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BAKOS & KRITZER

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TRISTAR PRODUCTS, INC.  
Petitioner

v.

CHOON'S DESIGN INC.  
Patent Owner

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Case IPR2015-00840  
Patent No. 8,622,441 B1

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**PETITIONER'S BRIEF IN RESPONSE TO PATENT OWNER'S  
CONTENTIONS RELATIVE TO 35 U.S.C. § 315(b)**

In its Order dated July 24, 2015 (Paper No. 6), the Board authorized Petitioner Tristar Products, Inc. (“Petitioner”) to submit a brief responding to contentions by Patent Owner Choon’s Design Inc. (“Patent Owner”) relative to 35 U.S.C. § 315(b). In short, Patent Owner has alleged that even though it filed proof of service with the District Court for the Eastern District of Michigan listing the date of service as March 4, 2015, service was also made at an earlier time. Patent Owner contends that the earlier service triggers the one year bar to *inter partes* review codified in 35 U.S.C. § 315(b), even though it was not substantiated pursuant to Federal Rule of Civil Procedure 4(l). Pursuant to the authorization granted by Paper No. 6, Petitioner hereby responds to Patent Owner’s contentions.

**I. Factual Background**

Patent No. 8,622,441 (the “441 Patent”) was asserted against Petitioner by the Patent Owner in *Choon’s Design Inc. v. Tristar Products, Inc.*, Case No. 2:14-cv-10848 (E.D. Mich.) (complaint filed February 24, 2014) (“the Litigation”). Pursuant to Federal Rule of Civil Procedure 4(l), on March 10, 2014, Patent Owner filed a proof of service with the district court confirming that service of the complaint was completed on March 4, 2014 at 3:10pm by personal service on Ms. Jan Teleski. Ex. 1004. Attached thereto was a copy of the summons, which states “[w]ithin 21 days after service of this summons on you (not counting the day you received it)...you must serve on the plaintiff an answer to attached complaint or a motion

under Rule 12 of the Federal Rules of Civil Procedure.” Ex. 1004 at 2. Mr. Steven Susser, an attorney of record for Patent Owner in the Litigation, filed the proof of service with the following docket entry: “CERTIFICATE of Service/Summons Returned Executed. Tristar Products, Inc. served on 3/4/2014, answer due 3/25/2014. (Susser, Steven) (Entered: 3/10/2014).” Ex. 3000. Petitioner did not challenge the sufficiency of service and filed its response in a timely manner consistent with the Proof of Service. Ex. 3000.

As detailed in Patent Owner’s Preliminary Response (Paper No. 5), Patent Owner contends that it served the complaint twice – first on February 28, 2014 and again on March 4, 2014. (Paper No. 5 at 1-3). Patent Owner did not file an affidavit demonstrating proof of service with the Eastern District of Michigan pursuant to Fed. R. Civ. P. 4(l)(1) with respect to its claimed February 28, 2014 service.

35 U.S.C. § 315(b) states in part: “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 relevant question is whether service prior to the date in a patent owner’s proof of service, which a petitioner has not had the opportunity to challenge, can prevent the filing of an otherwise-timely petition for *inter partes* review. Petitioner has not located a prior decision addressing this set of circumstances. For the following reasons, the deadline to file a petition

for *inter partes* review under 35 U.S.C. § 315(b) should be calculated from the date indicated in the proof of service filed by the patent owner in the corresponding district court Litigation.

## II. **The Date of the Patent Owner's Proof of Service of the Complaint for the Purposes of Calculating the Time Limitation Under 35 U.S.C. § 315(b)**

Fed. R. Civ. P. 4(l) requires a plaintiff to prove service:

“(l) Proving Service.

(1) Affidavit Required. Unless service is waived, proof of service must be made to the court. Except for service by a United States marshal or deputy marshal, proof must be by the server's affidavit.

...

(3) Validity of Service; Amending Proof. Failure to prove service does not affect the validity of service. The court may permit proof of service to be amended.”

“Service of process, under longstanding tradition in our system of justice, is fundamental to any procedural imposition on a named defendant.” *Murphy Bros., Inc. v. Michetti Pipe Stringing, Inc.*, 526 U.S. 344, 350 (1999). Under the federal rules enacted by Congress, federal courts lack the power to assert personal jurisdiction over a defendant “unless the procedural requirements of effective service of process are satisfied.” *Gorman v. Ameritrade Holding Corp.*, 293 F.3d 506, 514 (D.C. Cir. 2002); see *Omni Capital Int'l, Ltd. v. Rudolf Wolff & Co., Ltd.*, 484 U.S. 97, 104 (1987); *Miss. Publ'g Corp. v. Murphree*, 326 U.S. 438, 444-45 (1946). Service is therefore not only a means of “notifying a defendant of the commencement of an action against him,” but “a ritual that marks the court's

assertion of jurisdiction over the lawsuit.” *Okla. Radio Assocs. v. FDIC*, 969 F.2d 940, 943 (10<sup>th</sup> Cir. 1992). Consequently, courts have “uniformly held ... a judgment is void where the requirements for effective service have not been satisfied.” *Combs v. Nick Garin Trucking*, 825 F.2d 437, 442 & n. 42 (D.C. Cir. 1987) (collecting cases); *cf. Cambridge Holdings Grp., Inc. v. Federal Ins. Co.*, 489 F.3d 1356, 1360 (D.C. Cir. 2007).

Fed. R. Civ. P. 4(1)(3) provides: “Failure to prove service does not affect the validity of service. The court may permit proof of service to be amended.” That is, a plaintiff may amend its proof of service “even if the plaintiff fails timely to prove service by filing a server’s affidavit or files defective proof of service.” *Mann v. Castiel*, 681 F.3d 368, 373 (D.C. Cir. 2012) (*citing O’Brien v. R.J. O’Brien & Assocs., Inc.*, 998 F.2d 1394, 1402 (7th Cir. 1993)). In the corresponding Litigation, Petitioner has not challenged the March 4, 2014 service date as defective, and Patent Owner has not amended its proof of service.

**A. Absent Proof of Service, Patent Owner’s Purported Service on February 28, 2014 is Unsubstantiated**

As described above, absent waiver of service of process, a plaintiff is required to file an affidavit to prove service. Fed. R. Civ. P. 4(1). Indeed, a “[p]laintiff bears the burden of exercising due diligence in perfecting service of process and showing that proper service has been made.” *Jacobs v. Univ. of Cincinnati*, 189 F.R.D. 510,

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