

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KAPSCH TRAFFICCOM IVHS INC., KAPSCH TRAFFICCOM IVHS
HOLDING CORP., KAPSCH TRAFFICCOM IVHS TECHNOLOGIES
HOLDING CORP., KAPSCH TRAFFICCOM U.S. CORP., and
KAPSCH TRAFFICCOM HOLDING CORP.,
Petitioner,

v.

NEOLOGY, INC.,
Patent Owner.

Case IPR2015-00808 (Patent 6,229,443)
Case IPR2015-00814 (Patent 6,690,264)
Case IPR2015-00815 (Patent 8,587,436)
Case IPR2015-00818 (Patent 8,237,568)
Case IPR2015-00819 (Patent 8,325,044)
Case IPR2015-00823 (Patent 7,119,664)
Case IPR2015-00824 (Patent 7,119,664)¹

¹ This Decision addresses issues that are the same in all seven cases. We exercise our discretion to issue one Decision to be filed in each case. The parties are not authorized to use this style heading.

Before JUSTIN T. ARBES, GLENN J. PERRY, and
TREVOR M. JEFFERSON, *Administrative Patent Judges*.

PERRY, *Administrative Patent Judge*.

DENIAL OF MOTIONS TO VACATE
Real Party In Interest Under 35 U.S.C. § 312(a)(2)

I. INTRODUCTION

Petitions seeking *inter partes* reviews were filed in each of the captioned cases by Kapsch TrafficCom IVHS Inc. (“Kapsch TC IVHS”), Kapsch TrafficCom IVHS Holding Corp., Kapsch TrafficCom IVHS Technologies Holding Corp., Kapsch TrafficCom U.S. Corp., and Kapsch TrafficCom Holding Corp. (collectively “Petitioners”). Mot. 1. These Petitions challenge six patents owned by Neology, Inc. (“Neology”). Each Petition also names three additional corporate entities as real parties in interest (“RPI”): Kapsch TrafficCom Holding II US Corp.; Kapsch TrafficCom AG (“Kapsch TCAG”); and Kapsch TrafficCom, B.V. (“Kapsch TCBV”). Decisions regarding institution of trial are being issued in these cases.

Neology filed substantially identical motions to vacate² in each of its seven *inter partes* review matters challenging six different patents. These motions are based on Petitioners’ failure to name at least two additional

² IPR2015-00808, Paper 8 (“Mot.”); IPR2015-00814, Paper 8; IPR2015-00814, Paper 8; IPR2015-00818, Paper 8; IPR2015-00819, Paper 10; IPR2015-00823, Paper 8; IPR2015-00824, Paper 8;

Case IPR2015-00808, -00814, -00815, -00818, -00819, -00823, and -00824 Patents 6,229,443; 6,690,264; 8,587,436; 8,237,568; 8,325,044; and 7,119,664

corporate entities as RPIs: Kapsch-Group Beteiligungs GmbH (“Kapsch-Group”) and Kapsch Aktiengesellschaft (“Kapsch AG”). For simplicity, we discuss Neology’s motion made in IPR2015-00808, which is illustrative. Our conclusions apply to all seven *inter partes* reviews.

According to Neology, because the Petition in each case fails to identify all real parties in interest (“RPI”), it is not entitled to a filing date. *See* 35 U.S.C. § 312(a)(2) (a petition for *inter partes* review may be considered “only if” it meets certain statutory requirements, including identification of “all” real parties in interest); 37 C.F.R. § 42.106; Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012) (“Trial Practice Guide”). It has been more than one year since the service on Petitioners of a complaint asserting the challenged patents against them. Consequently, 37 C.F.R. § 42.106, which affords Petitioners one month to correct a defective petition, is inapplicable, and if a new filing date were accorded, the Petitions would be time-barred under 35 U.S.C. § 315(b).

Neology’s motion attempts to demonstrate sufficient involvement of the unnamed corporate entities based on 1) events surrounding a settlement meeting, 2) statements made in Kapsch-Group public documents, and 3) “admissions” by Kapsch AG. Petitioners oppose the motion.³ For reasons stated below, we DENY Neology’s motion to vacate.

³ IPR2015-00808, Paper 9 (“Opp.”); IPR2015-00814, Paper 9; IPR2015-00814, Paper 9; IPR2015-00818, Paper 9; IPR2015-00819, Paper 11; IPR2015-00823, Paper 9; IPR2015-00824, Paper 9.

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II. APPLICABLE LAW

A. Burden

We generally accept a petitioner's identification of real parties in interest at the time of filing the petition. *See* Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents; Final Rule, 77 Fed. Reg. 48,680, 48,695 (Aug. 14, 2012). A patent owner challenging a petitioner's RPI disclosure must provide sufficient evidence to show the disclosure is inadequate. *Intellectual Ventures Mgmt., LLC v. Xilinx, Inc.*, Case IPR2012-00018, slip op. at 3 (PTAB Jan. 24, 2013) (Paper 12). Prior to institution, when a patent owner provides sufficient evidence that reasonably brings into question the accuracy of a petitioner's identification of RPI, the overall burden remains with the petitioner to establish that it has complied with the statutory requirement of 35 U.S.C. § 312(a)(2) to identify all real parties in interest. *Zerto, Inc. v. EMC Corp.*, Case IPR2014-01254, slip op. at 6–7 (PTAB Feb 12, 2015) (Paper 32).

B. Considerations and Factors

As stated in the Trial Practice Guide, whether a party who is not a named participant in a given proceeding is a “real party-in-interest” to that proceeding “is a highly fact-dependent question.” 77 Fed. Reg. at 48,759 (citing *Taylor v. Sturgell*, 533 U.S. 880 (2008)). There is no “bright line test.” *Id.* In general, a “real party-in-interest” is “the party that desires review of the patent,” and “may be the petitioner itself, and/or it may be the party or parties at whose behest the petition has been filed.” *Id.* The Supreme Court in *Taylor* set forth a list of factors that might be relevant in a

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particular case. 533 U.S. at 893–95. Although “rarely will one fact, standing alone, be determinative of the inquiry” (Trial Practice Guide, 77 Fed. Reg. at 48,760), “[a] common consideration is whether the non-party exercised or could have exercised control over a party’s participation in a proceeding” (*id.* at 48,759 (citations omitted)); *see also Reflectix, Inc. v. Promethean Insulation Tech. LLC*, Case IPR2015-00039, slip op. at 12 (PTAB April 24, 2015) (Paper 18) (“The proper RPI analysis [] focuses on . . . the degree to which [the related non-named entity] exercised, or could have exercised, control over the Petitions.”).

Other considerations may include whether a non-party “funds and directs and controls” an IPR petition or proceeding; the non-party’s relationship with the petitioner; the non-party’s relationship to the petition itself, including the nature and/or degree of involvement in the filing; and the nature of the entity filing the petition. Trial Practice Guide, 77 Fed. Reg. at 48,760; *see also id.* at 48,759 (citing *Taylor*, 553 U.S. at 893–95 & n.6 (2008)). A party does not become a RPI merely through association with another party in an endeavor unrelated to the IPR proceeding. *Id.* at 48,760; *see also Denso Corp. v. Beacon Navigation GmbH*, Case IPR2013-00026, slip op. at 10–11 (PTAB Mar. 14, 2014) (Paper 34) (stating that the mere fact that parties are co-defendants or concurrent defendants in related litigation does not make them RPI).

When a patent owner asserts control as a basis for a non-party being a real party in interest, the non-party’s participation with the petitioner may be overt or covert, and the evidence may be direct or circumstantial, but the evidence as a whole must show that the non-party possessed effective

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