

Trials@uspto.gov
Tel: 571-272-7822

IPR2014-00935, Paper 52
IPR2014-00936, Paper 56
IPR2014-00938, Paper 57
Entered: August 21, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JIAWEI TECHNOLOGY (HK) LTD., JIAWEI TECHNOLOGY (USA) LTD.,
SHENZHEN JIAWEI PHOTOVOLTAIC LIGHTING CO., LTD., ATICO
INTERNATIONAL (ASIA) LTD., ATICO INTERNATIONAL USA, INC.,
CHIEN LUEN INDUSTRIES CO., LTD., INC. (CHIEN LUEN FLORIDA),
CHIEN LUEN INDUSTRIES CO., LTD., INC. (CHIEN LUEN CHINA),
COLEMAN CABLE, LLC, NATURE'S MARK, RITE AID CORP., SMART
SOLAR, INC., AND TEST RITE PRODUCTS CORP.,
Petitioner,

v.

SIMON NICHOLAS RICHMOND,
Patent Owner.

IPR2014-00935 (Patent 8,089,370 B2)
IPR2014-00936 (Patent 7,196,477 B2)
IPR2014-00938 (Patent 7,429,827 B2)

Before WILLIAM V. SAINDON, JUSTIN T. ARBES, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Motion to Terminate
35 U.S.C. § 312(a)(2) and 37 C.F.R. § 42.72

IPR2014-00935 (Patent 8,089,370 B2)
IPR2014-00936 (Patent 7,196,477 B2)
IPR2014-00938 (Patent 7,429,827 B2)

I. INTRODUCTION

Patent Owner filed a Motion to Terminate each of the instant proceedings on the basis that Petitioner failed to identify Southwire Company, LLC (“Southwire”) as a real party in interest (“RPI”) under 35 U.S.C. § 312(a)(2) at the time it filed its Petition. Paper 34 (“Mot.”).¹ Petitioner filed an Opposition, Paper 43 (“Opp.”), and Patent Owner filed a Reply, Paper 46 (“Reply”).² For the reasons stated below, Patent Owner’s Motion is DENIED.

A. Issue

The issue addressed in this Decision is whether Patent Owner has rebutted the presumption that Southwire was not a real party in interest at the time Petitioner filed its Petition (June 11, 2014). If Southwire was a real party in interest at the time Petitioner filed its Petition, then, according to Patent Owner, Petitioner’s Petition was incomplete under 35 U.S.C. § 312(a)(2), and this proceeding must be terminated, as the Petition would be accorded a new filing date and at least one of the Petitioner entities would be time-barred under 35 U.S.C. § 315(b). *See* Mot. 11–12; Paper 14, 3 n.4.

¹ This Decision addresses and disposes of similar motions appearing in IPR2014-00936, IPR2014-00935, and IPR2014-00938. Citations in this Decision are to those papers and exhibits filed in IPR2014-00936. Similar papers and exhibits may be found in IPR2014-00935 and IPR2014-00938.

² Petitioner also filed a motion to seal, along with redacted and unredacted versions of certain exhibits submitted with its Opposition. Paper 40. Patent Owner did not file an opposition to the motion. We do not refer to any of the material sought to be sealed in this Decision, and refer to the redacted versions of the exhibits where necessary. The motion to seal will be decided in a separate decision.

IPR2014-00935 (Patent 8,089,370 B2)
IPR2014-00936 (Patent 7,196,477 B2)
IPR2014-00938 (Patent 7,429,827 B2)

B. Background

The matter at hand stems from the relationship between Petitioner entity Coleman Cable, LLC (“Coleman”) and Southwire, Coleman’s current parent corporate entity, which was not listed as a RPI in the Petition. The following represents our understanding of the relevant events in this relationship.

Patent Owner served a complaint on Coleman Cable, Inc. on July 3, 2013, alleging infringement of one or more of its patents. Paper 14, 3 n.4. In December 2013, Southwire, Cubs Acquisition Corporation (“Cubs”), and Coleman Cable, Inc. signed an “Agreement and Plan of Merger,” wherein Southwire purchased 100% of the outstanding stock of Coleman Cable, Inc. Ex. 1046 ¶ 5.³ At that time, the then-President of Coleman Cable, Inc. issued a letter to its customers, explaining the existence of the merger agreement and that “[y]our Coleman contacts will remain the same, all current contracts will be honored, and there will be no immediate changes in how we conduct business with you.” Ex. 1030. The transaction later closed when Cubs merged with and into Coleman Cable, Inc., with Coleman Cable, Inc. being the surviving corporation; a merger certificate was filed on February 11, 2014. Ex. 1046 ¶ 5; *see also* Ex. 2037 (a Southwire PRNewswire release announcing the successful completion of the tender offer). On March 5, 2014, Coleman Cable, Inc. was reorganized into

³ Exhibit 1046 contains the testimony of Mr. Guyton Cochran. Mr. Cochran is Treasurer of Coleman and Executive Vice President and Chief Financial Officer of Southwire. Ex. 1046 ¶¶ 2–3.

IPR2014-00935 (Patent 8,089,370 B2)
IPR2014-00936 (Patent 7,196,477 B2)
IPR2014-00938 (Patent 7,429,827 B2)

Coleman Cable, LLC, with Southwire as the sole member.⁴ Ex. 1046 ¶¶ 7–8; Ex. 1017.

On June 11, 2014, Coleman, along with several other entities, filed a Petition in each of the instant proceedings. *See* Paper 4 (Coleman Power of Attorney); Paper 10 (first petition). The power of attorney for Coleman was signed by Mr. Floyd W. Smith, having a title of “Secretary.” Paper 4. At that time, Mr. Smith was also Executive Vice President, Secretary, and General Counsel of Southwire. Opp. 3; Ex. 1046 ¶¶ 12–13. Coleman’s share of the payments for the IPRs came from Coleman accounts, separate from Southwire’s accounts. Opp. 4–5; Ex. 1046 ¶¶ 17–21.

Patent Owner alleges that at the National Hardware Show (May 5–7, 2015), Southwire was listed in the directory as the exhibitor of a product formerly exhibited by Coleman. Mot. 4–5; Ex. 2055 ¶ 3. On June 22, 2015, Patent Owner contacted the Board seeking authorization to file the subject Motion, leading to the above-identified briefing. Paper 30. On July 17, 2015, Petitioner filed updated mandatory notice information adding Southwire as a real party in interest, pursuant to 37 C.F.R. § 42.8. Paper 38.

II. ANALYSIS

A. *Legal Principles*

Pursuant to 35 U.S.C. § 312(a)(2), a petition for *inter partes* review “may be considered *only if* . . . the petition identifies *all* real parties in

⁴ The ownership of limited liability companies is by one or more “members,” akin to the shareholders of traditional corporations or the partners of partnerships.

IPR2014-00935 (Patent 8,089,370 B2)
IPR2014-00936 (Patent 7,196,477 B2)
IPR2014-00938 (Patent 7,429,827 B2)

interest” (emphasis added). 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). Thus, there is a rebuttable presumption that a petitioner’s identification of real parties in interest is accurate. However, when a patent owner provides sufficient rebuttal evidence that reasonably brings into question the accuracy of the petitioner’s identification, the ultimate burden of proof 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.

Whether a non-party is a real party in interest for purposes of an *inter partes* review proceeding is a “highly fact-dependent question” that takes into account how courts generally have used the term to “describe relationships and considerations sufficient to justify applying conventional principles of estoppel and preclusion.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012) (“Trial Practice Guide”). 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.* Courts have identified multiple relevant factors that inform our analysis. *Id.* at 48,759–60. Relevant factors include the non-party’s “relationship with the petitioner” and “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.” *Id.*

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.