

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TIKTOK INC.,
Petitioner,¹

v.

CELLSPIN SOFT, INC.,
Patent Owner.

IPR2024-00757 (Patent 8,756,336 B2)
IPR2024-00759 (Patent 8,862,757 B2)
IPR2024-00760 (Patent 8,898,260 B2)
IPR2024-00767 (Patent 11,659,381 B2)
IPR2024-00768 (Patent 11,234,121 B2)
IPR2024-00769 (Patent 9,900,766 B2)
IPR2024-00770 (Patent 8,904,030 B2)

Before GREGG I. ANDERSON, CYNTHIA M. HARDMAN, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

PER CURIAM.

ORDER
Granting Patent Owner Authorization to File Motion to Terminate
37 C.F.R. § 42.5

¹ LifeScan, Inc., Senseonics Holdings, Inc., and Ascensia Diabetes Care Holdings AG have been joined as Petitioners to IPR2024-00768, -769, and -770. This Order addresses issues common to the identified cases. The parties are not authorized to use this caption without express authorization.

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I. INTRODUCTION

On March 5, 2025, Patent Owner Cellspin Soft, Inc. emailed the Board requesting a conference call for the purpose of seeking authorization to file “a Motion to Terminate the Proceeding and Vacate the Decision on Institution” in each of the above-noted IPRs.² *See* Ex. 3001³ (“PO Email”). Patent Owner stated:

The basis for these motions is Petitioner’s failure to name the Chinese Communist Party (“CCP”) as a real party-in-interest in each Petition for *Inter Partes* Review. Another related basis is that an entity controlled by a sovereign (here, the CCP) may not qualify as “persons” eligible to challenge a patent via an administrative patent review, such as an IPR (*See Return Mail Inc. v. United States Postal Service* (587 U.S. 117⁴ (2019))).

Id. Patent Owner further indicated that the parties were available for a conference to discuss this request on March 18, 2025. *Id.*

On March 18, 2025, the panel held a conference call with counsel for the parties. A court reporter was present, and a transcript of the conference

² Patent Owner does not identify any difference between the motions it seeks to file in each case. Thus, we refer to a singular “motion to terminate” below with the understanding that Patent Owner seeks to file a substantively identical motion in each case.

³ Herein we cite papers and exhibits filed in IPR2024-00757. Similar papers and exhibits are filed in the other subject IPRs.

⁴ Patent Owner’s email contains a typographical error in the *Return Mail* citation. The correct citation is *Return Mail Inc. v. United States Postal Service*, 587 U.S. 618 (2019).

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call is in the record. *See* Ex. 2023 (“Tr.”). During the call, the parties presented arguments regarding whether Patent Owner should be authorized to file a motion to terminate in each of these cases.

Patent Owner asserts two separate, but related theories for its proposed motion to terminate: (1) Petitioner TikTok Inc.’s alleged failure to name the CCP as a real party in interest in each Petition; and (2) that “an entity controlled by a sovereign (here, the CCP) may not qualify as ‘persons’ eligible to challenge a patent via an administrative patent review, such as an IPR (*See Return Mail Inc. v. United States Postal Service* (587 U.S. 117 (2019)).” PO Email; *see also* Tr. 7:21–8:11.

After considering the parties’ arguments, we grant Patent Owner’s request for authorization to file a motion to terminate. Below we provide guidance that the parties may elect to consider in preparing their briefs.

A. Failure to Name Real Party in Interest

Patent Owner’s first theory for why termination is proper is based on TikTok Inc.’s alleged failure to identify the CCP as a real party in interest in the Petition. *See* PO Email; *see also* Tr. 7:21–25. Our precedent, however, holds that the Board’s “jurisdiction to consider a petition does not require a ‘correct’ identification of all RPIs [real parties in interest] in a petition.” *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11, 18 (PTAB Oct. 6, 2020) (precedential) (quoting *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, IPR2015-00739, Paper 38 at 6 (PTAB Mar. 4,

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2016) (precedential)). Additionally, our precedent holds that we need not consider whether an unnamed party is a real party in interest when the addition of that party “would not create a time bar or estoppel under 35 U.S.C. § 315.” *SharkNinja*, IPR2020-00734, Paper 11, at 18. Given Patent Owner’s concession that the addition of the CCP as a real party in interest would not create any time bar or estoppel issues (Tr. 25:5–25) and if Patent Owner elects to continue with this argument as a separate basis for its motion, Patent Owner may wish to address in its brief on why TikTok Inc.’s alleged failure to name the CCP as a real party in interest is, standing alone, a proper ground for termination.

B. Applicability of Return Mail

Patent Owner raises a separate, but related, theory for its proposed motion, namely that under *Return Mail*, “an entity controlled by a sovereign (here, the CCP) may not qualify as ‘persons’ eligible to challenge a patent via an administrative patent review, such as an IPR.” PO Email (citing *Return Mail Inc. v. United States Postal Service*, 587 U.S. 618 (2019)).

As the Supreme Court explained in *Return Mail*, “[t]he AIA provides that only ‘a person’ other than the patent owner may file with the Office a petition to institute” a post-grant review, *inter partes* review, or (at the time of the *Return Mail* case) covered business method review of an issued patent. *Return Mail*, 587 U.S. at 626 (citing 35 U.S.C. §§ 311(a), 321(a); AIA § 18(a)(1)(B), 125 Stat. 330). In *Return Mail*, the U.S. Postal Service

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filed a petition for covered business method review of a patent. *Id.* at 625. The question presented in *Return Mail* was whether a federal agency is a “person” able to petition for post-issuance review of a patent. *See id.* at 621. The Court found that it is not. *See id.* In relevant part, the Court “applie[d] a ‘longstanding interpretive presumption that “person” does not include the sovereign,’ and thus excludes a federal agency like the Postal Service.” *Id.* at 626 (quoting *Vermont Agency of Natural Resources v. United States ex rel. Stevens*, 529 U.S. 765, 780–81 (2000)).

In their briefs, the parties may wish to address the seeming factual differences between those in *Return Mail* and those here, and whether and why any of those differences impact the application of *Return Mail*’s holding to this case. For example, in *Return Mail* the sovereign was a U.S. federal agency, whereas here the alleged “sovereign” is a foreign entity. Additionally, in *Return Mail* the petitioner was itself a sovereign, whereas here Patent Owner is not alleging that TikTok Inc. is itself a sovereign, but rather that it is “controlled by a sovereign.” *See* PO Email. The parties may also wish to address that TikTok Inc. is a corporation, and a corporation is a “person” eligible under 35 U.S.C. § 311(a) to petition for IPR.

Finally, given that cases IPR2024-00768, -769, and -770 have joined Petitioners (other than TikTok Inc.), we understand that Patent Owner’s motion for those cases would apply only to TikTok Inc. and not the entire proceeding. If this is not the case, Patent Owner should clarify its position in its motion.

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II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's request to file a motion to terminate in the above-noted IPRs is *granted*;

ORDERED that Patent Owner is authorized to file, on or before April 17, 2025, a motion to terminate in each of the above-referenced *inter partes* reviews, which shall not exceed 20 pages and shall not differ in substance between the proceedings with the exception that Patent Owner may also address the issue identified above relating to the joined petitioners in its motions for IPR2024-00768, -769, and -770;

FURTHER ORDERED that Petitioner TikTok Inc. is authorized to file, on or before May 8, 2025, an opposition to Patent Owner's motion in each of the above-referenced *inter partes* reviews, which shall not exceed 20 pages;

FURTHER ORDERED that Patent Owner is authorized to file, on or before May 19, 2025, a reply to Patent Owner's opposition in each of the above-referenced *inter partes* reviews, which shall not exceed 7 pages;

FURTHER ORDERED that any evidence Patent Owner offers in support of its motion shall be filed as an exhibit at the time that motion is filed. Any rebuttal evidence Petitioner offers shall be filed as an exhibit at the time its opposition is filed. Patent Owner may not file any exhibit with its reply absent authorization from the panel. In the event, either side submits testimony in the form of a declaration prepared for these

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proceedings, the parties shall work together to schedule the deposition of the declarant to occur sufficiently in advance of the deadline for the opposing party's next brief, i.e., either Petitioner's opposition or Patent Owner's reply;

FURTHER ORDERED that any objection to evidence submitted with the motion or opposition is due within five business days of service of the evidence as set forth in 37 CFR § 42.64(b)(1), and **the Board hereby shortens the time** set forth in 37 CFR § 42.64(b)(2) to serve any supplemental evidence in response to any such objection to **five business days after service of an objection**; and

FURTHER ORDERED that any motion to exclude evidence submitted with the motion or opposition is due on Due Date 6, as set forth in the scheduling order (Paper 9).

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