

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ZHEJIANG YANKON GROUP, LTD.,  
Petitioner,

v.

CORDELIA LIGHTING, INC.,  
Patent Owner.

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Case IPR2015-01420  
Patent 8,454,204 B1

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Before LORA M. GREEN, JONI Y. CHANG, and  
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

HARLOW, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

## I. INTRODUCTION

Petitioner, Zhejiang Yankon Group, LTD. (“Yankon-China”), filed a Petition requesting *inter partes* review of claims 1–20 of U.S. Patent No. 8,454,204 (Ex. 1001, “the ’204 patent”). Paper 1 (“Pet.”). Patent Owner, Cordelia Lighting, Inc. (“Cordelia”) timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). In its Preliminary Response, Cordelia alleged that Yankon Industries, Inc. (“Yankon-US”), as well as Lowe’s Companies, Inc. and Lowe’s Home Centers, LLC (collectively, “Lowe’s”) should have been identified as real parties-in-interest in the Petition, pursuant to 35 U.S.C. § 312(a)(2). Prelim. Resp. 4–22.

In view of Cordelia’s allegations, we *sua sponte* authorized Yankon-China to submit briefing and evidence (exclusive of new testimony) addressing the real party-in-interest issues raised in the Preliminary Response. Paper 7. Yankon-China subsequently filed a Brief on Real Parties in Interest in Response to Paper 7, (Paper 8 (“Reply”)), and provided additional excerpts from depositions cited in Cordelia’s Preliminary Response, (Exs. 1014–1016), which we have reviewed. Yankon-China did not submit any documentary, or other non-testimonial evidence, with its Reply.

Section 312 of Title 35 of the United States Code establishes the requirements for a petition seeking *inter partes* review of an issued patent. Section 312 states, in relevant part, that a petition “may be considered only if— . . . (2) the petition identifies *all* real parties in interest.” 35 U.S.C. § 312(a)(2) (emphasis added). Upon consideration of the totality of the

circumstances, we are persuaded that Yankon-China should have identified Yankon-US as a real party-in-interest in the Petition, as required by 35 U.S.C. § 312(a)(2). We, therefore, deny the Petition.

*A. Related Matters*

The parties indicate that the '204 patent was asserted in a district court case captioned *Cordelia Lighting, Inc. v. Zhejiang Yankon Group Co., Ltd. et al.*, No. 5:14-cv-00881-JGB-SP (C.D. Cal.). Paper 5, 2; Pet. 2; Ex. 1004.<sup>1</sup> Yankon-China, Yankon-US, Wei Chen, and Lowe's are named as defendants in that suit. Ex. 1004. On April 27, 2015, the district court issued a preliminary injunction against defendants, currently in force against Yankon-China and Yankon-US (collectively, the "Yankon entities").<sup>2</sup> Paper 5, 2; Ex. 2011. The district court litigation has been stayed pending resolution of this *inter partes* review. Prelim. Resp. 4.

On May 26, 2015, the Yankon entities appealed the preliminary injunction to the United States Court of Appeals for the Federal Circuit, in an appeal captioned *Cordelia Lighting, Inc. v. Zhejiang Yankon Group Co.*,

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<sup>1</sup> Petitioner's statement that "[t]he '204 Patent is the subject of a patent infringement lawsuit brought by Cordelia Lighting, Inc. in the Central District of Florida," appears to be an inadvertent error, as Petitioner's Exhibit 1004 correctly identifies the Central District of California as the situs of the infringement suit.

<sup>2</sup> Subsequent to entry of the injunction, the district court clarified that "Lowe's was not enjoined" by the preliminary injunction. Ex. 2015, A18 n.3.

*Ltd., et al.*, No. 15-1698 (Fed. Cir.). Paper 5, 2; Ex. 2015, 2. The Yankon entities' appeal of the preliminary injunction remains pending.

*B. Factual Background*

Yankon-China manufactures and sells recessed lighting fixtures. Ex. 2015, 4, 6. Yankon-China sells products in the United States directly to customers, and via Yankon-US, a wholly owned subsidiary. Ex. 1014, 33:1–10; Ex. 2006. Yankon-US in turn sells lighting fixtures, doing business as Energetic Lighting. Ex. 1015, 48:7–10, 45:3–8; Ex. 2008, 24:9–15, 25:18–24. Lowe's has sold lighting fixtures manufactured by Yankon-China. Ex. 1015, 42:5–12. However, subsequent to the district court's entry of an injunction against Yankon-China and Yankon-US, Lowe's has agreed to discontinue sales of products accused of infringing the '204 patent. Ex. 2012, 2.

Yankon-US has participated in patent licensing and sales negotiations related to the '204 patent and products accused of infringing that patent. For example, even though it allegedly does not sell the products accused of infringing the '204 patent, (Ex. 1014, 33:11–23), Yankon-US “was involved in the sales negotiation[s]” for at least one of the accused products, (*id.* at 35:4–10). Moreover, Michael Dellatorre, the General Sales Manager for Energetic Lighting, a trade name for Yankon-US, was responsible for “reach[ing] out to Cordelia to see if there was a way of working with

Cordelia with [the '204] patent.” Ex. 1015, 86:17–23; *see also id.* at 42:25–43:5.<sup>3</sup>

In email correspondence sent to Cordelia, identifying as its subject “Patent Discussion – Energetic Lighting,” Mr. Dellatorre wrote, “Energetic Lighting is interested in furthering talks with you to see if we can establish an agreement for the use of certain aspects of this patent. We are willing to negotiate with you or if you are interested in selling said patent.” Ex. 2014, CL000652. This email, as well as two follow-up messages, identified Mr. Dellatorre as the General Sales Manager for Energetic Lighting, and included David Liu, the General Manager of Yankon-US, as a recipient. *Id.* at CL000651–CL000652. One of Mr. Dellatorre’s emails to Cordelia included the statement “Energetic Lighting is a manufacturer of energy efficient bulbs, lamps and fixtures. Since 1975, we have grown to seven factories in three countries. Our North American headquarters is in Chino, California, 40 miles east of Los Angeles,” below his signature block. *Id.* at CL000651 (emphasis omitted).

During deposition, Mr. Dellatorre indicated that he also discussed the '204 patent telephonically with Cordelia. Ex. 1015, 122:3–6 (“I introduced myself and told him that we were in – we know you have this patent, we

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<sup>3</sup> We note that Petitioner has redacted, without explanation, the top portion of page 86 of Exhibit 1015, which appears to relate to testimony from Mr. Dellatorre regarding instructions that he “solve the patent issue.” Ex. 1015, 86:17–18. Additional unexplained redactions appear at pages 61 and 160 of Exhibit 1015.

were interested in talking to him further about the patent.”).<sup>4</sup> Testifying on behalf of Yankon-China as a corporate representative for patent licensing-related issues, Mr. Dellatorre stated that “I probably know as much as anybody else in the company on that also.” Ex. 1015, 74:14–16, 129:11–18.

Yankon-US and Yankon-China also exhibit operational and personnel overlap. For example, Wei Chen, the President of Yankon-US, is a high ranking executive within Yankon-China. Ex. 2008, 67:2–8 (identifying Mr. Chen as the “co-chairman or chairman of Yankon[-China]”). In addition, Mr. Chen owned Energetic Lighting prior to its sale to Yankon-US. Ex. 2007, 32:14–18, 33:6–24. David Liu, the General Manager of Yankon-US, reports to Yang Li, the General Manager of Yankon-China’s American business department. Ex. 1014, 31:3–22. Furthermore, Kai Zhao, the Vice President of Yankon-China’s American business department, and a direct report to Mr. Li, testified that although he does not “make decisions for Yankon[-US],” he nevertheless has “a certain degree of supervision over certain areas; for example, pricing.” Ex. 2009, 23:19–22, 24:6–20.

The Yankon entities have acted in unity throughout the district court and appellate actions. For example, the Yankon entities collectively filed an answer and counterclaims to Cordelia’s complaint. Ex. 2003. The Yankon entities also are represented by the same law firm, Sill Cummis & Gross, and

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<sup>4</sup> We note that Petitioner did not include the prior page of the deposition transcript, which appears to identify with whom Mr. Dellatorre spoke. However, it is clear from the subsequent testimony that Mr. Dellatorre’s testimony related to a telephonic conversation with Cordelia. Ex. 1015 122:13–123:16.

share the same lead counsel in the district court and appellate actions. That same firm and lead counsel represent Yankon-China in the instant *inter partes* review proceeding. Paper 2. Yankon-China has not provided evidence, such as the retention letter for the instant proceeding or invoices, to show, for example, that Yankon-China has paid all legal fees related to the instant *inter partes* review.

Lowe's bears no direct corporate relationship to the Yankon entities. Rather, Lowe's is an indemnitee of Yankon-China. Ex. 2010, 2. Moreover, "although Lowe's has informed Yankon[-China] of its indemnification rights to recover all of its costs, expenses and reimbursement, it has not made any formal demand for the costs associated with the stop order of its 1,722 U.S. stores." *Id.*

Lowe's was not named as a defendant in Cordelia's original complaint for patent infringement against the Yankon entities. Ex. 2002. Lowe's was not added to the suit until April 2015, nearly a year after the initial complaint. Ex. 2004. Lowe's does, however, share litigation counsel with the Yankon entities. Ex. 1004, 4. In addition, Lowe's joined the Yankon entities and Mr. Wei in filing a consolidated motion seeking to stay the district court action pending the *inter partes* review proceeding. Ex. 2013. Although it has agreed to refrain from selling the accused products while the preliminary injunction against the Yankon entities remains in force, Lowe's itself is not subject to that injunction, and is not party to the appellate proceedings concerning that injunction. Ex. 2012, 2; Ex. 2015, 4-5, A18 n.3.

## II. ANALYSIS

### A. Burden

Under 35 U.S.C. § 312(a)(2), a petition must identify all real parties-in-interest. Although we generally accept the petitioner's identification of real parties-in-interest at the time of filing the petition, this acceptance reflects a rebuttable presumption inuring to the petitioner's benefit; it does not shift the burden of persuasion. *Zerto, Inc. v. EMC Corp.*, Case IPR2014-01254 (PTAB Feb. 12, 2015) (Paper 32).

"[T]he party against whom a presumption is directed has the burden of producing evidence to rebut the presumption. *But this rule does not shift the burden of persuasion, which remains on the party who had it originally.*" Fed. R. Evid. 301 (emphasis added).<sup>5</sup> Where, as here, a patent owner presents evidence that reasonably brings into question the accuracy of a petitioner's identification of the real parties-in-interest, the petitioner alone bears the burden of establishing that it has complied with the statutory requirement to identify all the real parties-in-interest. *Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.*, Case IPR2013-00453, slip op. at 8 (PTAB Jan. 6, 2015) (Paper 88).

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<sup>5</sup> With few exceptions, not pertinent here, we have adopted the Federal Rules of Evidence as applying to *inter partes* review proceedings. 37 C.F.R. § 42.62(a).

*B. Principles of Law*

“Whether a party who is not a named participant in a given proceeding nonetheless constitutes a ‘real party-in-interest’ . . . to that proceeding is a highly fact-dependent question.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012) (“Trial Practice Guide”). “Courts invoke the terms ‘real party-in-interest’ and ‘privy’ to describe relationships and considerations sufficient to justify applying conventional principles of estoppel and preclusion.” *Id.*

The framework described in *Taylor v. Sturgell*, 553 U.S. 880 (2008), informs this determination. *Id.* In *Taylor*, the Supreme Court identified six categories of exceptions to the common law rule forbidding non-party preclusion in litigation: (1) whether the non-party agrees to be bound by the determination of issues in the proceeding; (2) whether a pre-existing substantive legal relationship with the party named in the proceeding justifies binding the non-party; (3) “in certain limited circumstances,” whether the non-party is adequately represented by someone with the same interests; (4) whether the non-party exercised or could have exercised control over the proceeding; (5) whether the non-party is bound by a prior decision and is attempting to rehear the matter through a proxy; and (6) whether a statutory scheme forecloses successive hearing by non-parties. 553 U.S. at 893–95. The Court noted, however, that this list “is meant only to provide a framework . . ., not to establish a definitive taxonomy.” *Id.* at 893 n.6.

Whether the non-party exercised or could have exercised control over the proceeding, is a common focus of inquiry in *inter partes* review proceedings. But “[c]ourts and commentators agree . . . that there is no bright-line test for determining the necessary quantity or degree of participation to qualify as a ‘real party-in-interest’ . . . based on the control concept.” Trial Practice Guide at 48,759 (citing *Gonzalez v. Banco Cent. Corp.*, 27 F.3d 751, 759 (1st Cir. 1994)). A non-party’s participation may be overt or covert, and the evidence may be circumstantial, but the evidence, as a whole, must show that the third party possessed effective control from a practical standpoint. *See Gonzalez*, 27 F.3d at 759. This inquiry is not based on isolated facts, but rather must consider the totality of the circumstances. *Id.*

### *C. The Parties’ Contentions*

In its Petition, Yankon-China identifies itself as the sole real party-in-interest. Pet. 2. In its Preliminary Response, Cordelia asserts that Yankon-China’s failure to identify either Yankon-US or Lowe’s as a real parties-in-interest is fatal to the Petition. Prelim. Resp. 4–22.

Cordelia argues that the corporate relationship between Yankon-China and Yankon-US has been blurred to the point that it is not possible to determine where one entity ends and the other begins. *Id.* at 15. Cordelia further contends that Yankon-US has exercised, or could have exercised, control over this Petition. *Id.* at 15–16. Concerning Lowe’s, Cordelia asserts that as indemnitees and co-defendants in the district court litigation,

Lowe's' interests are aligned with Yankon-China's, and Lowe's is, therefore, a real party-in-interest to this Petition. *Id.* at 19–20. Cordelia also argues that Lowe's desires to invalidate the '204 patent so it can resume sale of the accused devices. *Id.* at 21.

Pointing to the June 18, 2014 service of its complaint for patent infringement on the Yankon entities, Cordelia contends that Yankon-China cannot now correct its Petition to name either Yankon-US or Lowe's as real parties-in-interest, because the earliest filing date that could be according would fall outside of the period specified by 35 U.S.C. § 315(b). *Id.* at 22 (citing Ex. 1004, 7; *Zoll*, Case IPR2013-00606, slip op. at 16–17, 17 n. 2 (Paper 15); *Atlanta Gas*, Case IPR2013-00453, slip op. at 14 (Paper 88)).

In its Reply, Yankon-China contends that as a subsidiary, Yankon-US lacks effective control over Yankon-China, and, therefore, is not a real party-in-interest. Reply 1 (citing *TRW Automotive U.S. LLC v. Magna Electronics Inc.*, Case IPR2014-01346 (PTAB Feb. 20, 2015) (Paper 7)). Yankon-China further asserts that Yankon-US has no real interest in the Petition because it allegedly has not made or sold the products accused of infringement in the district court litigation. *Id.* at 2 (citing Ex. 1014, 33–35; Ex. 1015, 11, 42–45, 49, 66, 186; Ex. 1016, 22, 24, 53). Yankon-China also states that Energetic Lighting is a trade name for Yankon-US only. Reply 3–4 (citing Ex. 1014, 100).

Yankon-China argues that it and Yankon-US operate as separate entities. Yankon-China points out that Yankon-US purchases products from Yankon-China, collects payments from customers, and records its own

profits and losses. Reply 2–3 (citing Ex. 1015, 48, 60–61). Moreover, Yankon-China disputes that the activities of Mr. Chen and Mr. Dellatorre are indicative of corporate blurring. Yankon-China insists that Mr. Chen’s role as President of Yankon-US is merely ceremonial, Reply 2–3 (citing Ex. 1015, 68, 74–75; Ex. 1016, 9),<sup>6</sup> and that Mr. Dellatorre’s involvement in licensing discussions with Cordelia was circumscribed, *id.* at 3 (citing Ex. 1015, 86, 122–23, 159–60). Petitioner also contends that Mr. Dellatorre’s designation as a corporate representative for Yankon-China for licensing issues is irrelevant. *Id.* (citing Ex. 1015, 74, 129).

Regarding Lowe’s, Yankon-China asserts that there is no legal basis for finding that a retailer is a real party-in-interest to a petition filed by a separate and distinct product manufacturer. Reply 4–5. Additionally, Yankon-China states that Lowe’s has voluntarily stopped selling the products accused in the district court litigation, and that it has no intention of resuming such sales. *Id.* at 4.

*D. Yankon-China Has Not Satisfied Its Burden of Identifying  
All Real Parties-in-Interest in Its Petition*

Having reviewed the evidence presented by Yankon-China and Cordelia, we conclude that Yankon-China has not carried its burden of identifying all real parties-in-interest, as mandated by 35 U.S.C. § 312(a)(2).

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<sup>6</sup> Yankon-China’s Reply refers to deposition testimony concerning a “Yankon U.S. organizational chart [that] shows David Liu in charge of Yankon U.S.,” Reply 2, but no such chart has been submitted as evidence in this proceeding.

*i. Yankon-US*

Yankon-China contends that, as a subsidiary, Yankon-US cannot exercise control over Yankon-China, and therefore Yankon-US is not a real party-in-interest to the Petition. Reply 1. However, the relevant inquiry here is whether the non-party exercised or could have exercised control over *the instant proceeding*. It is not whether Yankon-US controls Yankon-China, but rather, the nature of Yankon-US's relationship to this *inter partes* review proceeding, and the degree of control Yankon-US can exert over the proceeding. *See, e.g., Amazon.com, Inc. et al. v. Appistry, Inc.*, Case IPR2015-00480, slip op. at 6 (PTAB July 13, 2015) (Paper 18) (“[T]he close corporate relationship between Amazon.com and AWS strongly suggests that ADS and AWSHC, the subsidiary companies in the chain of corporate ownership between Amazon.com and AWS, are involved and controlling corporations representing the unified interests of themselves and Petitioner.”); *Medtronic, Inc. v. Robert Bosch Healthcare Systems, Inc.*, Cases IPR2014-00488, IPR2014-00607, slip op. at 16 (PTAB Mar. 16, 2015) (Paper 52) (“assessing the totality of the evidence, they demonstrate that [the subsidiary] is the party with the substantive interest that desires review of the ’605 and ’249 patents, and that [the parent] is acting as a proxy for [the subsidiary]”). As discussed below, the totality of factual evidence in this record indicates that Yankon-US, a non-party, had the opportunity to exercise control over *this proceeding*. Accordingly, we conclude that Yankon-China has not met its burden of establishing that it is the only real party-in-interest to the Petition.

The role of Yankon-US in negotiations for the purchase or licensing of the '204 patent, as well as for the sale of products accused of infringing that patent suggests that Yankon-US had the opportunity to control this *inter partes* review proceeding. Yankon-US participated in sales negotiations for at least one of the products accused of infringing the '204 patent (Ex. 1014, 35:4–10), even though it allegedly never sold that product (*id.* at 33:11–23). Furthermore, the evidence of record shows that Mr. Dellatorre of Energetic Lighting was the sole point of contact for telephonic and written communications with Cordelia concerning the '204 patent, and that he represented to Cordelia that Energetic Lighting wished to negotiate rights to that patent. Ex. 2014; Ex. 1015, 122:3–6. In correspondence to Cordelia, Mr. Dellatorre represented that “Energetic Lighting is interested in furthering talks with you to see if we can establish an agreement for the use of certain aspects of [the '204] patent. We are willing to negotiate with you or if you are interested in selling said patent.” Ex. 2014, CL000652.

The only Yankon employee included on Mr. Dellatorre’s correspondence to Cordelia was Mr. Liu of Yankon-US. Ex. 2014. No evidence has been presented suggesting that Mr. Dellatorre ever drew a distinction between Yankon-US or Energetic Lighting on the one hand, and Yankon-China on the other during his dealings with Cordelia. Rather, the evidence supports the conclusion that Yankon-US led discussions with Cordelia concerning the '204 patent. *See Atlanta Gas*, Case IPR2013-00453, slip op. at 9–10 (Paper 88) (finding negotiations conducted by employee of non-party “at least partially on behalf of [Petitioner,]” and use

of non-parties' letterhead supported the conclusion that the non-party was a real party-in-interest to Petition).

Yankon-China's selection of Mr. Dellatorre as its corporate representative for licensing topics, including "[a]ny patent license agreements and proposed license agreements whether executed or not ultimately executed related to any knowledge of the accused products" (Ex. 1015, 129:11–18), combined with Mr. Dellatorre's testimony that he "probably know[s] as much as anybody else in the company on that" (*id.* at 74:14–16), underscores the prominent role of Yankon-US concerning the Yankon entities' patent-related activities in general, and the '204 patent in particular.

Mr. Chen's current leadership roles in Yankon-China and Yankon-US, as well as his prior ownership of Energetic Lighting, provide further support for the conclusion that Yankon-US could have exercised control over this proceeding. Ex. 2008, 67:2–8; Ex. 2007, 32:14–18, 33:6–24. In response to a question concerning whether Mr. Chen does day-to-day work as President of Yankon-US, or performs a more ceremonial role, Mr. Dellatorre testified that it is "a hard answer, but I would have to say I tend to lean towards a ceremonial role." Ex. 1015, 68:6–10. This response, however, does little to mitigate the fact that as the named President of Yankon-US, Mr. Chen had the opportunity to exercise control over this proceeding on behalf of Yankon-US.<sup>7</sup> *See Galderma S.A. v. Allergan*

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<sup>7</sup> We note that Yankon-China references an alleged Yankon-US

*Industrie*, Case IPR2014-01422, slip op. at 12 (PTAB Mar. 5, 2015) (Paper 14) (“As President and CEO of both parent and subsidiary, Mr. Antunes wields a significant degree of effective control over the present matter. We need not consider whether Mr. Antunes did or did not, directly or indirectly, exercise this control.”).

Whether or not Yankon-US sells the products accused infringement in the district court litigation is insufficient to overcome the evidence in this record, as a whole, showing Yankon-US possessed effective control over this proceeding from a practical standpoint. Indeed, when considered in view of Yankon-US’s involvement in sales negotiations for at least one of the accused products, (Ex. 1014, 35:4–10), and Mr. Dellatorre’s role in negotiations for rights to the ’204 patent, (Ex. 2014; Ex. 1015, 122:3–6), that Yankon-US may not itself have sold the accused products indicates that Yankon-US exercises control over patent and sales related activities not only for itself, but also for Yankon-China. Evidence of the purchase of products from Yankon-China by Yankon-US, receipt of payments directly from customers, and independent bookkeeping is inadequate to overcome the countervailing evidence of Yankon-US’s opportunity to control this proceeding described above.

The Yankon entities unified conduct with respect to the litigation over the ’204 patent also supports the conclusion that Yankon-US had the opportunity to control this *inter partes* review. Yankon-China shares

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organizational chart in its Reply, but that Yankon-China has not produced that chart for our consideration in these proceedings. *See* Reply 3.

counsel, and has acted in unison with Yankon-US throughout the district and appellate court proceedings. *See, e.g.*, Ex. 2003; Ex. 2015. The same counsel represents Yankon-China in this proceeding. Paper 2. Nevertheless, despite our invitation, Yankon-China has not presented any evidence, such as the retention letter for the instant proceedings or invoices, to show that Yankon-China alone authorized and funded the Petition.

Indeed, Yankon-China did not itself request authorization to submit argument or evidence in reply to Cordelia's allegations concerning Yankon-US's status as a real party-in-interest to this proceeding. It was not until we *sua sponte* issued an order urging Yankon-China to respond to Cordelia's contentions, and inviting the submission of evidence (other than new testimony) that Yankon-China filed its Reply and Exhibits excerpting (in some cases redacted) portions of Mr. Dellatorre's, Mr. Zhao's, and Mr. Lu's depositions, which we have considered.

Additionally, although Yankon-China proffered, in a footnote, that had we allowed it, Yankon-China would have presented new testimony that Yankon-US did not authorize, fund, or draft the Petition, at no point prior to the filing of its Reply did Yankon-China request a conference, or otherwise seek leave to submit such evidence. Neither did Yankon-China come forward with non-testimonial evidence, such as invoices or retention letters, to support its proffer. Accordingly, we do not find Yankon-China's proffer persuasive.

Because Cordelia provides sufficient rebuttal evidence that reasonably brings into question the accuracy of Yankon-China's identification of real

parties-in-interest, the burden remains with Yankon-China to establish that it has complied with the statutory requirement to identify all real parties-in-interest. *See supra* Section II.A. Despite its burden of persuasion, which arises “from the fact that a petitioner is far more likely to be in possession of, or to have access to, evidence relevant to the issue than is a patent owner,” *Atlanta Gas*, Case IPR2013-00453, slip op. at 8 (Paper 88), Yankon-China declined our invitation to submit documentary evidence showing that Yankon-US is not a real party-in-interest to this proceeding, and did not seek leave to file new testimonial evidence in support of its position.

Accordingly, in view of the totality of the factual evidence of record showing that Yankon-US could have exercised control over this *inter partes* review proceeding, we are not persuaded that Yankon-China has satisfied its burden of identifying all real parties-in-interest in the Petition, as required by 35 U.S.C. § 312(a)(2). Specifically, Petitioner has not persuaded us that the Petition need not have identified Yankon-US as a real party-in-interest.

*ii. Lowe’s*

In contrast to Yankon-US, the evidence of record does not support the conclusion that Lowe’s should have been identified as a real party-in-interest to the Petition. Lowe’s status as an indemnitee of Yankon-China and co-defendant sharing counsel in the district court litigation for infringement of the ’204 patent, without more, is insufficient to confer status as a real party-in-interest to Yankon-China’s petition. *See, e.g., Syntroleum v. Neste Oil Oyj*, Case IPR2013-00178, slip op. at 7 (Paper 22) (sharing of counsel in co-

pending litigation and existence of “indemnification agreement, without any evidence of the contractual obligations of the parties” does not establish requisite control). Similarly, Lowe’s business interest in invalidating the ’204 patent does not establish Lowe’s as a real party-in-interest to the Petition.

*E. Corrected Petition Would Be Time-Barred*

The Petition was accorded a filing date of June 16, 2015. Paper 3, 1. At this stage of the proceeding, correction of the Petition to include Yankon-US as a real party-in-interest would require assignment of a new filing date. *See* 37 C.F.R. § 42.106(b). Granting Yankon-US a new filing date would be futile in this instance because, even if corrected, the earliest filing date that could be accorded to the Petition would fall outside the one-year time bar for pursuing *inter partes* review set forth in 35 U.S.C. § 315(b).

III. ORDER

In consideration of the foregoing, it is  
ORDERED that the Petition is DENIED and no trial is instituted.

IPR2015-01420  
Patent 8,454,204 B1

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