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Paper 12
Date: August 27, 2020

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.

IPR2020-00883 (Patent 9,060,463 B2)
IPR2020-00884 (Patent 9,596,806 B2)
IPR2020-00885 (Patent 9,648,805 B2)
IPR2020-00886 (Patent 9,826,686 B2)
IPR2020-00887 (Patent 9,986,686 B2)
IPR2020-00888 (Patent 10,070,588 B2)
PGR2020-00059 (Patent 10,477,772 B2)
PGR2020-00060 (Patent 10,485,176 B2)
PGR2020-00061 (Patent 10,524,420 B2)

Before LINDA E. HORNER, BARRY L. GROSSMAN, JAMES J. MAYBERRY, and ALYSSA A. FINAMORE,
Administrative Patent Judges.[1]

MAYBERRY, *Administrative Patent Judge*.

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[1] This is not an expanded panel. Each of the four listed judges are part of one or more three-judge panels assigned to the listed proceedings.

ORDER[2]
Conduct of the Proceeding
37 C.F.R. §§ 42.5, 42.20(d)

BACKGROUND

On August 26, 2020, we held a conference call between the parties and Judges Horner, Grossman, Mayberry, and Finamore. In the call, Petitioner, One World Technologies, Inc., d/b/a Techtronic Industries Power Equipment ("One World") sought authorization to (1) file a Reply to the Patent Owner Preliminary Responses in IPR2020-00883, -00884, -00885, -00886, -00887, and -00888 and (2) update its mandatory notices in the six proceedings to add three real parties-in-interest ("RPIs"). At the end of the conference call, Petitioner added that at least the RPI issue also may apply to three post-grant review proceedings: PGR2020-00059, PGR2020-00060, and PGR2020-00061.

Patent Owner, Chervon (HK) Ltd. ("Chervon"), objected to the requests.

[2] This Order addresses issues that are the same in all listed cases. We do not authorize the parties to use this style heading for any subsequent papers at this time.

SUMMARY OF THE PARTIES' POSITIONS AND PANEL'S ANALYSIS

Reply

One World requests to file a Reply to Chervon's Preliminary Response to address discretionary denial under 35 U.S.C. § 314(a) and, specifically, Chervon's analysis of the *Fintiv* factors. On May 5, 2020, the Board made an Order in *Apple Inc. v. Fintiv, Inc.*, precedential. IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*"). The Order provides factors the Board balances in addressing whether the Board should exercise its discretion under § 314(a) to not institute a proceeding because of a parallel proceeding, as provided in our precedential decision in *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) ("*NHK*"). *See Fintiv* at 5–6.

One World argued that we designated *Fintiv* precedential after One World had filed its Petitions in the six *inter partes* review proceedings but before Chervon's Preliminary Responses. One World also argued that *NHK* is distinguishable from the facts of these six *inter partes* review proceedings, so One World had no reason to address the issue in the Petitions.

Chervon argued that One World should have addressed the parallel litigation and discretionary denial in its Petitions. Chervon added that the Board designated *NHK* as precedential prior to One World filing its

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Petitions, yet One World did not address the parallel district court litigation under *NHK*.

We determine, based on our review of the current records of the six *inter partes* review proceedings, that additional briefing on this issue would not benefit the Board. Accordingly, we deny One World's request to file Replies to the Preliminary Responses in these six *inter partes* review proceedings. We do not address this request for the three above-identified post-grant review proceedings.[3]

Real Parties-in-Interest

One World seeks authorization to update its mandatory notices to add three parties as real parties-in-interest in the six above-identified *inter partes* review proceedings without changing the filing date for the Petitions. During the call, One World also indicated that this issue may apply to the three above-identified post-grant review proceedings as well.

One World indicated that Chervon's contentions in its Preliminary Responses concerning One World's failure to name all real parties-in-interest are based on faulty facts, but One World stated it is willing to add

[3] As of the date of this Order, Chervon has not yet filed preliminary responses in the three post-grant review proceedings. Should One World wish to file replies to any preliminary responses in the three post-grant review proceedings, One World must request authorization anew.

the parties identified by Chervon as real parties-in-interest. One World defended its decision to originally not include the parties in the Petitions, arguing that the parties are not real parties-in-interest. One World indicated that, if the current filing dates are maintained, then adding the parties would not result in a time bar under 35 U.S.C. § 315(b).

Chervon responded that One World knew of these parties, two of which are co-defendants in parallel litigation, and had the obligation to identify the parties as real parties-in-interest in the Petitions. Chervon contended that, if the parties are added now, the filing dates of the Petitions should change, resulting in a time bar for the parties.

As an initial matter, we interpret One World's request as seeking authorization to file a motion to update the identified real parties-in-interest without changing the filing date for the effected Petitions. *See* 37 C.F.R. § 42.20(a) (2020) ("Relief, other than a petition requesting the institution of a trial, must be requested in the form of a motion."); *see also* 37 C.F.R. § 42.8(a) (allowing updates to mandatory notices without a motion, but only for changes and only if made within the prescribed time frame). For the reasons explained below, we grant authorization for the motion. That is, prior to us allowing One World to update its mandatory notices to add the parties as real parties-in-interest, One World must demonstrate that such an update is warranted without a corresponding change in the filing dates of the Petitions.

By statute, "[a] petition . . . may be considered only if . . . the petition identifies all real parties in interest." 35 U.S.C. § 312(a); *see also* 37 C.F.R. § 42.104 (requiring *inter partes* review petitions to include mandatory notices, including identifying real parties in interest); § 42.204 (providing the same for post-grant review petitions). "The core functions of the 'real party-in-interest' . . . requirement[] [is] to assist members of the Board in identifying potential conflicts, and to assure proper application of the statutory estoppel provisions." Consolidated Trial Practice Guide 12, available at https://www.uspto.gov/TrialPracticeGuideConsolidated (Nov. 2019). The Board has held that "a lapse in compliance with [the] requirements [of § 312(a)] does not deprive the Board of jurisdiction over [a] proceeding, or preclude the Board from permitting such lapse to be rectified." *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, IPR2015-00739, Paper 38 at 5 (PTAB Mar. 4, 2016) (precedential).

Indeed, we have said that failing to identify all real parties-in-interest is not meant to be a "windfall" for a patent owner. *Adello Biologics LLC v. Amgen Inc.*, PGR2019-00001, Paper 11 at 3–4 (PTAB Feb. 14, 2019) (precedential). In *Adello Biologics*, the Board exercised its discretion and allowed the petitioner to update the real parties-in-interest while maintaining the same filing date to "promote[] the core functions of RPI disclosures and secure[] a 'just, speedy, and inexpensive resolution' of this proceeding." *Id.* at 5.

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Significant to the Board's decision in *Adello Biologics* was the petitioner's explanation for omitting the party to be added. *Id.* at 4. Also, the Board relied on petitioner's certification that it did not act in bad faith. *Id.* at 5. Accordingly, before we allow the requested update, we require One World to file a motion explaining its reasons for omitting the three parties it seeks to add and certifying that the omissions were not in bad faith.

For expedience, we authorize One World's motion in each of the six above-referenced *inter partes* review proceedings and the three above-identified post-grant review proceedings.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request to file a Reply to the Patent Owner Response in each of the six above-identified *inter partes* review proceedings is *denied*;

FURTHER ORDERED that Petitioner is authorized to file a motion to amend its mandatory notices to add real parties-in-interest without a change to the filing date of the Petitions in each of the six above-identified *inter partes* review proceedings and three above-identified post-grant review proceedings, the motion not to exceed seven pages and due September 3, 2020;

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FURTHER ORDERED that Patent Owner is authorized to file an opposition to Petitioner's motion, the opposition not to exceed seven pages and due one week after Petitioner's motion; and

FURTHER ORDERED that Petitioner is authorized to file a reply to Patent Owner's opposition, not to exceed three pages and due three days after Patent Owner's opposition.

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