

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CREE, INC.,
Petitioner,

v.

DOCUMENT SECURITY SYSTEMS, INC.,
Patent Owner.

Case IPR2018-01220
Patent 7,256,486 B2

Before SCOTT C. MOORE, AMBER L. HAGY, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. §§ 314(a), 315(b)

I. INTRODUCTION

This is a preliminary proceeding to decide whether to institute *inter partes* review of U.S. Patent No. 7,256,486 B2 (Ex. 1001, “the ’486 patent”). See 35 U.S.C. § 314(a); 37 C.F.R. § 42.4(a) (delegating authority to institute trial to the Board). Cree, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) seeking *inter partes* review of claims 1–4 of the ’486 patent. Patent Owner, Document Security Systems, Inc., filed a Preliminary Response to the Petition (Paper 8, “Prelim. Resp.”).

Upon consideration of the Petition and the Preliminary Response, we find that the Petition is barred by 35 U.S.C. § 315(b). Accordingly, we deny institution of an *inter partes* review.

II. RELATED MATTERS

As required by 37 C.F.R. § 42.8(b)(2), each party identifies various judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 83; Paper 4 (Patent Owner’s Mandatory Notices). The parties identify the following district court cases: *Document Security Systems, Inc. v. Seoul Semiconductor Co. Ltd.*, No. 2:17-cv-00308 (E.D. Tex.) (dismissed without prejudice); *Document Security Systems, Inc. v. Seoul Semiconductor Co. Ltd.*, No. 8:17-cv-00981 (C.D. Cal.); *Document Security Systems, Inc. v. Cree, Inc.*, No. 2:17-cv-04263 (C.D. Cal.); *Document Security Systems, Inc. v. Cree, Inc.*, No. 2:17-cv-00309 (E.D. Tex.) (dismissed without prejudice); *Document Security Systems, Inc. v. Everlight Electronics Co., Ltd. et al.*, No. 2:17-cv-00310 (E.D. Tex.) (dismissed without prejudice); *Document Security Systems, Inc. v. Everlight Electronics Co., Ltd. et al.*, No. 2:17-cv-04273 (C.D. Cal.); *Document Security Systems, Inc. v. OSRAM GmbH*, No. 2:17-cv-05184 (C.D. Cal.);

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Document Security Systems, Inc. v. Lite-On, Inc., No. 2:17-cv-06050 (C.D. Cal.); and *Document Security Systems, Inc. v. Nichia Corporation et al.*, No. 2:17-cv-08849 (C.D. Cal.). Pet. 83; Paper 4, 2–3 (identifying the district court cases as involving the '486 patent). The parties also indicate that *inter partes* review of the '486 patent has been requested in IPR2018-00333, IPR2018-01166, IPR2018-01205, and IPR2018-01225. Pet. 83; Paper 4, 3–4.

III. ANALYSIS

In its Preliminary Response, Patent Owner contends that the Petition is untimely and no *inter partes* review can be instituted. PO Resp. 1–4 (citing 35 U.S.C. § 315(b); *Click-to-Call Tech., LP v. Ingenio, Inc.*, 899 F.3d 1321, 1330 (Fed. Cir. 2018) (en banc)). Patent Owner presents evidence that Petitioner was served with a complaint alleging infringement of the '486 patent more than one year prior to the filing of the Petition. Prelim. Resp. 1–2 (citing Ex. 2109 ¶¶ 20–26; Ex. 2110, 2). Petitioner did not request an opportunity to respond.

Under 35 U.S.C. § 315(b), “[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.” The U.S. Court of Appeals for the Federal Circuit held, in an en banc decision issued after the Petition was filed, that “§ 315(b) . . . unambiguously precludes . . . instituting an IPR if the petition seeking institution is filed more than one year after the petitioner, real party in interest, or privy of the petitioner ‘is served with a complaint’ alleging patent infringement.” *Click-to-Call*, 899 F.3d at 1330. The court further held that

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“§ 315(b)’s time bar is implicated once a party receives notice through official delivery of a complaint in a civil action, irrespective of subsequent events,” including dismissal, with or without prejudice. *Id.*

Petitioner, who is the real party-in-interest (Pet. 82), was served with a complaint alleging infringement of the ’486 patent in *Document Security Systems, Inc. v. Cree, Inc.*, No. 2:17-cv-00309 (E.D. Tex.). *See* Ex. 2109, 1 (identifying Petitioner as defendant), 3 (identifying ’486 patent), 6–9 (alleging infringement of the ’486 patent), 17 (requesting judgment that Petitioner has infringed one or more claims of the ’486 patent). According to the proof of service, this complaint was served on Petitioner on April 14, 2017. *See* Ex. 2110, 3.

The Petition was filed on June 7, 2018. *See* Paper 6 (Notice of Filing Date Accorded to Petition). This filing date is more than one year after the date of service of the complaint alleging infringement of the ’486 patent. In addition, the Petition was not accompanied by a motion for joinder. 35 U.S.C. § 315(b) (indicating the time bar “shall not apply to a request for joinder”).

Accordingly, the Petition is untimely, and we are barred from instituting an *inter partes* review. 35 U.S.C. § 315(b); *Click-to-Call*, 899 F.3d. at 1330.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED, pursuant to 35 U.S.C. § 315(b), that the Petition is *denied*, and no *inter partes* review is instituted as to any claim of the ’486 patent.

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