

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRON TECHNOLOGY, INC. and
MICRON CONSUMER PRODUCTS GROUP, INC.,
Petitioner,

v.

e.DIGITAL CORPORATION,
Patent Owner.

Case IPR2015-00519
Patent 5,839,108

Before LYNNE E. PETTIGREW, DAVID C. MCKONE, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

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

On February 13, 2015, Patent Owner e.Digital Corporation (“Patent Owner”) filed a motion titled “Patent Owner’s Motion To Deny The Petition A Filing Date For Failure To Serve The Patent Owner At The Correspondence Address Of Record And To Dismiss The Petition For Failure To File The Petition Within One Year After Service Of A Complaint For Patent Infringement.” Paper 8 (“Mot.”). On February 24, 2015, Petitioner Micron Technology, Inc., and Micron Consumer Products Group, Inc. (collectively “Petitioner”) filed an Opposition to Patent Owner’s Motion. Paper 11 (“Opp.”). The Motion and Opposition had been authorized by the Board in an Order dated February 10, 2015. Paper 7.

Background

Our governing statute regarding service provides that a petition for *inter partes* review may be considered only if “the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.” 35 U.S.C. § 312(a)(5). Our rules state that the “petition and supporting evidence must be served on the patent owner at the correspondence address of record for the subject patent. The petitioner may additionally serve the petition and supporting evidence on the patent owner at any other address known to the petitioner as likely to effect service.” 37 C.F.R. § 42.105(a). Moreover, 37 C.F.R. § 42.106(a)(2) provides that the petition will not be accorded a filing date until the petition satisfies the requirement of effecting “service of the petition on the correspondence address of record as provided in 37 C.F.R. § 42.105(a).”

Regarding the one-year bar, 35 U.S.C. § 315(b) states: “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 . . . is served with a complaint alleging infringement of the patent.” Additionally, 37 C.F.R. § 42.101(b) provides

that a petitioner may file a petition for *inter partes* review unless the “petition requesting the proceeding is filed more than one year after the date on which the petitioner, the petitioner’s real party-in-interest, or a privy of the petitioner is served with a complaint alleging infringement of the patent.”

In the current proceeding, the underlying district court complaints were filed on December 30, 2013. Patent Owner represents that “Petitioners were each served with the complaints and summonses on January 16, 2014.” Mot. 1. The Petition in this proceeding was filed on December 31, 2014, and accorded a filing date of December 31, 2014. Papers 1, 6. Patent Owner’s Preliminary Response is due on April 29, 2015.

Petitioner states that Petitioner’s counsel served a copy of the Petition and supporting materials on Patent Owner’s litigation counsel of record on December 31, 2014. Opp. 1 ¶ 1. Email correspondence between Petitioner’s counsel and Patent Owner’s litigation counsel indicates that Patent Owner’s litigation counsel was in receipt of the documents at least as early as January 5, 2015. Ex. 1019, 1020. Also on December 31, 2014, Petitioner’s counsel served a copy of the Petition and supporting materials on the law firm of Thorpe, North & Western, which was the correspondence address of record for the patent at issue until October 17, 2014. Opp. 2 ¶ 3, 4. On October 30, 2014, the Law Office of Robert E. Purcell, PLLC became identified as the correspondence address of record for the patent at issue. Mot. 1 (citing Ex. 2003–2005). Petitioner’s counsel admits that he used petitions filed by Intel Corp. in August 2014 “as a reference in drafting the instant petition and certificate of service,” including the correspondence address for service. Ex. 1017 ¶ 10. As of the date of the Motion, Petitioner still had not served Patent Owner with a copy of the Petition at the current correspondence address of record. Mot. 1.

Analysis

Patent Owner argues that the Motion is not premature. Mot. 7. Petitioner does not oppose the Board addressing the improper service arguments at present. Opp. 1, n.1. Accordingly, we address the substantive arguments in the Motion and Opposition at this time.

Patent Owner argues that (A) the Petition is not entitled to a filing date at this time; and (B) Petitioner's failure to file a complete petition requires dismissal for failure to meet the one-year filing requirement.

Petitioner responds that (A) Petitioners effectively served Patent Owner before January 16, 2015; and (B) the circumstances of this case do not warrant changing the filing date or dismissal of the petition, because (1) Petitioners acted in good faith; and (2) Patent Owner cannot show any prejudice.

Based on the evidence presented, Petitioner has provided Patent Owner with copies of the required documents. Patent Owner states that Petitioner "served a 'courtesy copy' [of the instant petition] on the Patent Owner's patent infringement litigation counsel" on December 31, 2014. Mot. 1. Petitioner states that on "December 31, 2014, Petitioner's counsel served by email a copy of the petition and supporting materials on Patent Owner's litigation counsel of record, including Mr. Anton Handal." Opp. 1 ¶ 1 (citing Ex. 1017 ¶¶ 4-5). The statute requires only that a petitioner provide copies of the required documents "to the patent owner or, if applicable, the designated representative of the patent owner." 35 U.S.C. § 312(a)(5). The parties appear to agree, and the evidence supports, that Petitioner provided copies of the required documents to a designated representative of Patent Owner in a timely manner. Thus, the statutory requirement has been met.

We agree with Patent Owner that Petitioner's service of the Petition and supporting documents to the firm of Thorpe, North & Western failed to comply

with 37 C.F.R. § 42.105(a). 37 C.F.R. § 42.105(a) specifies that “[t]he petition and supporting evidence must be served on the patent owner at the correspondence address of record for the subject patent.” The correspondence address of record for a patent can be discovered simply by entering the number of the patent into the USPTO’s web-based Patent Application Information Retrieval (PAIR) portal (<http://portal.uspto.gov/pair/PublicPair>). Petitioner admits that, rather than serving the address of record for U.S. Patent No. 5,839,108, it served Patent Owner’s former counsel of record, as listed on *inter partes* review petitions filed by Intel Corp. Opp. 2 ¶ 3. Relying on the notice of service attached to an earlier petition filed by another party in lieu of consulting the Patent Office database to determine the correspondence address of record is not a good faith attempt to comply with Rule 42.105(a).¹

Petitioner’s effective service of the Petition and supporting documents on the Patent Owner through its litigation counsel, however, is undisputed. Because Petitioner has complied with 35 U.S.C. § 312(a)(5); because counsel participating in this proceeding on behalf of Patent Owner actually received the Petition prior to the expiration of the one-year bar set forth in 35 U.S.C. § 315(b); and because Patent Owner does not allege that its time to respond to the Petition or its access to evidence has been affected meaningfully by Petitioner’s failure to comply, the

¹ One example of a good faith attempt to comply with our rules is relying on out-of-date information in the Patent Office database and working diligently to effect service once that information is discovered to be incorrect. *See Synopsys, Inc. v. Mentor Graphics Corp.*, Case IPR2012-00042, slip op. at 2–4 (PTAB Apr. 11, 2013) (Paper 23). As another example, a good faith attempt to comply with our rules is mailing a Petition to the correct address using Federal Express®, rather than Express Mail®, yet failing to choose Saturday delivery. *See Facebook, Inc. v. Rembrandt Social Media, L.P.*, Case IPR2014-00415, slip op. 6–7 (PTAB July 7, 2014) (Paper 9).

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remedy Patent Owner seeks (effectively, dismissal of the Petition with no opportunity to re-file) is out of proportion to Petitioner's rule violation. Accordingly, on that basis, we exercise our discretion under 37 C.F.R. § 42.5(b) to waive the requirement of Rule 42.105(a) and deny Patent Owner's motion. Moreover, on these facts, we do not see any need to change the December 31, 2014, filing date accorded to the Petition. Paper 6. Petitioner, however, must comply with the Board's procedural rules for the remainder of this proceeding.

Accordingly, it is

ORDERED that Patent Owner's Motion is *denied*.

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