

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EIZO CORPORATION,
Petitioner,

v.

BARCO N.V.,
Patent Owner.

Case IPR2014-00778
Patent RE43,707 E

Before KALYAN K. DESHPANDE, JAMES B. ARPIN, and
DAVID C. McKONE, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Eizo Corporation (“Petitioner”) filed a corrected Petition requesting an *inter partes* review of claims 64–66, 68–76, 80, 85–88, 91, 98–100, and 116–129 of Patent No. US RE43,707 E (Ex. 1015; “the ’707 patent”). Paper 6 (“Pet.”). Petitioner filed a Motion for Joinder (Paper 11, “Mot.”) accompanying the Petition, seeking to join this proceeding with *Eizo Corp. v. Barco N.V.*, Case IPR2014-00358 (PTAB) (“the ’358 proceeding”). Barco N.V. (“Patent Owner”) timely filed a Preliminary Response (Paper 14, “Prelim. Resp.”) and an Opposition to Petitioner’s Motion for Joinder (Paper 12, “Opp.”). Petitioner further filed a Reply (Paper 16, “Reply”) to Patent Owner’s Opposition. As explained in our Decision on Petitioner’s Motion for Joinder (Paper 17), we deny Petitioner’s request to join this proceeding with the ’358 proceeding.

35 U.S.C. § 315 provides in pertinent part:

(b) PATENT OWNER’S ACTION.—An *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

For the reasons that follow, we determine that neither the Initial Petition nor the Corrected Petition was filed within the statutory period of 35 U.S.C. § 315(b) and, therefore, we deny institution of an *inter partes* review.

B. Related Proceedings

Petitioner indicates that the '707 patent is the subject of a federal district court case: *Barco, N.V. v. Eizo Nanao Corp.*, 11-cv-00258 (N.D. Ga). Pet. 1.

As stated above, the '707 patent is the subject of *inter partes* review in the '358 proceeding. Additionally, the '707 patent is the subject of *Inter Partes* Reexamination No. 95/002,047 and was the subject of *Ex Parte* Reexamination No. 90/020,037 ("the '037 Reexam.").¹ Pet. 1.

II. ANALYSIS

In the present proceeding, Petitioner filed a Petition for *inter partes* review of the '707 patent and submitted a Motion for Joinder on July 21, 2014, seeking to join this Petition with the '358 proceeding. Patent Owner contends that the Petition is time-barred from *inter partes* review because its May 20, 2014, filing date is more than one year after the date Petitioner was served with the amended complaint in the related district court action, January 17, 2013. Prelim. Resp. 2; *see* Ex. 2005. Petitioner asserts that the "one-year time bar does not apply to a request for joinder" and the "motion for joinder permits a petition for *inter partes* review . . . to be filed more than one year after service of a complaint." Reply 2. That is, Petitioner acknowledges that this Petition was filed more than one year after the amended complaint was served. Accordingly, in light of our decision

¹ Reexamination Certificate No. US RE43,707 C1 ("the '707 C1 certificate") issued on March 31, 2014.

denying joinder of this proceeding with the '358 proceeding, this Petition is time-barred.

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has not filed a Petition in this proceeding within the one-year statutory period of 35 U.S.C. § 315(b). Accordingly, we deny institution of *inter partes* review in this proceeding.

IV. ORDER

For the reasons given, it is ORDERED that, pursuant to 35 U.S.C. § 315(b), Petitioner's Corrected Petition is *denied* as to all challenged grounds, and no trial is instituted.

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