EXHIBIT 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NICHIA CORPORATION
Petitioner

v.

EMCORE CORPORATION
Patent Owner

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Case IPR2012-00005
Patent 6,653,215

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Before KEVIN F. TURNER, STEPHEN C. SIU, and JONI Y. CHANG,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I.   INTRODUCTION

Nichia Corporation ("Nichia") filed a petition on September 16, 2012, requesting an *inter partes* review of claims 1-17 of U.S. Patent No. 6,653,215 ("the '215 patent"). Paper 2 ("Pet."). The patent owner, Emcore Corporation ("Emcore") did not file a preliminary response. Upon review of Nichia's petition, the Board instituted this trial on February 12, 2013.

During the trial, Emcore filed a patent owner response (Paper 24 ("PO Resp.")), and Nichia filed a reply to the patent owner response (Paper 38 ("Pet. Reply")). Emcore also filed a motion to amend claims (Paper 26); Nichia filed an opposition to Emcore's motion to amend claims (Paper 40); and Emcore then filed a reply (Paper 43) to Nichia's opposition. Oral hearing was held on November 6, 2013.[1]

We have jurisdiction under 35 U.S.C. § 6(c). This final written decision is entered pursuant to 35 U.S.C. § 318(a). We hold that claims 1-17 of the '215 patent are unpatentable under 35 U.S.C. § 103(a). Emcore's motion to amend claims is denied.

A. Related Proceeding

Nichia indicates that the '215 patent is asserted in the litigation styled *Emcore Corp. v. Nichia Corp.*, Case No. 2-12-cv-11758 (E.D. Mich). Pet. 1.

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[1] A transcript of the oral hearing is included in the record as Paper 66.

B. *Real Party-in-Interest*

Emcore asserts that Nichia[2] failed to identify all real parties-in-interest in the petition, as required by 35 U.S.C. § 312(a)(2). PO Resp. 1. In support of that assertion, Emcore alleges that Nichia represented to the district court, in a motion to stay, that both Nichia Corporation and Nichia America Corporation ("NAC") filed the petition. *Id*. at 2 (citing Ex. 2017, 1). Emcore takes the position that the petition was "filed at the behest of both Nichia Corporation and NAC," and that Nichia "is acting in the interest of NAC." *Id*. at 3. Emcore submits that NAC is a subsidiary of Nichia, and as co-defendants in the district court litigation, both Nichia and NAC used the same expert witness and counsel, and asserted the same prior art and claim for a declaratory judgment. *Id*. at 3-4.

Nichia disagrees and argues that a clerical error was made inadvertently in the motion to stay, and it has notified the district court of the clerical error. Pet. Reply 15. As support, Nichia has submitted a copy of the Notice Correcting Corporate Names (Ex. 1036) that was filed in the district court. *Id*. Nichia also asserts that NAC had no control over the decision to file a petition, drafting the petition, or the content of the petition. *Id*. at 14. Nichia further maintains that NAC did not fund the petition. *Id*.

We are not persuaded by Emcore's argument, as it is based on a clerical error made in a Nichia's court filing, and speculations. Whether a party that is not named in an *inter partes* review is a "real party-in-interest"

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[2] In the instant proceeding, the term "Nichia" refers to Nichia Corporation, and does not include Nichia America Corporation.

is a "highly fact-dependent question," taking into account various factors such as whether the non-party "exercised or could have exercised control over a party's participation in a proceeding" and the degree to which a non-party funds directs and controls the proceeding. Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48759-60 (Aug. 14, 2012).

Upon review of the parties' arguments and evidence, we determine that Emcore did not demonstrate adequately that Nichia failed to identify all real parties-in-interest. The petition identifies Nichia Corporation as the real party-in-interest. Pet. 1. Nichia's motion to stay (Ex. 2017) and the Notice Correcting Corporate Names (Ex. 1036) reveal that: (1) the motion to stay used the shorthand "Nichia" to refer to both Nichia Corporation and NAC; (2) the motion to stay inadvertently stated that "Nichia filed a Petition for *inter partes* review . . ."; and (3) the motion to stay should have used "Nichia Corporation" rather than "Nichia." Ex. 2017, 1-2; Ex. 1036, 2. The evidence before us clearly shows that the motion to stay filed in the district court contains a clerical error, especially in light of the fact that in the instant proceeding, we use the term "Nichia" to refer only to Nichia Corporation (*see, e.g.*, Decision on Institution, Paper 13 at 2). Therefore, the evidence does not establish that NAC is a real party-in-interest to this proceeding. Moreover, the mere fact that Nichia and NAC, as co-defendants, shared the same counsel and expert witness, and had similar litigation strategy is not sufficient to prove that NAC exercised, or could have exercised, control over Nichia's action in the instant proceeding. Nor does being a subsidiary of Nichia establish that NAC has the ability to control Nichia's conduct in this

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