

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZOLL LIFECOR CORPORATION
Petitioner

v.

PHILLIPS ELECTRONICS NORTH AMERICA CORPORATION
Patent Owner

Cases IPR2013-00609 (Patent 5,836,978)
IPR2013-00612 (Patent 5,803,927)
IPR2013-00613 (Patent 5,735,879)
IPR2013-00615 (Patent 6,047,212)
IPR2013-00616 (Patent 5,749,905)
IPR2013-00618 (Patent 5,607,454)¹

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

MEDLEY, *Administrative Patent Judge*.

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

¹ This order addresses a similar issue in the six cases. Therefore, we exercise discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style of heading in subsequent papers.

On November 5, 2013, a conference call was held between counsel for the respective parties and Judges Medley and Quinn.²

The purpose of the conference call was for Patent Owner to seek Board authorization to file a motion to dismiss each of the petitions filed by Petitioner in IPR2013-00609, -00612, -00613, -00615, -00616, and -00618.

Patent Owner is of the opinion that Petitioner's petitions filed in each proceeding are untimely under 35 U.S.C. § 315(b). Patent Owner requests authorization to file a motion to dismiss each petition prior to filing its preliminary response. Petitioner does not oppose, provided that Petitioner is authorized to file a response to the motions to dismiss.

During the conference call, the panel explained that a patent owner is provided an opportunity to file a preliminary response to a petition. 35 U.S.C. § 313; 37 C.F.R. § 42.107. A preliminary response may include reasons why no *inter partes* review should be instituted. 35 U.S.C. § 313. The panel further explained, that Patent Owner is provided an opportunity to file a preliminary response and may address the 35 U.S.C. § 315(b) issue in that context, and, therefore, separate briefing in the form of a motion to dismiss is not necessary. Based on the facts presented, Patent Owner did not provide a persuasive reason for considering the 35 U.S.C. § 315(b) issue in separate briefing in the form of a motion to dismiss.

Counsel for Patent Owner explained that Patent Owner does not believe that Petitioner has complied with 35 U.S.C. § 312(a)(2) by listing all real parties-in-interest. The significance of such an argument was not made clear by counsel for

² A court reporter was present.

Patent Owner in the context of seeking authorization to file the motions to dismiss under 35 U.S.C. § 315(b). In any event, Patent Owner, to the extent it believes that that is a reason for not instituting an *inter partes* review may make such arguments in its preliminary response.

Order

It is

ORDERED that Patent Owner's request for authorization to file motions to dismiss each petition in each of the six cases is *denied*.

For PETITIONER:

John C. Phillips
Dorothy P. Whelan
Fish & Richardson
Phillips@fr.com
Whelan@fr.com

For PATENT OWNER:

J. Michael Jakes
Denise W. DeFranco
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
mike.jakes@finnegan.com
denise.defranco@finnegan.com