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Paper 8
Entered: August 26, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRISTAR PRODUCTS, INC.,
Petitioner,

v.

CHOON'S DESIGN, LLC,
Patent Owner.

Case IPR2015-00838 (Patent 8,485,565 B2)
Case IPR2015-00840 (Patent 8,622,441 B1)[1]

Before GRACE KARAFFA OBERMANN, JEREMY M. PLENZLER, and JON B. TORNQUIST, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

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

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[1] This Decision addresses issues that are common to each of the above-referenced cases. We, therefore, issue a single Decision that has been entered in each case. The parties may use this style caption when filing a single paper in multiple proceedings, provided that such caption includes a footnote attesting that "the word-for-word identical paper is filed in each proceeding identified in the caption."

I. INTRODUCTION

A. Background

Tristar Products, Inc. ("Petitioner") filed Petitions to institute *inter partes* reviews of certain claims of U.S. Patent Nos. 8,485,565 ("the '565 patent") and 8,622,441 ("the '441 patent") on March 3, 2015. IPR2015-00838, Paper 1 ("838 Pet."); IPR2015-00840, Paper 1 ("840 Pet."). Choon's Design, LLC ("Patent Owner") filed a Preliminary Response in each of IPR2015-00838 and IPR2015-00840. IPR2015-00838, Paper 5 ("838 Prelim. Resp."); IPR2015-00840, Paper 5 ("840 Prelim. Resp."). Upon authorization from the panel (IPR2015-00838, Paper 6; IPR2015-00840, Paper 6), Petitioner filed supplemental briefing on 35 U.S.C. § 315(b) relative to the instant proceedings (IPR2015-00838, Paper 7 ("315(b) Br."); IPR2015-00840, Paper 7).[2]

We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." Under 35 U.S.C. § 315(b), however, we are precluded from instituting *inter partes* review "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." For the reasons given below, we do not institute an *inter partes* review in this proceeding.

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[2] Petitioner's supplemental briefing is identical in each case. For simplicity, our decision refers to "315(b) Br.," rather than citing to the briefing in each case individually.

B. Related Proceedings

Petitioner and Patent Owner indicate that the '565 patent and the '441 patent are the subject of the following federal district court case: *Choon's Design, Inc. v. Tristar Products, Inc.*, No. 2:14-cv-10848 (E.D. Mich.). 838 Pet. 1; 840 Pet. 1; IPR2015-00838, Paper 4, 2; IPR2015-00840, Paper 4, 2.[3]

II. ANALYSIS

As noted above, 35 U.S.C. § 315(b) states that "[a]n 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." Patent Owner contends that institution of trial in each of IPR2015-00838 and IPR2015-00840 is barred under 35 U.S.C. § 315(b) because "Tristar filed its Petition on March 3, 2015, more than one year after it was first served with the complaint in [*Choon's Design, Inc. v. Tristar Products, Inc.*, No. 2:14-cv-10848 (E.D. Mich.)]." 838 Prelim. Resp. 2; 840 Prelim. Resp. 2.

Patent Owner contends that "Tristar's registered agent was actually first served with the complaint on February 28, 2014." 838 Prelim. Resp. 1; 840 Prelim. Resp. 1. In each of IPR2015-00838 and IPR2015-00840, Patent Owner provides "Exhibit B [a]s the Proof of Service for February 28,

[3] Patent Owner and Petitioner identify numerous additional federal district court cases as related to the '565 and '441 patents. 838 Pet. 1–2; 840 Pet. 1–2; IPR2015-00838, Paper 4, 1–2; IPR2015-00840, Paper 4, 1–2.

2014."[4] 838 Prelim. Resp. 1; 840 Prelim. Resp. 1. In the discussion of related litigation, the 838 Petition and 840 Petition each indicate that "[t]he earliest that Petitioner was served was March 4, 2014." 838 Pet. 2; 840 Pet. 1. In its 315(b) Brief, Petitioner argues that "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." 315(b) Br. 2–3. The issue before us is whether the February 28, 2014 service on Petitioner is the service used to calculate the one-year deadline for filing a petition for *inter partes* review.

Petitioner's 315(b) Brief notes that "Petitioner has not located a prior decision addressing this set of circumstances" (315(b) Br. 2), and proceeds to argue that it would be unfair to use the February 28, 2014 service date for purposes of 35 U.S.C. § 315(b). For example, Petitioner notes that "Petitioner has not had an opportunity to challenge the alleged February 2[8], 2014 service which remains unsubstantiated," and "allow[ing] a patent owner to utilize an unsubstantiated service date to preclude an *inter partes* review under 35 U.S.C. § 315(b) . . . would unnecessarily create an improper loophole by allowing a patent owner to improperly serve a party at an early date, and then effect proper service at a later date." 315(b) Br. 5. Here, the February 28, 2014 service date is not unsubstantiated, as Patent Owner presents a signed declaration from the process server attesting to the February 28, 2014 service date. IPR2015-00838, Ex. 2; IPR2015-00840, Ex. 2002. Petitioner had the opportunity to identify any procedural defects

[4] Patent Owner refers to Exhibit 2002 in IPR2015-00840 as proof of service. Exhibit B (or Exhibit 2) and Exhibit 2002 appear to be the same document in each case.

in the February 28, 2014 service in its supplemental briefing (the 315(b) Brief). Noticeably missing from Petitioner's arguments, however, is any argument regarding a reason why the February 28, 2014 service was defective. In fact, Petitioner does not allege that the service was defective, but rather, argues that proof of the service was not filed with the court. *See, e.g.*, 315(b) Br. 8 (arguing that "Patent Owner has not provided any reason why it did not file the earlier proof of service with the district court," but not alleging that the service was defective); *see* Fed. R. Civ. P. 4(l)(3) ("Failure to prove service does not affect the validity of service.").

The plain language of 35 U.S.C. § 315(b) requires "the petitioner, real party in interest, or privy of the petitioner [to be] served with a complaint alleging infringement of the patent" to start the one year period for filing a petition for *inter partes* review. The statute does not include any requirement regarding filing proof of that service with a court. Based on the information before us, there is no reason to conclude that the February 28, 2014 service on Petitioner was defective, or otherwise ineffective to trigger the one-year bar of § 315(b). For example, although Petitioner argues that service might have been ineffective, if the entity served was no longer the registered agent for service of process, it has not come forward with any allegation suggesting this to be the case. *See* 315(b) Br. 5–6. Nor has Petitioner come forward with any argument that a procedural defect renders the February 28, 2014 service ineffective to trigger the bar. Petitioner's arguments regarding "not ha[ving] an opportunity to challenge the alleged February 2[8], 2014 service" and "allowing a patent owner to improperly serve a party at an early date, and then effect proper service at a later date" (315(b) Br. 5) are unpersuasive. Based on the particular facts before us,

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