

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

IMMERSION CORPORATION
Patent Owner

U.S. Patent No. 8,773,356

Filing Date: January 31, 2012

Issue Date: July 8, 2014

Title: Method and Apparatus for Providing Tactile Sensations

Inter Partes Review No.: IPR2017-00897

BRIEF ON SERVICE ISSUES

I. STATEMENT OF FACTS

The Petition and exhibits in this IPR were filed on Sunday, February 12, 2017. Ex. 1116 at 1. Payment for that Petition was accepted by the USPTO on February 12, 2017. Ex. 1117 at 2. Copies of the Petition, exhibits and power of attorney (collectively, the “Service Documents”) were served in two ways. Hard copies of Service Documents were placed into a cardboard box having a size of approximately 13”x10”x5”, and a UPS shipping label addressed to “Kilpatrick Townshend and Stockton, LLP, 1001 W. Fourth Street, Winston Salem NC 27101-2410” was attached to that box, on February 12, 2017. Ex. 1118 at 1; Ex. 1119 ¶ 9. The USPTO’s PAIR system indicates that this is the address of record for the ’356 patent. Ex. 1120 at 1. The cardboard box with that UPS shipping label was irretrievably placed through a slot/door into (not on the top/side of, or next to) a metal UPS drop box in the lobby of the building in which DLA Piper’s Austin, Texas office is located on February 12, 2017. Ex. 1119 ¶ 9. The box with that UPS shipping label was picked up from that drop box by UPS the next day on Monday, February 13, 2017 and delivered to the address on the label on Tuesday, February 14, 2017. Ex. 1121 at 1. These dates are undisputed. Ex. 2001 at 7.

An electronic copy of the Petition was served via email, and copies of the Petition, accompanying exhibits, and power of attorney were served via email using DLA’s FTP file transfer utility, on both lead and backup counsel of record

for this IPR on February 12, 2017. Ex. 1122 at 1; Ex. 1123 at 1. A zip file of those documents was accessed via this FTP utility by someone using the credentials supplied to Michael Fleming on Monday, February 13, 2017. Ex. 1124 at 1.

II. SERVICE WAS PROPERLY EFFECTED ON FEBRUARY 12, 2017

Service of a petition is governed by 37 C.F.R. §§ 42.6(e) and 42.105. The only relevant part of §42.6(e) is a requirement that the service be simultaneous with filing. Service on the day of filing satisfied that requirement. Sub-section (a) of §42.105 states that “[t]he petition and supporting evidence must be served on the patent owner at the correspondence address of record for the subject patent. The petitioner may additionally serve the petition and supporting evidence on the patent owner at any other address known to the petitioner as likely to effect service.” That regulation was complied with here. Hard copies of the Petition and accompanying exhibits were served on the patent owner at the correspondence address of record at the USPTO on February 12, 2017 via UPS. Ex. 1119 ¶¶ 3- 9.

37 C.F.R. § 42.105(b) provides that “Upon agreement of the parties, service may be made electronically. Service may be by Priority Mail Express[®] or by means at least as fast and reliable as Priority Mail Express[®]. Personal service is not required.” Again, that regulation was complied with here. The regulation expressly allows service by means at least as fast and reliable as Priority Mail Express. UPS fits that description, and hard copies of the service documents were

placed into a UPS drop box on the same day on which the Petition was filed, February 12, 2017. Ex. 1119 ¶ 9. § 42.105 requires nothing more. In particular, there is no requirement in 37 C.F.R. § 42.105(b) that a package must be placed into the hands of a U.S. Postal Service (“USPS”) employee in order effect service. To the contrary, the Board found that placing service copies of an IPR petition into a USPS mail slot on the day the Petition was filed was sufficient in *Yamaha Corp. of Am. v. Black Hills Media, LLC*, IPR2013-00593, Paper 22. In *Yamaha*, the service copies were placed into a USPS mail slot on 9/18/13 (the same day the petition was filed), first processed by the USPS the next day on 9/19/13, and delivered two days after the petition was filed on 9/20/13 (*id.* at 4). The Board found that the 9/18/13 filing date of the petition in that case was correct in light of this service (*id.* at 6). The facts are nearly identical here: the Petition was placed through a slot/ door into the UPS drop box on Sunday, processed/picked up by UPS on Monday, and delivered on Tuesday. Moreover, it is undisputed that UPS performed as fast and reliably as Priority Mail Express in this case. Given that US Post Offices are closed on Sundays, hard copies of the service documents in this case would not have been processed any earlier than Monday or delivered any earlier than Tuesday if they had been placed into a USPS Express Mail slot on Sunday.

Mr. Fleming has attempted to distinguish the facts here from *Yamaha* on the basis that *Yamaha* involved a USPS mail slot in a USPS building. Ex. 2001 at 8.

However, this argument fails because 37 C.F.R. § 42.105(b) expressly provides that a delivery service other than the USPS may be used to effect service.

Mr. Fleming also argued that the package containing the Service Documents is “larger than the maximum size allowed by UPS for packages to be deposited in a UPS drop box,” which creates a presumption that the packages were not placed into the drop box. Ex. 2001at 9. Any such presumption is clearly rebutted by Ex. 1119 ¶¶ 10-11, which establishes through photographs including a ruler that were previously provided to Mr. Fleming that the UPS drop box in question could accept packages of the size containing the Service Documents in this case, and that the box containing the Service Copies was placed in that UPS drop box on 2/12/17.

III. SERVICE WOULD HAVE BEEN TIMELY ON FEBRUARY 13, 2017

There is no *statutory* requirement for, or governing timing of, service of an IPR petition. *Yamaha*, IPR2013-00593, Paper 22 at 6; *Telemark N.A. LLC v. Joao Control & Monitoring Sys., LLC.*, IPR2015-01466, Paper 10 at 5. The only statutory requirement is that copies of the Petition and supporting papers be “provided” to the patent owner. *Id.* That has been done here. Thus, according the Petition its actual February 12, 2017 filing date does not implicate any statutory concern. A *regulation*, 37 CFR § 42.106(a) provides in relevant part that “[a] petition to institute *inter partes* review will not be accorded a filing date until the petition satisfies all of the following requirements . . . [e]ffects service of the

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