

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IKO INDUSTRIES, INC. and IKO INDUSTRIES LTD.,
Petitioner,

v.

KIRSCH RESEARCH AND DEVELOPMENT, LLC,
Patent Owner.

IPR2022-00416
Patent 6,308,482 B1

Before CHARLES J. BOUDREAU, JOHN D. HAMANN, and
AARON W. MOORE, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 315(b)

I. INTRODUCTION

On January 7, 2022, IKO Industries, Inc. and IKO Industries Ltd. (collectively, “Petitioner” or “IKO”) filed a Petition (Paper 1, “Pet.”) seeking *inter partes* review of claims 1–34 of U.S. Patent No. 6,308,482 B1 (Ex. 1001, “the ’482 patent”). Kirsch Research and Development, LLC (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”).

Section 315(b) of Title 35 of the United States Code provides that “[a]n 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, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent” and that “[t]he time limitation set forth in the preceding sentence shall not apply to a request for joinder” under 35 U.S.C. § 315(c).

Upon consideration of the information presented in the Petition and Preliminary Response, we determine that Petitioner’s challenge to the ’482 patent is barred under 35 U.S.C. § 315(b) as a result of Petitioner IKO Industries, Inc. and an additionally named real party in interest each having been served with complaints for infringement of the ’482 patent more than one year before the filing of the Petition. Accordingly, we deny the Petition and do not institute an *inter partes* review.

II. BACKGROUND

A. *Real Parties in Interest*

Petitioner identifies IKO Industries, Inc., IKO Industries Ltd., and Tarco Specialty Products, Inc. (“Tarco”) as real parties in interest for Petitioner. Pet. 72. Patent Owner identifies Kirsch Research and Development, LLC as the real party in interest for Patent Owner. Paper 5 (Patent Owner’s Mandatory Notices), 1.

B. Related Matters

Petitioner represents:

The '482 patent is currently the subject of several patent infringement lawsuits, including two suits filed on April 24, 2020 in the U.S. District Court for the Western District of Texas, by Patent Owner against IKO, styled as: *Kirsch Research and Development LLC v. IKO Industries Inc. et al.*, Civil Action No. 6-20-cv-00317 [hereinafter, the "IKO lawsuit"]; and Tarco, styled as: *Kirsch Research and Development LLC v. Tarco Specialty Products, Inc.*, Civil Action No. 6-20-cv-00318 [hereinafter, the "Tarco lawsuit"].

Pet. 72–73. Patent Owner identifies the IKO and Tarco lawsuits, among other related matters. Paper 5, 1–2. We further note that the '482 patent also is the subject of an *inter partes* review currently pending before the Board in *GAF Materials LLC v. Kirsch Research and Development, LLC*, IPR2021-00192, and was the subject of prior proceedings before the Board in IPR2020-01389 (terminated November 15, 2021), IPR2021-01181 (terminated November 17, 2021), and IPR2021-01183 (terminated November 23, 2021).

III. DISCUSSION

Patent Owner argues that Petitioner is barred under 35 U.S.C. § 315(b) from requesting *inter partes* review of the '482 patent based on the Petition having been filed more than one year after the dates on which Petitioner and real party in interest Tarco were served with complaints alleging infringement of the '482 patent. Prelim. Resp. 1–5. In support of its arguments, Patent Owner provides copies of the complaints from the IKO and Tarco lawsuits (Exhibits 2001 and 2002, respectively); proof of service of IKO Industries, Inc. in the IKO lawsuit on April 30, 2020 (Exhibit 2003); waiver of service by IKO Industries Ltd. in the IKO lawsuit, signed on

May 18, 2020 (Exhibit 2004); and proof of service of Tarco in the Tarco lawsuit on April 29, 2020 (Exhibit 2005). Patent Owner contends that the Petition does not address § 315(b) but contains only “a single sentence that merely asserts, with nothing more, that ‘Petitioner certify the ’482 patent is available for *inter partes* review and Petitioner is not barred or estopped from requesting *inter partes* review challenging the patent claims on the grounds identified herein’”; that “[t]he Petition does not dispute that IKO and Tarco were properly served with a complaint alleging infringement of the ’482 patent in April 2020, thus barring the present Petition from being instituted”; that “it is undisputed that their respective litigations have proceeded through claim construction”; and that “[n]othing in the Petition provides any facts or reasons as to why the current Petition for *inter partes* review of the ’482 patent should not be barred under 35 U.S.C. § 315.” Prelim. Resp. 3–4 (quoting Pet. 2).

We agree with Patent Owner. Despite Petitioner’s “certif[ication],” quoted by Patent Owner in the Preliminary Response, that “Petitioner is not barred or estopped from requesting *inter partes* review challenging the patent claims on the grounds identified herein” (Pet. 2), the uncontroverted evidence before us demonstrates otherwise. As Patent Owner points out, the January 7, 2022, filing date of the Petition is more than twenty months after both Petitioner IKO Industries, Inc. and real party in interest Tarco were served in the IKO and Tarco lawsuits, respectively. *See* Exs. 2003, 2005.¹

¹ The filing date of the Petition is also more than nineteen months after Petitioner IKO Industries Ltd. waived service of the complaint in the IKO lawsuit. Ex. 2004. Because the service of each of Petitioner IKO Industries, Inc. and real party in interest Tarco bars institution under § 315(b), we need not additionally reach Petitioner IKO Industries Ltd.’s waiver of service.

Moreover, as Patent Owner also points out (Prelim. Resp. 4), although the Petition represents that its asserted grounds “mirror the grounds recited in an IPR petition filed by Owens Corning Roofing & Asphalt, LLC against the ’482 patent, in IPR2020-01389, on which bases the Board issued a decision instituting an *inter partes* review proceeding (‘Prior Proceeding’) on February 18, 2021” (Pet. 1), Petitioner did not file any request for joinder with that “Prior Proceeding” or any other *inter partes* review proceeding, as contemplated by the second sentence of § 315(b) (providing that “[t]he time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c)”). Nor could Petitioner have done so, in view of the governing rule that “[a]ny request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R.

§ 42.122(b). As Petitioner notes, the Board instituted *inter partes* review in IPR2020-01389 on February 18, 2021, i.e., more than ten months before the instant Petition was filed on January 7, 2022. *See* IPR2020-01389, Paper 11 (PTAB Feb. 18, 2021).² The only other *inter partes* review of the ’482 patent that the Board has instituted is IPR2021-00192, referenced in Section II.B. above, but that proceeding was instituted more than seven months prior to Petitioner’s filing date, and, thus, is similarly unavailable for joinder under § 42.122. *See* IPR2021-00192, Paper 14 (PTAB May 25, 2021).

² Indeed, as noted in Section II.B. above, IPR2020-01389 was terminated on November 15, 2021, and, thus, was no longer pending at the time the instant Petition was filed.

IV. CONCLUSION

On the record before us, we determine that the Petition is barred under 35 U.S.C. § 315(b). We, accordingly, deny institution of an *inter partes* review of the challenged claims.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* as to all grounds and all challenged claims of the '482 patent, and no trial is instituted.

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Patent 6,308,482 B1

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