OkUNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COLLEGE PRODUCTS, INC.,

Petitioner,

v.

INTIRION CORPORATION,

Patent Owner.

Case IPR2023-01041

Patent No. 9,791,206

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF AUTHORITIES

Page(s)

Cases

Avigilon Corp. v. Canon Inc.,
Case IPR2018-01626 (P.T.A.B. Mar. 18, 2019) 1, 2, 5

Cisco Sys., Inc. v. Chrimar Sys., Inc.,
Case IPR2018-01511 (PTAB Jan. 31, 2019).....3

Click-to-Call Techs., LP v. Ingenio, Inc.,
899 F.3d 1321 (Fed. Cir. 2018) 3

Ruiz Food Prods., Inc. v. MacroPoint LLC,
Case IPR2017-02016 & IPR2017-02018 (P.T.A.B. Feb. 14, 2019).....3

ZTE (USA), Inc. v. Agis Software Dev., LLC,
Case IPR2019-00487 (P.T.A.B. May 6, 2019).....3

Statutes

35 U.S.C. § 315 ..... 1, 2, 3, 5

Rules

Fed. R. Civ. P. 13 3

TABLE OF EXHIBITS

Exhibit #	Reference Name
2001	Intirion's Patent Infringement Complaint in Case No. 6:22-cv-00459 (W.D. Tex.)
2002	Intirion's Affidavit of Service in Case No. 6:22-cv-00459 (W.D. Tex.)
2003	Order Transferring Case No. 6:22-cv-00459 (ECF 35) (W.D. Tex.) to the Northern District of Iowa
2004	Intirion's First Amended Complaint in Case No. 5:23-cv-04023-KEM (N.D. Iowa)
2005	College Products's Declaratory Judgment Complaint in Case No. 5:23-cv-04002-KEM (N.D. Iowa)
2006	College Products's Amended Complaint in Case No. 5:23-cv-04002-KEM (N.D. Iowa)
2007	Declaration of R. Scott Johnson
2008	Joint Email to the U.S. District Court for the Northern District of Iowa (May 3, 2023)
2009	Transcript of May 4, 2023, Telephonic Status Conference before the U.S. District Court for the Northern District of Iowa
2010	Summary of May 4, 2023, Telephonic Status Conference for Case No. 5:23-cv-04002-KEM (N.D. Iowa)
2011	Joint Motion to Consolidate Actions in Case No. 5:23-cv-4002-KEM
2012	Email Exchange between Counsel for Intirion and Counsel for College Products (May 30 to June 8, 2023)
2013	Order Consolidating Case Nos. 5:23-cv-04002-KEM (N.D. Iowa) and 5:23-cv-04023-KEM (N.D. Iowa)
2014	College Products's Petition for *Inter Partes* Review of U.S. Patent No. 9,791,206
2015	College Products's Petition for *Inter Partes Review* of U.S. Patent No. 10,495,374
2016	College Products's Petition for *Inter Partes* Review of U.S. Patent No. 11,274,876

Exhibit #	Reference Name
2017	Declaration of Thomas M. Patton

Petitioner College Products ("CP") filed a declaratory judgement ("DJ") action for invalidity on U.S. Patent Nos. 9,791,206 (the "'206 Patent"); 9,657,974 (the "'974 Patent"); 10,495,374 (the "'374 Patent"); and 11,274,876 (the "'876 Patent") on January 5, 2023 (collectively, the "Patents-at-Issue"). (Ex. 1017). CP filed its petitions for *inter partes* review for the '206, '974, and '374 Patents <u>six months later</u>, on June 8, 2023. In short, "before the date on which the petition for review [was] filed, the petitioner . . . filed a civil action challenging the validity of a claim of the patent." *See* 35 U.S.C. § 315(a)(1). Without legal citation, CP asks the Board to ignore the clear language of § 315(a)(1), ignore the definition of "counterclaim," and ignore analogous caselaw cited by Patent Owner Intirion to hold that CP's petitions for *inter partes* review—filed six months after CP filed its DJ action challenging the validity of the Patents-at-Issue—are somehow not barred. The Board should reject CP's request. *Inter partes* review is barred here.

Tellingly, after seeking leave to specifically address the § 315(a)(1) bar issue, CP did not find <u>*any*</u> legal support for its position that § 315(a)(1) does not bar institution of this Petition. Instead, CP chose to misrepresent the record and the cases Intirion cited in its preliminary response. CP attempts to circumvent *Avigilon Corp. v. Canon Inc.*, Case IPR2018-01626 (P.T.A.B. Mar. 18, 2019), by arguing it is distinguishable as Intirion's Action (Ex. 2001) was in the wrong venue, so CP's

claims in its DJ Action (Ex. 2006) are actually "counterclaims."[1] CP "distinguishes" on a legally irrelevant fact. Simply put, CP filed an *undisputedly separate* DJ lawsuit. *E.g.*, (Ex. 2005 (naming CP as "Plaintiff," not "counterclaimant")). Moreover, *Avigilon* stands for the proposition that filing a DJ action is not "counterclaims" for the purposes of § 315(a)(1) even where the claims could also have been filed as counterclaims in a separately pending action. *Avigilon*, Paper 11 at 10–11. CP has not (and cannot) distinguish this, nor has CP found caselaw supporting its position.

Similarly, CP's attempts to distinguish *ZTE, Ruiz,* and *Click-to-Call* fall flat. CP ignores the clear purpose of these citations in Intirion's briefing—to demonstrate the Board has *never* found that a DJ action initiated before the filing of a petition for

[1] CP's sole dispute is whether its filed DJ action contained only counterclaims. CP does not appear to dispute that, under § 315(a)(1), the question is whether CP "filed" a civil action challenging the validity of a claim in the patents, which merely refers to "a discrete action taken at a particular point in time," i.e., at the beginning of a lawsuit. Nor does CP argue there is some unwritten exemption for invalidity claims filed and later consolidated into another action. In other words, the question is merely whether CP *filed* an action challenging validity. Whether there was any later dismissal or consolidation is irrelevant. *See Avigilon*, Paper 11 at 7 (P.T.A.B. Mar. 18, 2019) (applying the plain meaning of "complaint" to § 315(a)).

inter partes review is a "counterclaim". *ZTE (USA), Inc. v. Agis Software Dev., LLC*, Case IPR2019-00487, Paper 9 at 3–5 (P.T.A.B. May 6, 2019) (denying institution where *ZTE (USA)* had previously filed a DJ action); *Ruiz Food Prods., Inc. v. MacroPoint LLC*, Case IPR2017-02016 & IPR2017-02018, Paper 25 at 11–13 (P.T.A.B. Feb. 14, 2019) (holding that claims in a DJ action are not considered "counterclaims").[2] And *Click-to-Call*—adopted by *Cisco Sys., Inc. v. Chrimar Sys., Inc.*, Case IPR2018-01511, Paper 11 (PTAB Jan. 31, 2019) (precedential)—requires a plain language application of § 315(a). *Click-to-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321, 1330–31 (Fed. Cir. 2018) (applying the plain and ordinary meaning of "complaint" to § 315); *see also Cisco Sys.*, Paper 11 at 6 (Jan. 31, 2019).

CP also glosses over key undisputed facts that further foreclose CP's after-

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[2] CP's selective citation of *Ruiz*, Paper 25 at 12 (focusing on "against an opposing party"), does not move the needle. Fed. R. Civ. P. 13 notes that counterclaims are against an "opposing party," i.e., the party *already in the suit*. Thus, CP's attempt to distinguish are without merit, as CP "filed its declaratory-judgment complaint "(i) as the plaintiff, (ii) in as [sic] a separate action, (iii) in a different jurisdiction, the Northern District of [Iowa], (iv) naming Patent Owner as defendant." *Ruiz*, Paper 25 at 12. In *Ruiz*, the Board noted such a filing was not consistent with the ordinary meaning of "counterclaim." *Id.*

the-fact attempt to recast its DJ Action as "counterclaims." For example, CP ignores it filed its DJ Action for invalidity of the '206, '374, and '876 Patents six months *before* CP filed its IPR petitions. (Ex. 2005 at 15–17, 19–21, 22–24 (Count III, titled "Declaratory Judgment of Invalidity of the '206 Patent"; Count V, titled "Declaratory Judgment of Invalidity of the '374 Patent"; Count VII, titled "Declaratory Judgment of Invalidity of the '876 Patent")). CP listed itself as "Plaintiff" and asserted these invalidity claims in a complaint (as opposed to in an existing civil action as a defendant or counterclaimant). *Then*—still before filing its IPR petitions, but after Intirion's Texas case had been transferred to the Northern District of Iowa—CP doubled down and filed an amended complaint in its DJ Action, again challenging the validity of the Patents-at-Issue and including additional claims against Intirion.[3] (Ex. 2006). Intirion is aware of no definition of

[3] CP misstates the record when it states, "The dispute about which case should be the lead case only arose *after* Petitioner amended its complaint in the Iowa Action, to include numerous affirmative claims against Patent Owner." Paper 9 at 3 (emphasis added). CP amended its DJ Action complaint on April 25, 2023. (Ex. 2006). Earlier that day, the parties had an initial conference call to discuss the two cases. (Ex. 2017, Patton Decl., ¶ 4; Ex. 2009 at 6:5–7). In particular, the parties discussed consolidation, with CP arguing it was the real plaintiff and its DJ Action

"counterclaim" that would stretch to meet such conduct. Indeed, there is no such definition. CP's stated belief that Intirion was not "interested . . . in really adjudicating" the infringement case drives the point home—CP believed that it was filing DJ claims of invalidity on patents for which it apparently believed Intirion was not pursuing infringement on. That is not a "counterclaim." *See* (Ex. 2009 at 10:21–11:3) (CP's counsel agreeing the "claims that [CP] filed in the lawsuit [CP] brought" could have been included as counterclaims but were not)).

CP's petitions for *inter partes* review should be denied under §315(a)(1). CP filed the DJ Action six months before it filed its petitions for *inter partes* review. CP does not contest the DJ Action it filed seeks invalidity of a claim of the '206 Patent. And "in [CP's] declaratory judgment action, [CP] was the plaintiff while [Intirion] was the defendant, so the allegations in the declaratory judgment complaint were not a defendant's claims in opposition to a plaintiff's claims, as set forth in the cited definition of 'counterclaim.'" *See Avigilon*, Paper 11 at 10–11. In these circumstances, "inter partes review may not be instituted." 35 U.S.C.§ 315(a)(1).

For all the above reasons, Intirion respectfully requests the Board decline to institute IPR2023-01041.

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was the lead case because CP was the first filed case in the proper venue. (Ex. 2017, Patton Decl., ¶ 4); *see also* (Ex. 2009 at 9:12–10:20).

Dated: October 27, 2023

/R. Scott Johnson/

R. Scott Johnson
Reg. No. 45,792

Counsel for Patent Owner Intirion

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(a)(1)(i), the undersigned hereby certifies that the foregoing Patent Owner's Sur-Reply to Petitioner's Reply to Patent Owner's Preliminary Response contains 1,601 words, excluding parts of this Sur-Reply exempted under § 42.24(a), as measured by the word-processing system used to prepare this paper.

Dated: October 27, 2023

/R. Scott Johnson/
R. Scott Johnson
Reg. No. 45,792

Counsel for Patent Owner Intirion

CERTIFICATE OF SERVICE

Per agreement of the parties and pursuant to 37 C.F.R. ¶ 42.105(b), the undersigned certifies that copies of Exhibits 2001–2016 were previously served on the persons listed below on September 14, 2023. A copy of this Patent Owner's Sur-Reply to Petitioner's Reply to Patent Owner's Preliminary Response and Exhibit 2017 was served on October 27, 2023, electronically via Secured File Transfer on the following:

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