

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC., CANON U.S.A., INC., CANON FINANCIAL SERVICES,
INC., NIKON CORPORATION, NIKON INC.,
SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., SANYO ELECTRIC CO.,
LTD.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2018-00410
Patent 6,895,449 B2

Before JONI Y. CHANG, JENNIFER S. BISK, and MIRIAM L. QUINN,
Administrative Patent Judges.

BISK, *Administrative Patent Judge.*

JUDGMENT

Denying *Inter Partes* Review; Dismissing Motion for Joinder;
Dismissing Motion to Waive or Suspend Rule 37 C.F.R. § 42.122
37 C.F.R. §§ 42.108, 42.122

INTRODUCTION

On December 29, 2017, Petitioner, listed above, filed a Petition requesting *inter partes* review of claims 1–10, 12–13, and 15–18 of U.S. Patent No. 6,895,449 B2 (“the ’449 patent,” Ex. 1001). Paper 1 (“Pet.”). Petitioner concurrently filed a Motion for Joinder (Paper 5, “Mot.”), seeking to be joined to ZTE (USA) Inc. v Papst Licensing GMBH, Case No. IPR2017-00415 (the “ZTE IPR”). In addition, Petitioner filed a Motion to Waive or Suspend Rule 37 C.F.R. § 42.122. Paper 6 (“Mot. to Waive”). Patent Owner filed an opposition to both the Motion for Joinder (Paper 13, “Opp. Mot.”) and the Motion to Waive (Paper 14, “Opp. Mot. to Waive”). The due date for any Preliminary Response is not until April 10, 2018. Because the dismissal of both of Petitioner’s motions determines the outcome of the Petition in this case, we need not wait for Patent Owner’s response.

For the reasons provided below, we dismiss both the Motion for Joinder and the Motion to Waive and deny the Petition.

RELATED PROCEEDINGS

The parties indicate that the ’449 patent has been asserted in cases taking place in several district courts. Pet. 3–4; Paper 12, 7. This patent has also been challenged in several other petitions for *inter partes* review. Pet. 3–4; Paper 12, 2–7.

The ’449 patent is also the subject of the ZTE IPR. In that case, we instituted trial on May 17, 2017 (IPR2017-00415, Paper 8), but terminated it on January 18, 2018, because the parties settled their dispute (IPR2017-00415, Paper 32).

ANALYSIS

A. *Petitioner's Motions are Moot*

Petitioner seeks joinder with the ZTE IPR. Mot. 1. The ZTE IPR has been terminated. *See* IPR2017-00415, Paper 32. Hence, there is no pending proceeding for Petitioner to join. Accordingly, we dismiss the Motion for Joinder as moot. Likewise, because the Motion to Waive or Suspend Rule 37 C.F.R. § 42.122 requests waiver of the deadline for filing the Motion for Joinder (Mot. to Waive 1), it is also moot.

B. *The Petition is Time-Barred under 35 U.S.C. § 315(b)*

Section 315(b) bars institution of *inter partes* review when the petition is filed more than one year after the petitioner is served with a complaint alleging infringement of the patent. 35 U.S.C. § 315(b). There is no dispute that Petitioner was served with a complaint alleging infringement of the '449 patent more than one year before it filed its Petition. *See* Mot. 3–4; Mot. to Waive 2–4. The Petition, therefore, is statutorily barred, and no *inter partes* review may be instituted. 35 U.S.C. § 315(b).

ORDER

Accordingly, it is

ORDERED that the Motion for Joinder is *dismissed* as moot;

FURTHER ORDERED that the Motion to Waive or Suspend Rule 37 C.F.R. § 42.122 is *dismissed* as moot; and

FURTHER ORDERED that the Petition for *inter partes* review of claims 1–10, 12–13, and 15–18 of the '449 patent is *denied*.

IPR2018-00410
Patent 6,895,449 B2

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