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Date: August 12, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PETROLEUM GEO-SERVICES INC,
Petitioner,

v.

WESTERNGECO LLC,

Patent Owner.

Cases¹

IPR2014-00678 (Patent 6,691,038)

IPR2014-00687 (Patent 7,162,967)

IPR2014-00688 (Patent 7,080,607)

IPR2014-00689 (Patent 7,293,520)

Before BRYAN F. MOORE, SCOTT A. DANIELS,
and BEVERLY M. BUNTING, *Administrative Patent Judges.*

MOORE, *Administrative Patent Judge.*

¹ This Order addresses issues that are the same in all four cases. Therefore, we exercise our discretion to issue one Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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ORDER SETTING NEW FILING DATES
Conduct of the Proceedings
37 C.F.R. § 42.5, 42.20, 42.106

On August, 2014, a conference call was held in the above proceedings regarding Petitioner's request to list PGS AS and other related companies as real parties-in-interest and Patent Owner's request for authorization for a motion to seal. Present on the call were counsel for the parties and Administrative Patent Judges Bryan Moore and Beverly Bunting, and a court reporter.

REAL PARTY-IN-INTEREST

During a July 27, 2014 call regarding Patent Owner's request for authorization for a motion to seal, the parties also discussed whether Petitioner could file an updated mandatory notice listing PGS AS as a real party-in-interest and what impact that would have on the proceeding. Because the Patent Owner Preliminary Responses were due to be filed on the day of the call, we exercised our discretion under 37 C.F.R. § 42.5(c) and extended the deadline for those responses by 5 business days. We also requested short email responses from both parties regarding this issue in order to expedite the process. In an email dated July 29, 2014, Petitioner responded as follows:

We write, pursuant to the Board's Order during the July 28 teleconference, to address the procedure for Petitioner to add one or more corporate affiliates as real parties in interest. Petitioner proposes to do so by listing them in an amended mandatory notice. This amendment is intended to be prophylactic—unlike in *ZOLL v. Philips*, IPR2013-00609, Paper 15 (March 20, 2014), Petitioner's proposed addition would not affect any statutory bar. Allowing

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Petitioner to file an updated mandatory notice is a practical way to approach this issue and one that has been previously invoked by the Board to address similar issues. See, e.g., *American Express v. Metasearch*, CBM 2014-00001, Paper 29 (March 20, 2014), at 3 n.2; *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033, Paper 60 (July 3, 2013), at 4. The authority to permit such a filing exists under 37 C.F.R. §§ 42.5(a)-(b), which collectively grant the Board “wide latitude in administering the proceedings to balance the ideal of precise rules against the need for flexibility to achieve reasonably fast, inexpensive, and fair proceedings.” 77 F.R. 48,612, 48,616. In the alternative, by agreement of Petitioner, the Board can adopt the approach suggested in *ZOLL* by deeming the Petition incomplete for failure to name all real parties in interest: “Ordinarily, because the Petition is incomplete, the Board would give Petitioner one month from the date of this decision to correct the deficiency[.]” *ZOLL*, Paper 15 at 16; 37 C.F.R. § 42.106(b). As in *ZOLL*, the fact that a petition already has been accorded a filing date does not preclude the Board from permitting Petitioner to file corrected petitions that result in the petitions receiving a new filing date. *ZOLL*, Paper 15 at 16-17. Either of the approaches outlined is acceptable to Petitioner as a way to resolve this issue and advance these proceedings to the merits. Given this authority, Petitioner believes that it is unwarranted to require re-filing the petitions as new petitions.

In any of these situations, the Board has discretion in setting a new deadline for any preliminary response from Patent Owner. Pursuant to 37 C.F.R. § 42.5(c), the Board has the discretion to set any deadline it deems reasonable. As stated in § 42.5(c), the three months provided for 37 C.F.R. § 42.107(b), like any time set by rule, is simply a “default” that “may be modified by order.” The Board has previously exercised its discretion to shorten the time for a preliminary response where, as here, a petition addresses the same issues and prior art as a previous petition. See *Reloaded Games, Inc. v. Parallel Networks*

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LLC, IPR2014-00950, Paper 9 (July 7, 2014). The Board has also shortened the time to respond where the issues raised are not sufficiently “complicated” to merit the full three months provided by default. See *SAP America, Inc. v. Versata Development Group, Inc.*, CBM2012-00001, Paper 10 (Oct. 17, 2012) at 5-6. Here, Patent Owner has already had a full three months to prepare a response to Petitioner’s arguments, the default time frame under the Rules. Patent Owner’s preliminary response is already completely drafted and ready for filing, as Patent Owner indicated during the July 28 teleconference. To the extent the addition of a corporate affiliate of Petitioner could have any impact on Patent Owner’s preliminary response—and Petitioner does not believe it will—Petitioner respectfully suggests that six weeks should be more than sufficient for Patent Owner to edit its already-drafted preliminary response to address it. Petitioner believes that this six-week deadline would be appropriate whether the Board grants Petitioner leave to file an amended mandatory notice, requires Petitioner to file a corrected petition, or requires Petitioner to re-file the petitions as new petitions. Setting a shortened deadline for Patent Owner’s preliminary response best effectuates the purpose of the Rules, which are “to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). In the event that the Board does not exercise its discretion to shorten the time for Patent Owner’s preliminary response to six-weeks, Petitioner reserves the right to re-file the petitions to incorporate substantive modifications.

In an email dated July 30, 2014, Patent Owner responded to Petitioner’s email as follows:

As authorized by the Board in the above captioned proceedings, Patentee responds to Petitioner’s 7/29 email request seeking a clerical reset of their improper petitions. 35 U.S.C. § 312(a) is controlling here. This statute explicitly recites that “a petition filed under section

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311 may be considered only if...(2) the petition identifies all real parties in interest.”(emphasis added). The petitions in the above captioned proceedings do not list all RPIs. The plain language of the statute now precludes their consideration. The Board decisions relied upon by the Petitioner actually support the Patentee’s position. They merely explain a procedural mechanism for removing properly named RPIs from proceedings, for settlement purposes and the like. See, e.g., *American Express v. Metasearch*, CBM 2014-00001, Paper 29 (March 20, 2014), at 3 n.2 (encouraging the Petitioner to file an updated mandatory notice, if necessary, when a joint motion captioned fewer than the ten real parties-in-interest identified in the Petition and Mandatory Notice); *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033, Paper 60 (July 3, 2013), at 4 (ordering remaining Petitioners to update the mandatory notice to reflect termination of inter partes review with respect to one of the original Petitioners due to settlement). These decision do not, and cannot, provide a mechanism for rewriting petitions that fail to include all RPIs. Neither the dicta in *ZOLL v. Philips*, IPR2013-00609, Paper 15 (March 20, 2014) (non-precedential) nor regulations of the agency can trump statutory requirements.

As the Board correctly pointed out on the call of 7/28, the requirement to refile these petitions triggers the default 3 month time period for Patentee’s preliminary response. While it is acknowledged that the Board has discretion in setting this period, fairness dictates the full three-month time period be accorded. Patentee has worked since June (to no avail) to settle this very RPI dispute through additional discovery, dedicated pages of its current draft response to this topic, only to have the rug pulled out from under these efforts the same day the preliminary responses were due to be filed. Now, additional parties are being added that are in privity with parties outside of the 12-month window of 35 U.S.C. § 315(b). These new petitions will require significant re-work and possible discovery for a fair and adequate response. On top of all of that the Petitioner threatens to

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