

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

ATI TECHNOLOGIES ULC,
Patent Owner.

Case IPR2018-00560
Patent 7,633,506 B1

Before MARC S. HOFF, JONI Y. CHANG, and
BRIAN J. McNAMARA, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

VIZIO, Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–9 of U.S. Patent No. 7,633,506 B1 (Ex. 1001, “the ’506 patent”). Paper 1 (“Pet.”).

ATI Technologies, ULC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108. Upon consideration of the Petition and Preliminary Response, we conclude that the information presented does not show that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of any of claims 1-9 of the ’506 patent.

A. *Related Matters*

Petitioner notes that the ’506 patent is the subject of the following actions brought by Patent Owner against Petitioner that may affect or be affected by a decision in this proceeding: U.S. International Trade Commission (“ITC”) Inv. No. 337-TA-1044 (“ITC Investigation”) and U.S. District Court for District of Delaware Case No. 1:17-cv-00064.

Petitioner also states that the ’506 Patent is asserted against entities unrelated to VIZIO in the following actions: U.S. District Court for District of Delaware Case Nos. 1:17-cv-00063 and 1:17-cv-00065.

Petitioner also notes that entities unrelated to VIZIO have filed the following petitions for *inter partes* review of the ’506 Patent: IPR2017-01670, IPR2018-00101; and IPR2018-00102.

Petitioner further states that is concurrently filing a petition requesting *inter partes* review of several claims of U.S. Patent No. 7,796,133 (“the ’133 Patent”), which Patent Owner also has asserted in the ITC Investigation and in the U.S. District Court for District of Delaware Case No. 1:17-cv-00064.

II. DISCUSSION

IS THE PETITION TIME-BARRED?

If a party served with a complaint alleging patent infringement does not file a petition for *inter partes* review challenging the patent asserted in the complaint within one year, “*inter partes* review may not be instituted.” 35 U.S.C. § 315(b); *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 1374 (Fed. Cir. 2018)(en banc).

Petitioner states that it was served with a triggering complaint on February 1, 2017. Pet. 3. On February 7, 2017, counsel for Patent Owner filed an affidavit of service with the United States District Court for the District of Delaware, stating that Patent Owner mailed a notice of service, the Summons, and a copy of the Complaint to Petitioner on January 30, 2017. Ex. 2002, 1, 4.¹

The Federal Rules of Civil Procedure state that a corporation must be served “in a judicial district of the United States” “in the manner prescribed by Rule [4\(e\)\(1\)](#) for serving an individual.” Fed. R. Civ. P. 4(h)(1)(A); *see* Prelim. Resp. 3. Under Fed. R. Civ. P. 4(e)(1), service on an individual may be done by “following state law for serving a summons in an action

¹ The signed return receipt from VIZIO indicates that Petitioner received the package on February 1, 2017. Ex. 2002, 6.

brought in courts of general jurisdiction in the state where the district court is located” or where service is made. Fed. R. Civ. P. 4(e)(1); *see* Prelim. Resp. 3. Thus, in this matter, Petitioner could be served by following Delaware law.

Delaware law (the Delaware “long-arm statute”) states that service may be made “by any form of mail addressed to the person to be served and requiring a signed receipt.” 10 Del. C. § 3104(d)(3); *see* Prelim. Resp. 4. The Delaware Rules of Civil Procedure provide that

[w]henver under these Rules service is required or permitted to be made upon a party represented by an attorney the service shall be made upon the attorney unless service upon the party personally is ordered by the Court. Service upon the attorney or upon a party shall be made by delivering a copy to the attorney or party or by mailing it to the attorney or party at the attorney's or party's last known address *Service by mail is complete upon mailing.*

Del. R. Civ. P. 5(b) (emphasis added); *see* Prelim. Resp. 4. Patent Owner argues that this Rule is consistent with the Delaware long-arm statute’s provision that

[i]f service is made pursuant to paragraph (d)(3) of this section (i.e., “by any form of mail addressed to the person to be served and requiring a signed receipt”), the time in which defendant shall serve an answer *shall be computed from the date of the mailing* which is the subject of the return receipt or other official proof of delivery.

10 Del. C. § 3104(g); Prelim. Resp. 4.

Delaware Rule of Civil Procedure 12(a) states that an answer must be served “within 20 days after service of process.” Del. R. Civ. P. 12(a). We agree with Patent Owner’s argument that, in order for the answer deadlines

specified in Rule 12(a) and in the Delaware long-arm statute to reconcile, service of process must be considered complete upon a mailing that is compliant with § 3104(d)(3). Prelim. Resp. 4.

Applying the Delaware statutes and rules regarding service to the facts of this case, Patent Owner served Petitioner with a copy of the summons and complaint, in compliance with § 3104, with a date of mailing of January 30, 2017. Petitioner filed the instant petition for *inter partes* review on February 1, 2018, which is more than one year after Petitioner was served with a complaint alleging infringement of the '506 Patent. Accordingly, Petitioner's petition is time-barred under § 315(b) and *inter partes* review may not be instituted.

III. CONCLUSION

Under 35 U.S.C. § 315(b), *inter partes* review of the '506 patent may not be instituted, because the petition for review was filed more than one year after Petitioner was served with a complaint alleging infringement of the '506 patent.

IV. ORDER

In consideration of the above, it is
ORDERED that the Petition is denied as to all challenged claims, and no trial is instituted.

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