

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION AND HTC AMERICA, INC.,
Petitioner,

v.

JOE ANDREW SALAZAR,
Patent Owner.

Case IPR2018-00273
Patent 5,802,467

Before JAMESON LEE, MATTHEW J. McNEILL, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

Opinion for the Board filed by McNEILL, *Administrative Patent Judge*.

Opinion Dissenting filed by Lee, *Administrative Patent Judge*.

McNEILL, *Administrative Patent Judge*.

ORDER

Conduct of Proceeding
37 C.F.R. § 42.5(a)

On February 15, 2018, the Board received an email from Patent Owner requesting an extension of time to file Patent Owner's Preliminary Response, which is due March 12, 2018. Judges Lee, McNeill, and

Margolies conducted a conference call with counsel for the respective parties on February 22, 2018.¹

“A request for an extension of time must be supported by a showing of good cause.” 37 C.F.R. § 42.5(c)(2). During the conference call, Patent Owner’s counsel argued that Petitioner did not serve the instant Petition for *inter partes review* of U.S. Patent No. 5,802,467 (“the ’467 Patent”) on Patent Owner at the time the Petition was filed. Specifically, Patent Owner’s counsel argued that the assignment records for the ’467 Patent indicate the correspondent of record is J.A. Salazar, the current owner of the ’467 Patent. Patent Owner’s counsel contended that instead of serving Mr. Salazar at the address recorded with the USPTO in the assignment of the patent to Mr. Salazar (*see* Ex. 3001 (copy of printout from <https://portal.uspto.gov/pair/PublicPair>)) as required by 37 C.F.R. §42.105(a) (according to Patent Owner’s counsel), Petitioner served John DiMatteo, counsel for a prior owner of the ’467 Patent.

Patent Owner’s counsel also argued that Patent Owner only became aware of this matter when the Board contacted Patent Owner’s counsel on February 13, 2018 about Patent Owner’s failure to file a Mandatory Notice as required by 37 C.F.R. § 42.8. Patent Owner’s counsel argued Petitioner’s

¹ Jennifer Meredith and Sucheta Chitgopekar represent Patent Owner in this matter. Paper 5. During the conference call, Ms. Meredith requested that Darius Keyhani, counsel for Patent Owner in related litigation, be permitted to speak on behalf of Patent Owner because of his familiarity with the facts at issue. Ms. Meredith represented that Patent Owner intends to file a motion for *pro hac vice* admission of Mr. Keyhani. For the purposes of the call only, the Board allowed Mr. Keyhani to speak on behalf of Patent Owner. Patent Owner is directed to file a motion for *pro hac vice* admission of Mr. Keyhani within ten days of the issuance of this order.

failure to timely serve the Petition violates Patent Owner's due process rights and prejudices his ability to file a Preliminary Response. Patent Owner requests that we extend the deadline for the Preliminary Response to May 14, 2018, which is 90 days after Patent Owner became aware of the Petition on February 13, 2018.

During the conference call, counsel for Petitioner responded that Petitioner served the Petition on Mr. DiMatteo, who Petitioner asserted is the attorney of record at the USPTO. Petitioner's counsel argued that Petitioner first served Mr. DiMatteo at the "Correspondence Address" listed in the public Patent Application Information Retrieval (PAIR) database. *See* Ex. 3002 (copy of printout from <https://portal.uspto.gov/pair/PublicPair>). According to Petitioner's counsel, this address is no longer Mr. DiMatteo's current address, and Petitioner additionally served Mr. DiMatteo at his current address after learning this fact. Petitioner's counsel contended the file history for the '467 Patent does not have a revocation of Mr. DiMatteo's power of attorney, and no counsel that is registered to practice before the USPTO had made an appearance in the related litigation between the parties at the time the Petition was served.

Under 35 U.S.C. § 312(a)(5), a petitioner must provide a copy of the petition "to the patent owner or, if applicable, the designated representative of the patent owner." Rule 42.105(a) states 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 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." (emphasis added).

Petitioner served the Petition on Mr. DiMatteo. Although the law firm Sofer & Haroun is listed as the Attorney, Agent, or Firm on the face of the '467 Patent, Mr. DiMatteo is identified as the "Attorney/Agent" for the '467 Patent in the PAIR database. Ex. 3001. PAIR identifies an address for Mr. DiMatteo as the "Correspondence Address." *Id.* Patent Owner's argument that Rule 42.105(a) requires service on Mr. Salazar is unpersuasive because although Mr. Salazar is listed as a correspondent in an assignment of the '467 Patent (*see* Ex. 3002), Mr. DiMatteo is listed as the "Attorney/Agent" for the '467 Patent and his address is listed as the "Correspondence Address" for the '467 Patent (*see* Ex. 3001). Accordingly, Patent Owner fails to show that Petitioner violated 37 C.F.R. § 42.105(a) by serving Mr. DiMatteo.

Nonetheless, according to Patent Owner's counsel, Patent Owner did not become aware of the Petition until February 13, when the Board contacted Patent Owner's counsel in related litigation about Patent Owner's failure to file a Mandatory Notice. Patent Owner requests an extension of the deadline to file his Preliminary Response because of this delay in becoming aware of the Petition. Patent Owner's counsel argued that Patent Owner, an individual who is one of the named inventors listed on the face of the '467 Patent, would suffer substantial prejudice by having less than 30 days to prepare his Preliminary Response due to his limited resources.

Petitioner's counsel responded that granting the requested extension would prejudice Petitioner in the related litigation between the parties and prolong Patent Owner's ability to make public statements about the '467 Patent. Petitioner's counsel argued that the Petition relies on the same prior art and same expert testimony as the related litigation and Patent Owner,

therefore, would not be prejudiced by the original deadline for the optional Preliminary Response.

Under the particular facts of this case, we conclude that good cause supports a limited extension of the Preliminary Response deadline. Petitioner properly served Patent Owner at the correspondence address of record for the '467 Patent. However, that information apparently is outdated and is the address of the attorney of the prior owner of the patent. The assignment of the patent, which was recorded in January 2007 with the USPTO, lists the current owner of the patent—Mr. Salazar—and his address. Ex. 3001. Patent Owner asserts that he needs more time to prepare the Preliminary Response and Petitioner fails to identify any substantial prejudice in extending this proceeding by a month. Accordingly, under the particular facts of this case, we determine that granting Patent Owner a one-month extension (until April 12, 2018) to file a Preliminary Response is appropriate.

ORDER

Accordingly, it is

ORDERED that the deadline for Patent Owner's Preliminary Response shall be April 12, 2018; and

FURTHER ORDERED that Patent Owner shall file a motion for *pro hac vice* admission of Mr. Keyhani within ten days of this Order.

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LEE, *Administrative Patent Judge*, dissenting.

I disagree that Patent Owner has shown good cause for an extension of time to prepare its preliminary response. If the correspondence address in PAIR is incorrect or outdated, it is because Patent Owner did not timely update it. Patent Owner still has 27 days, from the time it actually learned of the Petition, to prepare a preliminary response. That is not an impossibly short period of time, given that the involved patent is in active litigation before a district court. Also, if trial eventually is instituted, Patent Owner will have a full opportunity to file a Patent Owner Response. Granting relief in this case diminishes the consequences of Patent Owner's not updating its correspondence address and encourages similar behavior of other patentees

in the future. The Board's administrative staff expended substantial effort to locate Patent Owner at an address that is not the correspondence address indicated in PAIR. That is a waste of the Board's resources, particularly if similar effort has to be expended in the future in connection with other patentees who do not update their correspondence address for whatever reason. Patent Owner further has not informed the Board that it has, since the time it became aware of the Petition, taken steps to ensure that the correspondence address shown in PAIR is correct and up to date.

PAIR clearly indicates, even as of March 5, 2018, the correspondence address for the '467 patent is "John M Dimatteo, PATTERSON BELKNAP WEBB & TYLER, 1133 Avenue of the Americas, New York NY 10036." Ex. 3001. That is who and where Petitioner served the Petition, in accordance with 37 C.F.R. § 42.105(a).

Insofar as the Assignment document also includes a correspondence address, it is not the "Correspondence Address" indicated in PAIR. Also, "[i]f more than one correspondence address is specified, the Office will select one of the specified addresses for use as the correspondence address and, if given, may select the address associated with a Customer Number over a typed correspondence address." 37 C.F.R. § 1.33. It is not reasonably disputable that the correspondence address for the '467 patent is "John M Dimatteo, PATTERSON BELKNAP WEBB & TYLER, 1133 Avenue of the Americas, New York NY 10036."

Patent Owner can have no valid complaint that Petitioner served the correspondence address of record, as indicated in PAIR. Petitioner need not do more than what is required. Patent Owner has not shown good cause for an extension of time, despite the fact that there does not appear to be

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substantial prejudice to Petitioner if some extension of time is granted. The lack of substantial prejudice to Petitioner should not become the driving factor for granting an extension of time to Patent Owner, where Patent Owner itself caused the delay in its being notified of the Petition and still has 27 days to complete a preliminary response.

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