICA CORP. and
KONINKLIJKE PHILIPS N.V.
Patent Owner

Case IPR2013-00609
Patent 5,836,978

Before SALLY C. MEDLEY, MIRIAM L. QUINN, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

ZOLL Lifecor Corporation (“Petitioner”) filed a corrected petition requesting *inter partes* review of claims 1-7 (the “challenged claims”) of U.S. Patent No. 5,836,978 (Ex. 1001, “the ’978 patent”). Paper 1 (“Pet.”). Philips Electronics North America Corporation (“Patent Owner”) filed a preliminary response. Paper 9 (“Prelim. Resp.”). The Board authorized the Petitioner to file a brief addressing the privity and real party-in-interest issues raised in the preliminary response. Paper 12. Petitioner filed a brief addressing those issues. Paper 13 (“Br.”). We have jurisdiction under 35 U.S.C. § 314.

Upon consideration of the petition, we determine that ZOLL Medical, Petitioner’s parent company, is a real party-in-interest that was served with a complaint alleging infringement of the ’978 patent more than one year before the filing of this petition. The petition is therefore untimely under 35 U.S.C. § 315(b). Moreover, because the petition does not identify ZOLL Medical as a real party-in-interest, the petition fails to identify “all the real parties in interest,” as required by 35 U.S.C. § 312(a). Accordingly, the petition is denied.

A. *Related Proceedings*

The ’978 patent is involved in a co-pending case filed against Petitioner on September 21, 2012, and captioned *Koninklijke Philips Elecs. N.V. v. Zoll Lifecor Corp.*, Civ. A. No. 2:12-cv-01369 (W.D. Pa.) (the “Pennsylvania Action”). Pet. 2; Prelim. Resp. 5. Petitioner was served with a complaint in that proceeding on September 21, 2012. Prelim. Resp. 5

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(citing Ex. 2006). The Pennsylvania Action also involves seven other patents, all related to the '978 patent. Prelim. Resp. 5-6. Each of these patents, including the '978 patent, claims priority to the same application: No. 08/103,837, filed on August 6, 1993. *Id.* at 5; Ex. 1001.

The '978 patent also is involved in a co-pending case filed against Petitioner's parent company, ZOLL Medical Corporation ("ZOLL Medical"), on June 18, 2010, and captioned *Koninklijke Philips Elecs. N.V. v. Zoll Med. Corp.*, Civ. A. No. 1:10-cv-11041 (D. Mass.) (the "Massachusetts Action"). Prelim. Resp. 4-5. ZOLL Medical was served with an amended complaint alleging infringement of six of the eight patents at issue in the Pennsylvania Action, including the '978 patent, on October 13, 2010. Prelim. Resp. 4-5 (citing Ex. 2004).

Petitioner also has filed petitions for *inter partes* review of the other seven patents in the Pennsylvania Action: IPR2013-00606 (U.S. Patent No. 5,593,427), IPR2013-00607 (U.S. Patent No. 5,749,904), IPR2013-00612 (U.S. Patent No. 5,803,927), IPR2013-00613 (U.S. Patent No. 5,735,879), IPR2013-00615 (U.S. Patent No. 6,047,212), IPR2013-00616 (U.S. Patent No. 5,749,905), and IPR2013-00618 (U.S. Patent No. 5,607,454). Pet. 2; Prelim. Resp. 5-6.

The Petition identified as a related matter the Pennsylvania Action, but not the Massachusetts Action. Pet. 2. On January 3, 2014, after Patent Owner filed its Preliminary Response, Petitioner amended its Mandatory Notice to include the Massachusetts Action. Paper 11 at 2-3.

II. DISCUSSION

A. *Factual Background*

ZOLL Medical is a manufacturer of resuscitation devices and related software solutions. Ex. 2001. On April 10, 2006, ZOLL Medical announced that it had acquired the assets and business of Lifecor, Inc., a privately held company that designs, manufactures, and markets a wearable external defibrillator system. *Id.* At the time ZOLL Medical acquired Lifecor, Inc., ZOLL Medical announced that it would operate the Lifecor, Inc. business through the ZOLL Lifecor subsidiary, based in Pittsburgh, Pennsylvania. *Id.* A parent-subsiary relationship was formed in 2006 when ZOLL Medical acquired Lifecor, Inc. It is undisputed that ZOLL Lifecor, Petitioner, is a wholly-owned subsidiary of ZOLL Medical. Prelim. Resp. 1; Br. 1.

After the acquisition, ZOLL Medical referred to itself and Petitioner collectively as “ZOLL.” Ex. 2008 (ZOLL Medical’s Annual Report, Form 10-K, dated Dec. 15, 2006). In filed public financial statements, ZOLL Medical asserted that it “now manufactures and markets [a] wearable external defibrillator system [i.e., LifeVest] through its subsidiary, ZOLL Lifecor Corporation.” Ex. 2008 at 10. Under the ZOLL brand, ZOLL Medical used a dedicated sales force to sell Petitioner’s LifeVest product. Ex. 2008 at 19. In 2008, ZOLL Medical asserted in public financial documents that ZOLL was conducting clinical trials related to the LifeVest product. Ex. 2010 at 27.

The LifeVest is Petitioner's only product, which is marketed on the ZOLL Medical website. Ex. 2011.

Petitioner sought a stay of the Pennsylvania Action based on the overlap with, and the impact of, the Massachusetts Action. Ex. 2015 at 5. Petitioner took the position that issues of invalidity addressed in the Massachusetts Action would be directly applicable to the eight patents involved in the Pennsylvania Action. Ex. 2025 at 2. The district court granted a stay of the Pennsylvania Action, and required the parties to mediate. Prelim. Resp. 36-37 (citing Ex. 2027). Three officers of ZOLL Medical, which is not a party to the Pennsylvania Action, attended the mediation on behalf of Petitioner. Ex. 2017, 6-7, 9; *compare* Ex. 2018 with Ex. 2019. One of those officers, Mr. Grossman, is also Petitioner's Secretary, and provides legal guidance to both ZOLL Medical and Petitioner. Br. 5.

To maintain the stay, Petitioner again relied on the "high degree of overlap between this [Pennsylvania Action] and the Massachusetts [Action]," and that resolution of the parties' negotiations with Patent Owner involved a "global resolution" that included both pending Actions. Ex. 2016 at 6. Petitioner argued against ramping up activity in the Pennsylvania Action because the parties were focusing on preparing for the trial in the Massachusetts Action. Ex. 2016 at 3-4.

The instant Petition for *inter partes* review was filed on September 23, 2013. Paper 1. The petitions rely on declarations from the same expert

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