

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ONE WORLD TECHNOLOGIES, INC.,  
D/B/A TECHTRONIC INDUSTRIES POWER EQUIPMENT,  
Petitioner,

v.

CHERVON (HK) LIMITED,  
Patent Owner.

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Case IPR2020-00885  
U.S. Patent No. 9,648,805

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**PETITIONER'S MOTION TO UPDATE MANDATORY NOTICE  
TO ADD REAL PARTIES-IN-INTEREST**

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Pursuant to the Board’s order of August 27, 2020 (Paper 12), and in accordance with 37 C.F.R. § 42.20(a) (2020), One World Technologies, Inc., d/b/a Techtronic Industries Power Equipment (“Petitioner”) respectfully moves to update its mandatory notice to identify additional real parties-in-interest (“RPIs”) without changing the filing date of the above-captioned petition.<sup>1</sup> Specifically, Petitioner hereby moves to update its mandatory notice to identify Techtronic Industries Co. Ltd., Techtronic Industries North America, Inc., and Homelite Consumer Products, Inc., as real parties-in-interest without admitting that they are, in fact, real parties-in-interest.

**I. The Board Should Allow Petitioner to Update the Real Parties-In-Interest Listing While Maintaining the Original Filing Date.**

The Federal Circuit has held that the real party-in-interest requirement of 35 U.S.C. § 312(a) is correctable. “[I]f a petition fails to identify all real parties in

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<sup>1</sup> As permitted by the order, substantively identical motions and related papers are being filed in each of IPR2020-00883 (Patent 9,060,463 B2); IPR2020-00884 (Patent 9,596,806 B2); IPR2020-00885 (Patent 9,648,805 B2); IPR2020-00886 (Patent 9,826,686 B2); IPR2020-00887 (Patent 9,986,686 B2); IPR2020-00888 (Patent 10,070,588 B2); PGR2020-00059 (Patent 10,477,772 B2); PGR2020-00060 (Patent 10,485,176 B2); and PGR2020-00061 (Patent 10,524,420 B2).

interest under § 312(a)(2), the Director can, and does, allow the petitioner to add a real party in interest.” *WiFi One v. Broadcom Corp.*, 878 F.3d 1364, 1374, n.9 (Fed. Cir. 2018) (*en banc*).<sup>2</sup> The requirement to identify all RPIs serves “to assist members of the Board in identifying potential conflicts, and to assure proper application of the statutory estoppel provisions.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012). A lapse in compliance with the requirements of § 312(a) “does not deprive the Board of jurisdiction over the proceeding, or preclude the Board from permitting such lapse to be rectified.” *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, Case IPR2015-00739, slip op. 5 (PTAB Mar. 4, 2016) (Paper 38) (precedential). Indeed, the Board has found that allowing petitioners “to update the mandatory notices while maintaining the original filing date promotes the core functions of RPI disclosures and secures a ‘just, speedy, and inexpensive resolution’ of this proceeding.” *Adello Biologics LLC v. Amgen Inc.*, PGR2019-00001, Paper 11 at 5 (PTAB Feb. 14, 2019) (designated precedential Apr. 16, 2019) (citing 37 C.F.R. § 42.1).

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<sup>2</sup> *Wi-Fi One* was decided in the context of *inter partes* review, and in *Adello Biologics LLC v. Amgen Inc.*, PGR2019-00001, Paper 11 at 3 n.1 (PTAB Feb. 14, 2019) (designated precedential Apr. 16, 2019), the Board saw “no reason” to treat differently the correction of RPIs in a post-grant review.

**A. 35 U.S.C. 312(a) and 37 C.F.R. 42 Allow Updates to the RPI Listing While Maintaining a Petition’s Original Filing Date.**

Section 312 is not a jurisdictional statute. *Lumentum*, at 4-5 (relying on *Elekta, Inc. v. Varian Med. Sys., Inc.*, IPR 2015-01404, Paper 19 (PTAB Dec. 31, 2015)). “Section [37 C.F.R. §] 42.106 does not foreclose the Board’s discretion to maintain a petition’s original filing date when a party amends its RPI disclosures because, under § 42.5(b), ‘[t]he Board may waive or suspend’ § 42.106’s filing date provisions.” *Elekta* at 8. The *Elekta* Board maintained the petition’s original filing date and allowed petitioner to amend its mandatory notice and add RPIs based on § 42.5(b). *Id.*, 8-10. *See* § 42.5(a); *Lumentum* at 7 (37 C.F.R. 42.5(c)(3) “provid[es] the Board discretion to permit late-filing of the updated mandatory notice.”). The Board therefore has authority to provide the relief sought.

**B. No Evidence of Bad Faith, Gamesmanship, or Intentional Concealment by Petitioner.**

In *Adello*, the Board considered whether any intentional concealment, gamesmanship, or other bad faith by the petitioner was behind its delay in identifying an additional RPI. *Adello*, at 4-5; *see also Proppant*, at 6. None of those factors is present here. Petitioner acknowledges that parties and individuals involved in proceedings before the Office have a “duty of candor and good faith,” 37 C.F.R. § 42.11(a). With that understanding, Petitioner represents that there was no intentional concealment, gamesmanship, or bad faith in its decision to identify

only “One World Technologies, Inc., d/b/a Techtronic Industries Power Equipment” as the Petitioner.

Patent Owner bases its argument on purported control over the Petitioner. Specifically, Patent Owner’s Preliminary Response (POPR) asserts that Techtronic Industries Co. Ltd. is a real party in interest because that entity allegedly controlled the filing of this Petition. *See, e.g.*, IPR2020-00885, Paper 11 at 43-44. The declaration from Mr. Clancy (Ex. 2004) asserts that it was his impression during settlement negotiations that Lee Sowell “on behalf of ‘TTI’” controlled whether any and all of Petitioner, Techtronic Industries Co. Ltd., and Homelite Consumer Products, Inc. would file an IPR petition. The POPR concludes, without any support, that “‘TTI’ stands for Techtronic Industries Co. Ltd.” POPR at 45, n. 8. This is wrong. Rather, Mr. Sowell’s use of “TTI” was shorthand for the Petitioner; *i.e.*, One World Technologies, Inc., d/b/a Techtronic Industries Power Equipment. *See* Ex. 1036 (Declaration of Lee Sowell), ¶2. Thus, Patent Owner has no basis to assert that Techtronic Industries Co. Ltd. controlled the filing of this Petition.

Instead, Techtronic Industries Co. Ltd. and Techtronic Industries North America, Inc., are Petitioner’s grandparent and parent investment holding companies, respectively. *See* Patent Owner’s Exhibit 2005, p.63 (Techtronic Industries Co. Ltd. “acts as an investment holding company”); p.112 (Techtronic Industries North America, Inc. “Principal activities[:] Investment holding”). *See*

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