

Service of the petition on patent owner's litigation counsel and assignment counsel sufficient in some cases

NOVEMBER 9, 2020

Intel Corp. v. PACT XPP Schweiz AG, IPR2020-00518, Paper 12 (PTAB Aug. 11, 2020); *Intel Corp. v. PACT XPP Schweiz AG*, IPR2020-00525, Paper 12 (PTAB Aug. 11, 2020); *Intel Corp. v. PACT XPP Schweiz AG*, IPR2020-00528, Paper 11 (PTAB Aug. 11, 2020); *Intel Corp. v. PACT XPP Schweiz AG*, IPR2020-00531, Paper 13 (PTAB Aug. 11, 2020); *Intel Corp. v. PACT XPP Schweiz AG*, IPR2020-00533, Paper 11 (PTAB Aug. 24, 2020); *Intel Corp. v. PACT XPP Schweiz AG*, IPR2020-00535, Paper 11 (PTAB Aug. 11, 2020)

Before: Ken B. Barrett, Charles J. Boudreau, Christopher L. Ogden.

Intel Corp. v. PACT XPP Schweiz AG, IPR2020-00539, Paper 11 (PTAB Sep. 10, 2020)

Before: Sally C. Medley, Ken B. Barrett, Christopher L. Ogden.

In this series of proceedings between the same parties, among other arguments, patent owner challenged the sufficiency of petitioner's service of the petitions. In each proceeding, the Board instituted trial over the patent owner's challenges.

In each proceeding, as of the § 315(b) one-year bar date, there was no power of attorney in the PTO database filed by patent owner, PACT XPP Schweiz AG. There was, however, a power of attorney in the PTO database filed by a predecessor-in-interest, a different PACT entity known as PACT XPP Technologies AG. But the attorney named in the predecessor's power of attorney was deceased. Rather than serve the deceased attorney, Petitioner contacted the attorney named as the designated correspondent in the agreement assigning the patents to the current PACT entity. The designated correspondent attorney initially agreed to service. But on the last day of the one-year bar date, three days after petitioner sent the service documents to the designated correspondent, the designated correspondent informed petitioner that he was not authorized to accept service. On that day, Petitioner also sent the service documents to patent owner's counsel in the parallel district court litigation. District Court counsel would go on to represent the patent owner in these IPR proceedings. Also, months later, the law firm of the designated correspondent was identified in the PTO database as the law firm of record for patent owner.

Under 37 C.F.R. § 42.105(a), "[t]he petition and supporting evidence must be served on the patent owner at the correspondence address of record;" but, "[t]he 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." The panel held this rule implies that service may be effected in ways other than using the correspondence of record for the patent. The rule

is moderately more restrictive than the service required by the patent statute. The patent statute requires that “the petitioner provides copies of [a complete petition and supporting evidence] to the patent owner or, if applicable, the designated representative of the patent owner.” 35 U.S.C. § 312(a)(5) (2018). The patent statute also requires that the petition provide sufficient notice to the patent owner of “each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” *Id.* § 312(a)(3).

In this case, there was no question that patent owner’s eventual IPR counsel and PTO counsel received the service documents. There was no dispute that patent owner actually received the petition before the expiration of the one-year bar. There was also no dispute that patent owner had not been prejudiced from the lack of notice. The Board first held that petitioner’s service attempts complied with the statutory requirements. The only question was whether petitioner had complied with the relevant patent office rule, 37 C.F.R. § 42.105(a). As to the rule, the Board held that in view of petitioner’s compliance with the statute, patent owner’s timely receipt of the petition, and the absence of evidence of prejudice to patent owner, a determination that the petition is time barred would be disproportionate to the harm associated with petitioner’s alleged non-compliance with the rule. Therefore, the Board held that petitioner had sufficiently shown that the petition was timely filed and was not time barred.

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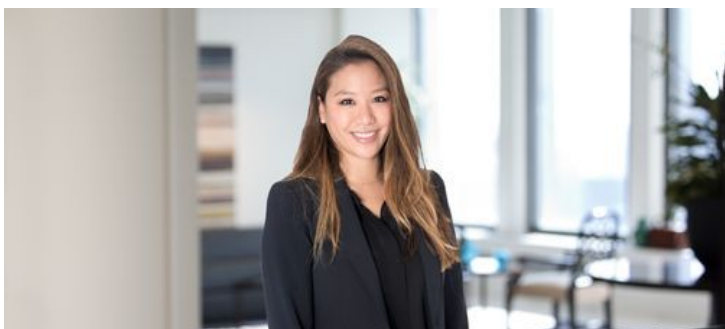
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