

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TARGET CORPORATION,
Petitioner,

v.

DESTINATION MATERNITY CORPORATION,
Patent Owner.

Case IPR2014-00508
Patent RE43,563 E

Before LORA M. GREEN, THOMAS L. GIANNETTI,
JENNIFER S. BISK, MICHAEL J. FITZPATRICK, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* FITZPATRICK.

Opinion Dissenting filed by *Administrative Patent Judge* GREEN, in which
GIANNETTI, *Administrative Patent Judge*, joins.

FITZPATRICK, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 315(b)

Petitioner Target Corporation filed a corrected Petition (“Petition”) for an *inter partes* review of claims 1–4, 6–8, 10–14, 16, 20, and 21¹ of U.S. Patent No. RE43,563 E (the “’563 patent”). Paper 9. The Petition was accorded a filing date of March 14, 2014. Paper 5. The Patent Owner, Destination Maternity Corporation, filed a Preliminary Response pursuant to 35 U.S.C. § 313. Paper 16. We have authority to determine whether to institute an *inter partes* review under 35 U.S.C. § 314(b) and 37 C.F.R. § 42.4(a). We *deny* the Petition.

Petitioner previously filed two other petitions for *inter partes* reviews of different, yet overlapping, subsets of claims of the ’563 patent. We instituted trial in both of those proceedings: IPR2013-00530 and IPR2013-00531 (“the pending trials”). Collectively, we instituted trial on all but one of the claims of the ’563 patent that Petitioner had challenged in the pending trials. *See* Paper 13 in IPR2013-00530 (instituting trial on all of challenged claims 1–4 and 6–8); Paper 10 in IPR2013-00531 (instituting trial on challenged claims 1, 10–14, 16, and 20 but not on challenged claim 21).

Prior to the filing of all of Petitioner’s petitions for *inter partes* reviews of the ’563 patent, Patent Owner asserted the patent against Petitioner in a lawsuit: *Destination Maternity Corporation v. Target Corporation et al.*, Case No. 2:12-cv-05680-AB (E.D. Pa.). Pet. 1; Patent Owner Mandatory Notices 2 (Paper 6). Petitioner was served, in that lawsuit, with a complaint alleging infringement of the ’563 patent on

¹ Petitioner subsequently filed a motion to limit the claims being challenged by its Petition to only claims 1, 20, and 21. Paper 7.

October 4, 2012. *Destination Maternity Corporation v. Target Corporation et al.*, Case No. 2:12-cv-05680-AB (E.D. Pa.) (Dkt. No. 5).

The instant Petition, filed March 14, 2014, was filed more than one year after Petitioner was served with the complaint alleging infringement of the '563 patent. *See* Paper 5. We may not institute an *inter partes* review when “the petition . . . is filed more than 1 year after the date on which the petitioner, . . . is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b). Section 315(b) further states this “time limitation . . . shall not apply to a request for joinder under subsection (c).” *Id.* Thus, it does not apply to a person’s request to “join as a party to that [i.e., a previously instituted] *inter partes* review.” 35 U.S.C. § 315(c).² However, the time limitation does apply to that person’s petition.

Accordingly, it is

ORDERED that the Petition is denied and no trial is instituted.

² Petitioner’s request for joinder is denied, by separate decision, entered contemporaneously with this Decision.

GREEN, *Administrative Patent Judge, dissenting*, in which GIANNETTI, *Administrative Patent Judge*, joins.

As stated in our dissent to the denial of Petitioner's Motion for Joinder, entered contemporaneously with this Decision, joinder may be appropriate if the merits are reached. As we conclude that 35 U.S.C. § 315(c) does not prohibit joinder of the same party, we would consider the merits of the joinder motion, and if joinder were appropriate, we would address the merits of the petition as to challenged claims 20 and 21.

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Patent RE43,563 E

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