

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MAKO SURGICAL CORP.,  
Petitioner,

v.

BLUE BELT TECHNOLOGIES, INC. and  
CARNEGIE MELLON UNIVERSITY  
Exclusive Licensee and Patent Owner.

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Case IPR2015-00630  
Patent 6,205,411 B1

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Before SALLY C. MEDLEY, KEVIN F. TURNER, and  
WILLIAM M. FINK, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

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

A conference call was held on December 16, 2015, involving respective counsel for Mako Surgical Corporation and Blue Belt Technologies, Inc., and Judges Medley, Turner, and Fink. Counsel for Carnegie Mellon University (“CMU”) was not present on the call. Counsel for named Patent Owner (“Blue Belt”) initiated the call to seek authorization to file a Motion to Terminate. We

provided the panel's decision on the conference call that no motion was authorized. This order memorializes the discussion and decision thereon, and provides specific requirements detailed herein.

Blue Belt sought authorization to file a motion to terminate because the Petition fails to name the true patent owner as a real party in interest. Blue Belt argued that because all real parties-in-interest are not named in this proceeding, it should be terminated, citing *Corning Optical Comm'ns RF, LLC v. PPC Broadband, Inc.*, Case IPR2014-00440, slip op. at 23–25 (PTAB Aug. 18, 2015) (Paper 68) and 35 U.S.C. § 312 (a)(2).

During the conference call, we pointed out that the cited case addressed real parties-in-interest for petitioners and did not address real parties-in-interest for patent owners. Blue Belt acknowledged that it did not know of any case where the Board has dismissed or terminated a proceeding for failure of a petitioner to correctly list the correct patent owner's real party-in-interest.

Moreover, we disagree with Blue Belt that 35 U.S.C. § 312 (a)(2) requires Petitioner to identify all real parties in interest for the *Patent Owner*. That section of the statute requires Petitioner to name all of its real parties-in-interest, but does not require Petitioner to name Patent Owner's real parties-in-interest. *See also* 37 CFR § 42.8(a) (requiring a petitioner to identify petitioner's real parties-in-interest in the petition, and patent owner to identify patent owner's real parties-in-interest in mandatory notices). We find Blue Belt's proffered reading of the statute to require Petitioner to name all of Patent Owner's real parties-in-interest to be unreasonable. Patent Owner is in the best position to inform the Board and Petitioner who is a real party in interest for

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Patent Owner, just as Petitioner is in the best position to inform the Board and Patent Owner who is a real party-in-interest for Petitioner.

We referred Blue Belt to *Askeladden LLC v. McGhie*, Case IPR2015-00122 et al., slip op. at 2–3 (PTAB Dec. 16, 2014) (Paper 9), where the panel in that proceeding determined that a patent owner’s mandatory notices clarified the record and, therefore, denied authorization for that patent owner to file motions to dismiss the petitions for failing to name the correct patent owner’s real party-in-interest. We are persuaded that Blue Belt’s filing of mandatory notice (Paper 5), indicating that Blue Belt is the exclusive licensee of U.S. Patent No. 6,205,411, and that CMU is the owner of that patent, is sufficient to clarify the record in this proceeding.

Additionally, an *inter partes* review is initiated against claims of a patent, determining unpatentability of claims upon institution, independent of what party has ownership of the patent, even if that ownership changes over the course of the proceeding. Indeed, even if the named parties settle, a final written decision may still be issued determining the patentability of claims, per 35 U.S.C. § 317(a). For all of these reasons, Blue Belt is not authorized to file a motion to terminate.

A separate issue raised during the call was whether a power of attorney for Patrick J. McElhinny or Mark. G. Knedeisen, said to be representing CMU, was filed in this proceeding. Paper 5, 2. As explained on the call, the filing of a power of attorney for those individuals should be made. 37 C.F.R. § 42.10.

During the call, Blue Belt indicated that it did not know whether Carnegie Mellon University was willing to participate in this proceeding. A

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review of the papers in this proceeding, however, indicates that CMU has participated in this proceeding and has acted as a party to this proceeding. CMU is represented by counsel and has authorized the filing of a Patent Owner Response (Paper 11). CMU also authorized the filing of a Motion to Amend (Paper 12), wherein CMU indicates that it “hereby joins in a motion to amend U.S. Patent No. 6,205,411.” Paper 12, 1. Further, as noted by Petitioner’s counsel, CMU has acted or has had the ability to act during the elapsed portion of the trial. Therefore, based on the present record, we are persuaded that CMU is a party to this proceeding, as the patent owner, and should be named as such. Lastly, although CMU has had minimal participation in this proceeding, CMU nonetheless would be bound by any judgment adverse to Blue Belt. *See, e.g.*, 37 C.F.R. § 42.73(d)(3).

In order to make the record in this proceeding clear, we request that CMU provide power of attorney for the attorneys representing it in this proceeding.

It is

ORDERED that Patent Owner’s request to file a motion to terminate is *denied*;

FURTHER ORDERED that Carnegie Mellon University is named as the patent owner in this proceeding and is a party to the proceeding such that it would be bound by any judgment adverse to Blue Belt. *See, e.g.*, 37 C.F.R. § 42.73(d)(3); and

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FURTHER ORDERED that Carnegie Mellon University shall, no later than December 22, 2015, file a power of attorney for the counsel indicated as representing Carnegie Mellon University.

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