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.,
Petitioners

v.

SIMON NICHOLAS RICHMOND
Patent Owner

Case IPR2015-00580

Patent 7,429,827

PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER TO RELATED *INTER PARTES* REVIEW OF U.S. PATENT NO. 7,429,827 (IPR2014-00938)

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I. Introduction

Petitioner's Motion for Joinder (IPR2015-00580, the "580 IPR," Paper 11), which seeks to join its current Petition ("Second Petition") challenging Claims 31 - 34 of U.S. Patent No. 7,429,827 (the "827 Patent") with its prior proceeding (IPR2014-00938, the "938 IPR"), is without merit. The Second Petition relies upon the same prior art and the same or substantially the same arguments it presented in its prior "First Petition," filed June 6, 2014, 938 IPR (Paper 13), which the Board held failed to show a likelihood of unpatentability of Claims 31-34.[1] 938 IPR (Paper 20). This prior art and these same or substantially the same arguments were presented again in Petitioner's request for rehearing, 938 IPR (Paper 22)("Req. Reh'g"), and rejected again by the Board in its January 15, 2015 Decision denying rehearing. 938 IPR (Paper 27). 35 U.S.C § 325(d) expressly authorizes the Board to exercise its discretion to reject institution of a petition under such circumstances.

Since Petitioner transparently seeks joinder to attempt to avoid the one year bar of § 315(b) to obtain yet another bite at the same apple, this Board should

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[1] Trial was instituted only as to Claims 24-30 and 35, over various combinations of prior art, namely, Chliwnyj, Lau, Dowling, Wu and/or Pu. 938 IPR (Paper 20) at 19, encompassing all prior art now raised in the Second Petition.

exercise its discretion to deny joinder and institution of the improper Second Petition.

II. Response to Petitioner's STATEMENT OF FACTS Presented in the Motion for Joinder

In response to Petitioner's Alleged Fact No. 1, Patent Owner agrees that each real party-in-interest has the following service date in the District of New Jersey (the "New Jersey Lawsuit"): "June 11, 2013 (Menards, Lowe's, and Walgreens); June 12, 2013 (Smart Solar); June 13, 2013 (Ace, CVS, Jiawei Technology (USA) Ltd., Orgill, True Value, Chien Luen, and Rite Aid); July 3, 2013 (Coleman); and no service date (Nature's Mark and Test Rite)." 938 IPR (Paper 13) at 3. Regarding Alleged Fact No. 6, Patent Owner denies that "the Board found that claim 30 was obvious over Chliwnyj in view of Wu, and Lau." Petitioner mischaracterizes the Board's decision. Patent Owner admits the remainder of the alleged fact. Patent Owner admits the Alleged Facts Nos. 2 – 5 and 7 - 9.

III. Relevant Law

In IPR proceedings, "[a] petitioner is not entitled to multiple challenges against a patent." *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, IPR2015-00118 (Paper 14) at 6 – 7 (denying joinder and stating "we are not apprised of a reason that merits a second chance").

35 U.S.C. § 325(d) provides, in pertinent part, as follows:

> (d) MULTIPLE PROCEEDINGS. —*In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.* (Emphasis added.)

The Board designated seven decisions as "informative" regarding subsequent proceedings. In each, the Board exercised its discretion under 35 U.S.C. § 325(d) to reject a subsequent petition where "the same or substantially the same prior art or arguments were presented to the office." For example, in *ZTE v. ContentGuard Holdings*, IPR2013-00454 (Paper 12) at 6, the Board stated the following:

> A decision to institute review on some claims should not act as an entry ticket, and a how-to guide, for the same Petitioner who filed an unsuccessful joinder motion, and is outside of the one-year statutory period, for filing a second petition to challenge those claims which it unsuccessfully challenged in the first petition.

See also Intelligent Bio-systems, Inc. v. Illumina Cambridge Limited, IPR2013-00324 (Paper 19) at 6 – 7 (same); *Prism Pharma v. Choongwae Pharma.*, IPR2014-00315 (Paper 14) at 13 (same); *Medtronic, Inc. v. Robert Bosch Healthcare Systems, Inc.*, IPR2014-00436 (Paper 17) at 12 (same); *Medtronic, Inc. v. Nuvasive, Inc.*, IPR2014-00487 (Paper 8) at 6 – 7 (same); *Unilever, Inc. v. The Procter & Gamble Co.*, IPR2014-00506 (Paper 17) at 6 (same). *United Patents,*

Inc. v. Personalweb Technologies, LLC, IPR2014-00702 (Paper 12) at 4 ("Joinder [under Section 315(c)] is not automatic, particularly given the need to complete proceedings in a just, speedy, and inexpensive manner.") (citing 37 C.F.R. § 42.1(b)).

35 U.S.C. § 315(b) provides:

> An *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 time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

Multiple bites at the apple are "especially" unjustified when a subsequent petition would otherwise be time-barred by § 315(b). *Rembrandt Wireless*, IPR2015-00118 (Paper 14) at 7; *see also Medtronic, Inc. v. Endotach LLC*, IPR2014-00695 (Paper 18) at 4 ("when a § 315(b) bar would apply absent joinder, we hesitate to allow a petitioner a second bite one month after institution of a first case").

Petitioner here, as a single party with several members served with complaints more than one year ago, is time-barred under § 315(b), absent joinder. *Fandango, LLC v. Ameranth, Inc.*, CBM2014-00013 (Paper 22) at 4 (denying

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