Trials@uspto.gov
571-272-7822

Paper 12
Entered: September 25, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SEVEN NETWORKS, LLC,
Patent Owner.

IPR2018-01047 and IPR2018-01048 (Patent 9,516,129)
IPR2018-01049 and IPR2018-01101 (Patent 9,553,816)
IPR2018-01051 and IPR2018-01052 (Patent 9,516,127)
IPR2018-01094 and IPR2018-01095 (Patent 9,444,812)
IPR2018-01116 and IPR2018-01117 (Patent 9,351,254)
IPR2018-01102 (Patent 8,811,952)[1]

Before THU A. DANG, KARL D. EASTHOM, JONI Y. CHANG, THOMAS L. GIANNETTI, ROBERT J. WEINSCHENK, and JACQUELINE T. HARLOW, *Administrative Patent Judges*.[2]

CHANG, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

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[1] This Order applies to each of the above-listed proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this heading style in any subsequent papers.

[2] This is not an expanded panel of the Board. It is a listing of all the Judges on the panels of the above-listed proceedings.

I. INTRODUCTION

On September 24, 2018, Judges Dang, Easthom, Chang, Giannetti, Weinschenk, and Harlow held a conference call with counsel for Google LLC ("Petitioner") and counsel for SEVEN Networks, LLC ("Patent Owner"). A court reporter was present on the conference call. This order summarizes statements made during the conference call. A more complete record may be found in the court reporter's transcript.[3]

In its Petition (Paper 2[4], "Pet."), Petitioner identifies Google LLC as the sole real party in interest. Pet. 68. Patent Owner filed a Preliminary Response (Paper 10, "Prelim. Resp.") in each of the above-identified proceedings, except in Cases IPR2018-01094 and IPR2018-01095. In its Preliminary Responses, Patent Owner argues that Petitioner failed to identify all real parties in interest, namely Alphabet, Inc. and XXVI Holdings, Inc. (collectively, "Google's parent companies") as well as Samsung Electronics Co., Ltd. and/or Samsung Electronics America, Inc. (collectively, "Samsung"). Prelim. Resp. 13–38. According to Patent Owner, the failure to identify all real parties in interest "requires denial of the petition when the § 315(b) bar has elapsed." *Id*. at 14.

The purpose of the conference call, requested by the Board, was to discuss the real party in interest issues raised by Patent Owner, and a few

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[3] We authorize Petitioner to file the court reporter's transcript as an exhibit in each of the above-identified proceedings.

[4] We cite to the record in IPR2018-01047, unless otherwise noted.

other procedural matters. During the conference call, Petitioner requested authorization to file a reply to address Patent Owner's real party in interest arguments and Patent Owner requested authorization to file a sur-reply. Upon consideration of the totality of the circumstances, we grant both parties' requests as set forth below.

II. DISCUSSION

Petitioner is Required to Identify all Real Parties in Interest

Under 35 U.S.C. § 312(a)(2), a petitioner is required to identify all of the real parties in interest in each proceeding. The identification of real parties in interest must be submitted in the mandatory notices in accordance with 37 C.F.R. § 42.8(b)(1).

We generally accept a petitioner's initial identification of real parties in interest unless the patent owner presents some evidence to support that an unnamed party should be included as a real party in interest. *See Worlds Inc. v. Bungie, Inc.*, No. 2017-1481, 2018 WL 4262564, at *3 (Fed. Cir. Sept. 7, 2018) (explaining that "an IPR petitioner's initial identification of the real parties in interest should be accepted unless and until disputed by a patent owner," and that "a patent owner must produce some evidence to support its argument that a particular third party should be named a real party in interest"). Furthermore, the petitioner bears the burden of persuasion to demonstrate that it actually has identified all of the real parties in interest. *Cf. id.* at *3–4. This burden does not shift to the patent owner. *Id.* at *4–5.

Patent Owner is Conflating § 312(a)(2) with § 315(b)

Here, Patent Owner's arguments incorrectly conflate § 312(a)(2) with § 315(b) by applying § 312(a)(2) as part of the timeliness inquiry under § 315(b). Prelim. Resp. 13−38. These statutory provisions "entail distinct, independent inquiries." *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1364 (Fed. Cir. 2018) (Judge Reyna's concurring opinion). As the U.S. Court of Appeals for the Federal Circuit has noted, it "is incorrect" to "conflate[] 'real party in interest' as used in § 312(a)(2) and § 315(b), and claim[] that '§ 312(a)(2) is part and parcel of the timeliness inquiry under § 315.'" *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 1374 n.9 (Fed. Cir. 2018) (en banc). "For example, if a petition fails to identify all real parties in interest under § 312(a)(2), the Director can, and does, allow the petitioner to add a real party in interest." *Id.* (noting the following cases as examples: *Intel Corp. v. Alacritech, Inc.*, Case IPR2017-01392, slip op. at 23 (PTAB Nov. 30, 2017) (Paper 11); *Elekta, Inc. v. Varian Med. Sys., Inc.* Case IPR2015-01401, slip op. at 6−10 (PTAB Dec. 31, 2015) (Paper 19)); *see also Applications in Internet Time*, 897 F.3d at 1364 (Fed. Cir. 2018) (Judge Reyna's concurring opinion) (explaining that "Section 312(a)(2) is akin to a pleading requirement that can be corrected"). "In contrast, if a petition is not filed within a year after a real party in interest, or privy of the petitioner is served with a complaint, it is time-barred by § 315(b), and the petition cannot be rectified and in no event can IPR be instituted." *Wi-Fi One*, 878 F.3d at 1374 n.9.

Here, it is undisputed that Google LLC was served on **May 18, 2017**, with a complaint alleging infringement of at least one of the challenged patents. Ex. 2003, 2. The petitions at issue were timely filed within one year from May 18, 2017. Paper 4, 1 ("The petition for *inter partes* review, filed in the above proceeding has been accorded the filing date of May 18, 2018"). None of the allegedly unnamed real parties in interest was served on or before May 18, 2017, with a complaint alleging infringement of at least one of the challenged patents. The evidence in this record does not show, nor does Patent Owner argue, that Google's parent companies or Samsung were served with a complaint more than one year before May 18, 2018. Prelim. Resp. 13−38.

Therefore, even if the allegedly unnamed parties are real parties in interest, the Petitions at issue would not be time-barred under § 315(b).

Procedures for Rectifying Noncompliance of § 312(a)(2)

The Federal Circuit also has recognized that "the PTO has established procedures to rectify noncompliance of § 312(a)(2)." *Wi-Fi One*, 878 F.3d at 1374 n.9 (citing *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, Case IPR2015-00739, slip op. at 5 (PTAB Mar. 4, 2016) (Paper 38) (precedential); 37 C.F.R. §§ 42.8(a)(3), 42.8(b)(1)); *see also Applications in Internet Time*, 897 F.3d at 1364 (Fed. Cir. 2018) (Judge Reyna's concurring opinion) (explaining that "Section 312(a)(2) does not act as a prohibition on the Director's authority to institute"). Our precedential decision in *Lumentum Holdings*, indicates that "a lapse of compliance with those

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