UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CHERVON (HK) LIMITED,
Patent Owner.

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

PETITIONER'S REPLY IN SUPPORT OF ITS 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), Petitioner submits this reply in support of its motion to update its mandatory notices.

Patent Owner's opposition offers unsupported rhetoric but fails to address the undisputed fact central to the motion—namely, none of the parties sought to be added as real parties-in-interest is statutorily barred from filing an IPR petition. Patent Owner relies nearly exclusively on *Ventex Co., Ltd. v. Columbia Sportswear North Am., Inc*., IPR2017-00651, Paper 148 (Jan. 24, 2019), arguing the to-be-named RPIs are "clear beneficiaries" of this proceeding. Opp., 2-5. *Ventex*, however, turned on whether beneficiaries of a petition were time-barred under 35 U.S.C. § 315(b) from pursing their own IPR petitions. *Id*., 8. The one-year time bar also was central to *Applications in Internet Time, LLC v. RPX Corp*., 897 F.3d 1336 (Fed. Cir. 2018) ("*AIT*"), the case that guided the *Ventex* panel. In contrast, none of the to-be-named RPIs here were served with a complaint more than one year before the petition was filed. This fundamental difference explains the glaring omission by Patent Owner of any alleged motive or benefit that would support its claims of bad faith and gamesmanship. As Petitioner established, there was none.

In fact, Patent Owner's unsupported claims of bad faith and gamesmanship are belied by another undisputed fact—namely, Patent Owner knew about each to-be-named RPI long before the petition was filed. Unlike *Ventex* and *AIT*, Patent Owner is not at risk of an untimely administrative attack against its patents, and all

RPIs will be bound by the outcome and the estoppel of § 315(e) or § 325(e). And in contrast to Patent Owner's "willful blindness" comment from *AIT*—where the petitioner's actions were intended to circumvent its client's one-year bar under § 315(b)—no RPI in this proceeding is subject to that bar. Opp., 5-6; *AIT*, 1335.

None of Patent Owner's arguments warrant denial of Petitioner's motion. In general, an RPI "may be the petitioner itself, and/or it may be the party or parties at whose behest the petition has been filed." Office Patent Trial Practice Guide. However, "[t]here is no rule establishing that every party who has been sued for infringement of a patent is necessarily a real party-in-interest in every proceeding challenging the patentability of the claims of that patent." *Puzhen Life USA, LLC v. Esip Series 2, LLC*, IPR2017-02197, Paper 13 at 5 (PTAB, Apr. 11, 2018).

Here, Mr. Sowell's declaration unequivocally confirms that Petitioner "had no obligation to consult with any of those three companies or obtain their permission to file the IPR and PGR petitions in this matter." Ex. 1036, ¶4. Homelite's alleged activity of "import[ing] and distribut[ing]" the accused products (Opp., 3) does not demonstrate control over Petitioner's decision to file this proceeding. Patent Owner also fails to explain how a warranty card from Techtronic Industries North America Inc. demonstrates control over Petitioner. Opp., 3. And despite Patent Owner's speculation (Opp., 3-4), it is commonplace for settlement discussions to explore how all parties might resolve their

differences. Patent Owner identifies no authority to support the conclusion that Mr. Sowell's discussion with Mr. Clancy should invoke the notion of real parties-in-interest, especially where public policy strongly favors the resolution of disputes via settlement. Patent Owner's attorney argument that when Mr. Sowell used "TTI" he meant the Petitioner's parent is belied by the actual facts—Mr. Sowell has confirmed his employer does business as TTI, and Patent Owner's own research has confirmed Mr. Sowell works for One World Technologies, the Petitioner. Ex. 2022. Patent Owner also offers no authority that an overlap in corporate addresses or directors means that two entities are necessarily real parties-in-interest. Opp., 4. And the perception of a former President regarding corporate organization (Opp., 4) is far less relevant than Mr. Sowell's dispositive declaration.

Finally, Patent Owner's unsupported claims of "gamesmanship" and "bad faith" are highly ironic, given that Patent Owner waited until the afternoon its response was due to inform Petitioner that Patent Owner was about to violate the district court's Protective Order by submitting documents produced by the defendants in the district court proceeding that cannot be used "under any circumstances for any other proceeding"—a prohibition that Patent Owner agreed and the district court ordered. The timing of that request and Patent Owner's reference to it speak volumes. In short, Patent Owner's Opposition punctuates that this motion should be granted so the Board can address the merits of the Petition.

Respectfully submitted,

Dated: September 14, 2020

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