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Paper 135 (IPR2014-00041)
Paper 114 (IPR2014-00043)
Paper 113 (IPR2014-00051)
Paper 134 (IPR2014-00054)
Paper 106 (IPR2014-00055)
Entered: December 23, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEA PROCESS ENGINEERING, INC.,
Petitioner,

v.

STEUBEN FOODS, INC.,
Patent Owner.

Cases¹

IPR2014-00041 (Patent 6,945,013 B2)
IPR2014-00043 (Patent 6,475,435 B1)
IPR2014-00051 (Patent 6,209,591 B1)
IPR2014-00054 (Patent 6,481,468 B1)
IPR2014-00055 (Patent 6,536,188 B1)

Before MICHAEL P. TIERNEY, RAMA G. ELLURU, and
BEVERLY M. BUNTING, *Administrative Patent Judges*.

ELLURU, *Administrative Patent Judge*.

TERMINATION

35 U.S.C. § 312(a)(2) and 37 C.F.R. § 42.72

¹ This order addresses issues raised in all five cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

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I. INTRODUCTION

Patent Owner, Steuben Foods, Inc. (“Steuben Foods”), filed motions addressing two issues: (1) whether Petitioner, GEA Process Engineering, Inc. (“GEA”), identified all real-parties-in-interest (“RPIs”) in its Petitions; and (2) what relief we should grant if we determine that GEA did not identify all RPIs in its Petitions. Paper 62, 3 (authorizing briefing); Paper 63 (“Mot”).² GEA filed Oppositions to Steuben Foods’ motions. Paper 62, 3 (authorizing briefing); Paper 79 (“Opp.”); Paper 81, 4 (authorizing GEA to refile its Opposition to comply with the authorized 15 page limit). GEA’s Oppositions are supported by a Declaration from its General Counsel, Brian Casto. Ex. 1056. Steuben Foods filed Replies in support of its Motions. Paper 81, 5 (authorizing briefing); Paper 108 (“Reply”). Lastly, GEA filed sur-replies. Paper 126, 4 (authorizing briefing); Paper 128 (“Sur-reply”).

Based on the present record, and for the reasons stated below, we grant Steuben Foods’ motions. Thus, we vacate our decisions on institution in the above-identified cases and terminate the *inter partes* reviews in these cases.

² The same briefing from both parties was filed in all five cases. While the analysis herein applies to each of these proceedings, we refer to the papers filed in Case IPR2014-00041 for convenience, unless otherwise indicated.

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II. ANALYSIS

A. *Factual Background*

GEA and GEA Procomac S.p.A. (“Procomac”) are related companies within the same family of companies. Ex. 2001, 13, 206–209; Ex. 2006; Ex. 2007 ¶¶ 3–5; Ex. 1052 ¶ 1; Ex. 2012; Ex. 2013. GEA Group AG (“GEA Group”) is the parent company of both GEA and Procomac. Ex. 2001, 13; Ex. 2012; Ex. 2013. Steuben Foods filed a complaint in district court alleging infringement of all five patents at issue in these proceedings against GEA and Procomac. Ex. 2007, 1–12. Steuben Foods served GEA with the complaint on October 10, 2012. *See* IPR2014-00051, Paper 10, 1–2.³

In November 2012, GEA and Procomac entered into an [REDACTED] agreement with [REDACTED] covering the “Steuben Patents.” Ex. 1052⁴ ¶¶ 1–5. The agreement defines “GEA” as GEA Process Engineering Inc. (Petitioner) and GEA Procomac S.p.A,

³ Although GEA asserts that it was served with a complaint alleging infringement of US Patent No. 6,209,591 B1 on September 10, 2012 (IPR2014-00051, Paper 10, 1–2), the parties have not disputed that this service date applies to the other four patents at issue. *See* 35 U.S.C. § 315(b) (“An *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.”).

⁴ Although the [REDACTED] agreement provided as Exhibit 1052 does not evidence execution, GEA has not disputed that the agreement was executed. *See Opp.*

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collectively. *Id.* ¶ 2. “Steuben Patents” is defined to include all five patents at issue in these trials. *Id.* ¶ 1. The [REDACTED] agreement provides that:

[REDACTED]

Id. ¶ 2 (emphasis added).

On October 9 and 10, 2013, GEA filed the five petitions at issue in these trials.⁵ GEA is represented in these proceedings by the same counsel that represents both GEA and Procomac in the district court case, Pillsbury Winthrop Shaw Pittman LLP (“Pillsbury”). Ex. 1056 ¶¶ 5, 7; Ex. 2004. Two in-house attorneys from GEA Group are designated as in-house legal representatives for both GEA and Procomac under the protective order in the related district court case. Ex. 2002.

We instituted *inter partes* review (“IPR”) trials in these cases on March 10, 2013. Paper 15. During the initial conference call, on March 31, 2014, Steuben Foods sought additional discovery relating to the RPI of the

⁵ The petition filing dates are as follows: IPR2014-00041 (October 9, 2013); IPR2014-00043 (October 9, 2013); IPR2014-00051 (October 9, 2013); IPR2014-00054 (October 10, 2013); and IPR2014-00055 (October 10, 2013).

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petitions at issue. Paper 18; *see* 35 U.S.C. § 312(a)(2) (“A petition filed under section 311 may be considered only if . . . the petition identifies all real parties in interest”). Specifically, Steuben Foods alleged that Procomac was possibly an RPI because it may have funded and controlled the filing of the instant petitions. Paper 18, 4–5. We authorized Steuben Foods to file a motion for additional discovery relating solely to the RPI issue in the instant cases and authorized GEA to file an opposition to that motion. *Id.* at 6–7. During that March 31 teleconference, GEA argued that if Procomac was a party that should have been identified as an RPI in the instant petitions, the failure to do so was merely a clerical error. *Id.* at 5. GEA requested us to extend the time period within which a party could have requested joinder in the instant proceedings, which expired on April 10, 2014, so that if Procomac sought to file petitions in these cases, they could be joined with the present cases. *Id.*; *see* 37 C.F.R. § 42.122(b) (“Any request for joinder must be filed . . . no later than one month after the institution date of any *inter partes* review for which joinder is requested.”). We declined to extend the deadline set forth in § 42.122(b). Paper 18, 5. Procomac did not file petitions and seek joinder in these cases.

We subsequently denied Steuben Foods’ motion for additional discovery relating to the identity of all RPIs because the evidence and arguments presented by Steuben Foods did not convince us that the requested additional discovery either existed or was likely to uncover

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information useful to the instant proceedings. Paper 23, 7; Paper 29 (denying request for rehearing of decision denying additional discovery). One of our considerations in denying Steuben Foods' request was that, at that time in the proceedings, there was no evidence that GEA accepted monetary compensation from Procomac. Paper 23, 6.

Almost two months after the initial conference call, in a May 21, 2014 teleconference, Steuben Foods continued to seek discovery relating to the RPIs. Paper 32, 2–7. GEA admitted during that teleconference that “[o]n May 16, 2014, petitioner discovered that after the October 10, 2013 filing of the petitions [Procomac] had been [REDACTED] invoiced by petitioner for *IPR petition expenses for the previously filed IPR petition[s]*. Petitioner is correcting its [REDACTED] now.” Ex. 2064, 33:11–18 (emphasis added). We authorized Steuben Foods to file a “proposed” set of discovery requests relating to the RPI issue. Paper 32, 2–7. Steuben Foods filed proposed discovery requests including a request for document(s) referenced by GEA during the May 21 teleconference, and GEA agreed to produce that requested discovery. Papers 33, 38; Ex. 2072. GEA subsequently reimbursed Procomac for all IPR expenses that were invoiced previously by GEA to Procomac (“GEA/Procomac invoices”) on May 28, 2014. Ex. 2073.

During a June 24, 2014 teleconference, GEA stated that it would not agree to un-redact the portions of the GEA/Procomac invoices that indicated dollar amounts, but agreed to produce dollar amounts in terms of

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percentages, “presumably the percentage of the amount [GEA’s counsel] Pillsbury charged for legal fees for the instant proceedings that was invoiced to Procomac, GEA Group or any other party.” Paper 43, 3. On July 21, 2014, GEA counsel sent Steuben Foods counsel an email stating that with regards to the GEA/Procomac invoices dated October 23, 2013, December 20, 2013, and March 19, 2014, GEA [REDACTED] invoiced Procomac for “*all of the IPR expenses that had previously been billed to and paid by*” GEA for GEA’s IPRs. Ex. 2073 (emphasis added); *see* Ex. 2072 (GEA/Procomac Invoices). GEA counsel further stated that the three GEA/Procomac Invoices included “all the IPR expenses” until this [REDACTED] was identified on May 16, 2014. *Id.*

GEA’s Opposition to Steuben Foods’ RPI motion is supported by a Declaration from Brian Casto, General Counsel for GEA, who started working for GEA on June 16, 2014, after the relevant events at issue occurred. Paper 79, 1 (citing Ex. 1056). Mr. Casto provides the following declaration testimony:

When categorizing Pillsbury’s invoices, *Petitioner did not differentiate between (1) IPR Expenses that Petitioner alone was responsible for, and (2) non-IPR expenses that were supposed to be charged to Procomac.* This caused Petitioner’s accounting department to treat the different Pillsbury expenses in the same way and [REDACTED] invoice IPR Expenses to Procomac on October 23, 2013, December 20, 2013, and March 19, 2014 (*see*, Ex. 2072, pp. 1-3, respectively) (the [REDACTED]).

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Ex. 1056 ¶ 10 (emphasis added). During a September 11, 2014 teleconference, we ordered GEA to produce to Steuben Foods the “Pillsbury invoices” referred to in Mr. Casto’s Declaration and Pillsbury invoices to GEA that reference any IPR expense with appropriate redactions, beginning with the first-in-time Pillsbury invoice that references an IPR expense and all Pillsbury invoices that reference any IPR expense from then until June 30, 2014. Paper 90, 3–4. That discovery was produced,⁶ and the parties have completed the ordered briefing.

B. Arguments Presented

Steuben Foods argues that a challenge to the identification of the RPI can be raised at any time during a proceeding, and that if all RPIs have not been identified in the petition, there is no jurisdictional basis for the IPR. Mot. 5 (citing 35 U.S.C. §§ 312(a), 315(b)); *see Zoll Lifecor Corp v. Phillips Elec. N.A. Corp.*, IPR2013-00606, slip op. at 10 (PTAB Mar. 10, 2014) (Paper 13) (hereinafter “*Zoll Lifecor*”). Steuben Food further asserts that a failure to disclose an RPI is a substantive defect, and curing that defect, e.g., updating mandatory notices, requires giving the petition a new filing date. Mot. 6 (citing *Petroleum Geo-Services Inc. Westerngeco, LLC*, IPR2014-00678, slip op. at 4 (PTAB July 24, 2014) (Paper 15)); Reply 5. According

⁶ On October 2, 2014, Steuben Foods filed a paper stating that “[i]n view of the stipulation agreed to by the parties, it is no longer necessary to depose Mr. Brian Casto,” and indicating that the deposition of Mr. Casto was cancelled. Paper 105.

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to Steuben Foods, however, the assignment of a new filing date is futile if the petition would then be time-barred. Mot. 6 (citing *Zoll Lifecor*, slip op. at 12 (Paper 13)).

Steuben Foods advances several arguments in support of its assertion that Procomac is an RPI of the instant proceedings, including that GEA and Procomac, jointly, entered into an agreement with ██████████, that Procomac did in fact fund the entirety of these review proceedings up until May 2014, and that GEA's allegation of an ██████████ is suspect. Mot. 6–15; Reply 2–4.

GEA argues that Steuben Foods raised the RPI issue in an untimely manner. Opp. 9–12. According to GEA, 35 U.S.C. § 312(a) is a “petition completeness statute,” petition completeness challenges must be made before institution, and the Board's institutions affirmed GEA's filing dates. *Id.* at 10 (citations omitted).

Referring mainly to Mr. Casto's Declaration, GEA asserts that Procomac did not control or fund the petitions. *Id.* at 1–3. Furthermore, reiterating the statements in Mr. Casto's Declaration, GEA alleges that the Pillsbury invoices were sent to Procomac as a result of an ██████████ ██████████ *Id.* at 7 (citing Ex. 1056 ¶ 10). GEA also argues that Procomac was not an RPI when the petitions were filed, and a post-filing change in the RPIs due to an alleged ██████████ does not affect petition completeness or GEA's standing. Opp. 8, 11–12. With respect to the

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██████████ agreement, GEA states that ██████████ did not file an IPR or move to join GEA’s IPR and, thus, Procomac did not have an actual opportunity to control GEA’s IPR. *Id.* at 4 (emphasis omitted).

Lastly, GEA argues that it should be allowed to correct any mistakes it made in identifying all the RPIs in its petitions without having to change its petition filing dates. *Id.* at 12–15.

C. *Timeliness of Steuben Foods Raising the Real Party-In-Interest Issue*

GEA argues that Steuben Foods raised the RPI issue in an untimely manner. *Opp.* 9–12. Section 312(a) of Title 35 of the United States Code provides:

REQUIREMENTS OF PETITION.—A petition filed under section 311 may be considered only if—

...
(2) *the petition identifies all real parties in interest;*

...
(emphasis added). For a petition to receive a filing date, the petition must satisfy the § 312(a) statutory requirements.

GEA contends that 35 U.S.C. § 312(a) is a “petition completeness statute” and that petition completeness challenges must be made before institution, as opposed to “standing” issues that may be challenged at any time. *Opp.* 9–10. According to GEA, the Board’s decisions on institution

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found that the original petitions are complete and listed all RPIS,⁷ and those decisions affirming the filing dates are final. *Id.* at 9 (citations omitted).

GEA does not provide persuasive authority for its position that challenges to the identification of an RPI pursuant to § 312(a) must be made before institution.

GEA refers to the Office's response to the public's comments to the Final Rules, 77 Fed. Reg. 48,680, 48,695 (August 14, 2012), cmt. 8. Opp. 10. In response to the public comment that the Office should require challenges to RPI identifications to be brought no later than the deadline for filing a preliminary response, the Office responded that such a challenge "should be" brought before or with the filing of the patent owner preliminary response. *Id.* During that period, the patent owner may seek authorization to take pertinent discovery and, after that time, the likelihood of granting authorization for additional discovery before institution will decrease. *Id.* The Office, however, did not state that a challenge to the identification of the RPI *must* be brought before institution. Indeed, the Office, in the same response, further stated that, "[a]fter institution, standing issues may still be raised during trial" and "[a] patent owner may seek authority [] to take pertinent discovery or to file a motion to challenge the petitioner's

⁷ GEA's argument, that even if Procomac became an RPI subsequent to the petition filings, its petitions were complete when filed, fails for the reasons discussed below. Opp. 11–12.

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standing.” *Id.*⁸ GEA also refers to the decision in *Synopsys, Inc. v. Mentor Graphics Corp.*, IPR2012-00042, slip. op. at 3 (PTAB Mar. 11, 2013) (Paper 23). That decision denied a rehearing request because patent owner failed to raise an improper service of petition issue pursuant to § 312(a) in its preliminary response, and could not make the argument anew in its rehearing request. *Id.* That decision also did not hold that a challenge to the RPI *must be* made before institution. *See id.*

Section 312(a) expressly states that a petition filed under § 311 “*may be considered only if,*” among other things, the petition identifies all RPIs—*not* “*may be considered before or at institution only if . . .*” Rather, the statutory provision is clearly an ongoing requirement that must be complied with during the pendency of the petition. Furthermore, requiring that such challenges must be made before institution would be prejudicial to patent owners as exemplified by this case. Here, Steuben Foods chose not to file patent owner preliminary responses, as was its option. Furthermore, Steuben Foods did not obtain the crucial discovery upon which its present motions are based until months after it first raised the RPI issue and sought additional

⁸ *Cf.* 77 Fed. Reg. at 48,759 (“The typical common-law expression of the ‘real party-in-interest’ (the party ‘who, according to the governing substantive law, is entitled to enforce the right’) does not fit directly into the AIA trial context” because “[t]hat notion reflects standing concepts, but no such requirement exists in the IPR or PGR context” wherein “there is no ‘right’ being enforced since any entity (other than the patent owner) may file an IPR or PGR petition.”).

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discovery, *and* it received the discovery only after we ordered GEA to produce the discovery. Thus, based on the present record, we determine that Steuben Foods' challenge to the identification of the RPIs in GEA's petitions is not untimely.

D. Real Party-in-Interest Analysis

Having decided that Steuben Foods is not time-barred from alleging that GEA did not properly identify all RPIs in the instant petitions, we address the question of whether Procomac is an RPI in the proceedings at issue.

“Whether a party who is not a named participant in a given proceeding nonetheless constitutes a ‘real party-in-interest’ . . . to that proceeding is a highly fact-dependent question.” 77 Fed. Reg. at 48,759. “[T]he spirit of that formulation as to IPR . . . proceedings means that, at a general level, the ‘real party-in-interest’ is the party that *desires review* of the patent. Thus, the ‘real party-in-interest’ may be the petitioner itself, and/or it may be the real party or parties at whose behest the petition has been filed.” *Id.* (emphasis added).

There are multiple factors relevant to consider in the RPI determination. 77 Fed. Reg. at 48,759 (citing *Taylor v. Sturgell*, 553 U.S. 880 (2008)). “A common consideration [but not the sole consideration] is whether the non-party exercised or could have exercised control over a party’s participation in a proceeding.” *Id.* (citations omitted); *see*

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Syntroleum Corp. v. Neste Oil Oyj, IPR2013-00178, slip. op. at 6 (Sept. 4, 2013) (Paper 22). The concept of control generally means that “the non-party has the actual measure of control or opportunity to control that might reasonably be expected between two formal coparties.” 77 Fed. Reg. at 48,759 (citation omitted). There is no bright-line test, however, for “determining the necessary quantity or degree of participation to qualify as a ‘real party-in-interest’ . . . based on the control concept.” *Id.* (citing *Gonzalez v. Banco Cent. Corp.*, 27 F.3d 751, 759 (1st Cir. 1994)). And whether “something less than complete funding and control suffices to justify similarly treating the party requires consideration of the pertinent facts.” *Id.* (citations omitted). The non-party’s participation may be overt or covert, and the evidence may be direct or circumstantial—but the evidence as a whole must show that the nonparty possessed effective control from a practical standpoint. *Gonzalez*, 27 F.3d at 759. The inquiry is not based on isolated facts, but rather must consider the totality of the circumstances. *Id.*

Procomac funded all of the expenses of the instant proceedings until May 2014. Ex. 2072; *see* 77 Fed. Reg. at 48,760 (discussing funding). GEA does not dispute that on October 23, 2013, December 20, 2013, and March 19, 2014, it invoiced Procomac for “*all of the IPR expenses that had been previously billed to and paid by*” GEA for its IPRs. Ex. 2073 (emphasis added); *see* 77 Fed. Reg. at 48,759 (identifying funding as a consideration for determining whether a party is an RPI). This funding occurred until May

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2014, when GEA claims that it identified an alleged [REDACTED] and refunded to Procomac all the IPR expenses that Procomac had thus far paid. Ex. 1056 ¶ 11; Ex. 2072, 4. Although GEA has not revealed the dollar amount of the expenses that it invoiced to Procomac and then refunded to Procomac, there is no dispute that it was one-hundred percent of the IPR expenses that previously was billed to, and paid by, GEA. Ex. 2073. As Steuben Foods contends, the undisclosed amount of money invoiced to and paid by Procomac is presumably significant—“on the order of several hundred thousand dollars.” Mot. 11.

GEA asserts that Procomac paid for the IPR expenses *after* the IPR petitions were filed, and, thus, that Procomac was not an RPI when the petitions were previously filed, arguing that post-filing funds cannot retroactively change the facts as of the filing date. Opp. 6, 8, 11–12. We are not persuaded by GEA’s argument. Typically, legal bills are billed and paid for *after* the services have been rendered. Here, the first invoice from Pillsbury to GEA that included an IPR expense is dated October 25, 2013, for “services rendered and disbursements incurred through September 30, 2013,” and there is an invoice dated November 14, 2013, for “services rendered and disbursements incurred through October 31, 2013.” Ex. 2113, 1–15, 16–30; *see* Paper 90 (ordering GEA to produce to Steuben Foods Pillsbury invoices that reference any IPR expenses, “beginning with the first-in-time Pillsbury invoice that references an IPR expense”). Some

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Pillsbury invoices to GEA included both IPR expenses as well as expenses related to the district court litigation. *See, e.g.*, Ex. 2113, 32. The first invoice from GEA to Procomac for IPR expenses is dated October 23, 2013,⁹ indicating that it is “to backcharge your account for legal fees.” Ex. 2072, 1. GEA’s counsel acknowledges that Procomac paid for “all of the IPR expenses that had been *previously billed to and paid by*” GEA. Ex. 2073 (emphasis added). Thus, there is no dispute that the amount invoiced to Procomac, beginning on October 23, 2013, covered the costs and expenses associated with the preparing and filing of the petitions on October 9 and 10, 2013. A third-party cannot shield itself from being identified as an RPI in a petition by, among other things, funding IPR expenses after the related petition was filed or after it was instituted. *See Taylor*, 553 U.S. at 895 (“a party bound by a judgment may not avoid its preclusive effect by relitigating through a proxy”). Furthermore, Procomac’s funding of the IPR expenses starting with the GEA/Procomac invoice dated October 23, 2013, a mere two weeks after the petitions were filed on October 9 and 10, 2013, speaks to the relationship between Procomac and GEA, and these proceedings, at the time of the filing of the petitions.

GEA argues that the invoices for the IPR expenses were sent to Procomac as a result of an [REDACTED] Opp. 7. The evidence

⁹ We note that the first invoice from GEA to Procomac for IPR expenses is dated October 23, 2013, two days before the first invoice from Pillsbury to GEA including an IPR expense. Ex. 2013, 1–15; Ex. 2072, 1.

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GEA provides in support of its position is a declaration by Mr. Casto, who began working for GEA as its General Counsel on June 16, 2014, well after the relevant events occurred. Ex. 1056 ¶ 1–3. Mr. Casto attests that throughout the preparation and filing of GEA’s petitions and Pillsbury’s ongoing work in GEA’s *inter partes* reviews, Pillsbury billed only GEA for costs and expenses incurred for the reviews, and GEA paid the bills. *Id.* ¶ 7. Mr. Casto further attests that “[w]hen categorizing Pillsbury’s invoices, [GEA] *did not differentiate between (1) IPR [e]xpenses* that [GEA] alone was responsible for, *and (2) non-IPR expenses* that were supposed to be charged to Procomac.” *Id.* ¶ 10 (emphasis added). GEA explains that this lack of differentiation caused GEA’s accounting department to “treat the different Pillsbury expenses in the same way and [REDACTED] invoice IPR Expenses to Procomac on October 23, 2013, December 20, 2013, and March 19, 2014.” *Id.* (citations omitted). That GEA itself did not differentiate between IPR expenses and non-IPR expenses, i.e., the related district court expenses, sheds light on the relationship between the two proceedings. GEA itself treated the IPR as if it was closely related to, if not the same as, the district court case. What Mr. Casto does not assert also is telling—“Mr. Casto does not aver that any employee of [GEA] ever issued or received instructions to the effect that [GEA] should be bearing the costs of the review proceedings.”¹⁰ Reply 3. Although GEA “refunded” to Procomac

¹⁰ One of the invoices from Pillsbury to GEA has the following handwritten

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the IPR expenses Procomac previously had paid, on May 28, 2014, well after Steuben Foods had first alleged that Procomac was an RPI, the fact remains that Procomac funded the IPR expenses until May 2014.

Furthermore, something less than complete funding and control may be sufficient to justify similarly treating the party as an RPI. 77 Fed. Reg. at 48,760. We must consider the totality of circumstances. *Gonzalez*, 27 F.3d at 759.

We are not persuaded by GEA’s argument that funding is not sufficient to make Procomac an RPI because “Procomac had no control over or involvement” in these reviews and did not request the reviews. Opp. 8. One of the considerations in determining whether a non-party is a real party-in-interest is whether the non-party has an “*opportunity to control* that might reasonably be expected between two formal coparties.” 77 Fed. Reg. at 48,759 (emphasis added) (citations omitted). The evidence of record

note by GEA’s General Counsel at the time, Mr. Doug L. Lunefeld: [REDACTED] Ex. 2113, 1, 4; Ex. 2116. The parties dispute the meaning of the notations with Steuben Foods’ counsel arguing that the notation indicates a [REDACTED] [REDACTED] (Reply 2–3), and GEA’s counsel (i.e., Pillsbury) arguing that notation [REDACTED] [REDACTED]” (Sur-reply 1–2). Given that GEA does not provide declaratory testimony attesting to the meaning of the notation (e.g., declaration testimony by the person who made the notation), we do not make a determination as to the definitive meaning of this notation as it is not necessary for our analysis.

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supports a reasonable inference that Procomac in fact had an opportunity to control GEA's participation in these IPRs.

The totality of the circumstances persuades us that there was no discernible boundary between GEA and Procomac in relation to these proceedings, providing Procomac ample opportunity to control GEA's participation in these proceedings. The facts here do not present the situation where Procomac and GEA are merely co-defendants with a mutual interest in the patentability of the Steuben Foods' patents. *See* 77 Fed. Reg. at 48,760 (solely because a non-party is a part of a joint defense group with a party that does file a petition for review, the non-party is not a real party-in-interest for purposes of the petition, but "*slight alterations in the facts, as well as consideration of other facts, including the non-party's relationship to the petitioner and the petition, might result in a different conclusion*") (emphasis added). GEA and Procomac are related companies, with a common parent, GEA Group. Steuben Foods alleges patent infringement by both GEA and Procomac of all five patents at issue in these proceedings in the related district court case. GEA is represented in these proceedings by Pillsbury, which represents both GEA and Procomac in the district court case.¹¹ In addition, two in-house attorneys from GEA Group are designated as in-house legal representatives for both GEA and Procomac under the

¹¹ *See Zoll Lifecor Corp.*, slip op. at 10 (Paper 13) (taking into consideration common counsel); *RPX v. Virnetx*, IPR2014-00171, slip op. at 6 (PTAB June 5, 2014) (Paper 49) (same).

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protective order in the district court case. Procomac also admitted in the related district court case to working with GEA to defend against the lawsuit. Ex. 2075 (“It is Procomac’s understanding that defense work done with [GEA] to defend against the present [related district court lawsuit] would not be considered indirect assistance in connection with [GEA’s] discrete IPR proceedings”).¹² In addition, well before the instant proceedings were filed, GEA and Procomac entered into an [REDACTED] agreement with a third party covering the “Steuben Patents.” Ex. 1052¹³ ¶¶ 1–5. Under the agreement, GEA and Procomac jointly (the agreement defines “GEA” as GEA Process Engineering Inc. (Petitioner) and GEA Procomac S.p.A) have [REDACTED]

[REDACTED] Ex. 1052 ¶ 2. GEA and Procomac were so closely aligned in relation to these proceedings that even the entities themselves did not fully appreciate they were separate and distinct entities, as demonstrated by the alleged [REDACTED] As discussed above, Procomac funded the

¹² While Procomac agreed to be bound by the statutory estoppel provisions under 35 U.S.C. § 315(e)(2) as a condition of the stay in the district court, it is not clear when Procomac made this concession, and neither party expressly argues that this fact affects our analysis. Ex. 2075.

¹³ Although the [REDACTED] agreement provided as Exhibit 1052 does not evidence execution, GEA has not disputed that the agreement was executed. *See Opp.*

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significant costs of these proceedings until May 2014, approximately a month and a half after Steuben Foods first raised the RPI issue, and GEA produced evidence of that funding only after we ordered it to produce such discovery. Even assuming GEA sent the invoices for the IPR expenses to Procomac as a result of an [REDACTED] Procomac's opportunity to control GEA's participation in the instant proceedings was increased during the time because it was the entity entirely funding the proceedings.

Furthermore, GEA has not produced evidence that the alleged [REDACTED] [REDACTED] involved an insignificant amount of money; GEA did not agree to un-redact the GEA/Procomac invoices indicating the precise amount of money that was invoiced to Procomac. Paper 43, 3; *see* Mot. 11 (alleging that the amount of expenses invoiced to Procomac was "on the order of several hundred thousand dollars"). That a [REDACTED] of that proportion could take place is evidence of the closely aligned relationship between Procomac and GEA.

Therefore, based on the particular facts of this case, we determine that Procomac was an RPI of the instant proceedings that was not identified in the Petitions. Having decided that Procomac is an RPI, we must determine the appropriate remedy for GEA's failure to identify Procomac as such in the Petitions.

E. Correcting the Identification of Real Parties-In-Interest

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Steuben Foods asserts that because Procomac is an RPI that GEA did not identify in the petitions, GEA must update the mandatory notices in these proceedings, and the petitions should be accorded a new filing date. Mot. 15. Because GEA filed the petitions on the “last possible day” before the § 315(b) bar applied, Steuben Foods argues the petitions are time barred. *Id.* GEA argues that if we determine now that Procomac is an RPI, we should allow GEA to correct the identification without changing the filing date because “(1) Petitions need not be completed on their filing date, and (2) Petitioner should equitably be allowed to correct a good-faith RPI mistake without changing Petitioner’s filing date.” Opp. 12–14. We determine that, based on the particular facts of this case, that GEA’s failure to identify Procomac as an RPI is not the type of error that can be corrected without changing the filing date of the petitions.

Pursuant to statutory authority, we may not consider a petition unless it includes the identification of all real parties-in-interest. Specifically, 35 U.S.C. § 312(a)(2) dictates that “[a] petition filed under section 311 may be considered only if . . . the petition identifies all real parties in interest.” In order to receive a filing date, the petition must satisfy § 312(a) statutory requirements as of the filing date. *See, e.g.*, 37 C.F.R. § 42.106 (in order to receive an accorded filing date, the petition must satisfy § 42.104, which by requiring compliance with § 42.8, requires a mandatory notice that identifies each real party-in-interest for the party); 77 Fed. Reg. at 48,763 (Aug. 14,

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2012) (“To obtain a filing date, the petition must meet certain minimum standards.”). Because GEA did not identify all the real parties-in-interest in its petitions, it has not met the statutory requirement of § 312(a)(2), and we cannot consider the petitions.

GEA contends that although § 42.106 requires a petition to be complete to receive a filing date, that requirement is regulatory, not statutory, and it should not be applied here because the Office’s own FAQs concede that the Board disregards this rule and accords the filing date of the original submission if it includes “only regulatory defects.” Opp. 13 (citing Ex. 1058, 5). Our rules do allow for corrections of “clerical or typographical” mistakes in a petition for *inter partes* review while maintaining the original filing date. 37 C.F.R. § 42.104(c); *see also* 37 C.F.R. § 42.106(b) (allowing for correction of an incomplete petition). For example, the Board has allowed for the correction of certain papers filed in *inter partes* review proceedings to address non-substantive mistakes. *See, e.g., ABB Inc., Roy-G-Biv Corp.*, IPR2013-00063, slip. op. at 5–10 (PTAB Jan. 16, 2013) (Paper 21). GEA, however, does not *now* argue that the failure to identify all RPIs in the petitions is a non-substantive “clerical or typographical” error. *See Chicago R.I. & P. Ry. Co. v. Schendel*, 270 U.S. 611, 620 (1926) (“Identity of parties is not a mere matter of form, but of substance. Parties nominally the same may be, in legal effect, different; and parties nominally different may be, in legal effect, the same.”).

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Furthermore, the rules contemplate that not all mistakes can be corrected without changing the filing date. *See, e.g.*, 77 Fed. Reg at 48,699 (“[t]here is no provision allowing for the correction of a mistake that is not clerical or typographical in nature without a change in filing date.”). The lack of a rule that allows for the correction to the identification of the RPIs without changing the filing date is consistent with the contemplated importance of identifying *all* the RPIs in the petitions. The mandatory notices included in the petition must include the identification of “each real party-in-interest for the party.” 37 C.F.R. §§ 42.8(a)(1), (b)(1). The Board relies on petitioner’s identification of the RPI to determine conflicts of interest for the Office, the credibility of evidence presented in a proceeding, and standing of a party that previously has filed a civil action involving a patent for which an IPR is requested. *Id.* at 48,617. The failure to identify all the RPIs impedes the Board’s ability to determine whether a request for *inter partes* review is timely. This is so because an IPR may not be instituted if the petition is filed more than one year after the date on which the petitioner, the RPI, or privy of the petitioner is served with a complaint alleging infringement of the patent. 35 U.S.C. § 315(b). Further, the failure to identify the RPI impedes the Board’s ability to determine whether the IPR may be barred under 35 U.S.C. § 315(a)(1), or whether an RPI or privy of the petitioner is estopped from requesting review under 35 U.S.C. § 315(e).

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Lastly, GEA argues that equity and justice warrant allowing GEA to correct its identification of the RPIs without changing the filing dates of the Petitions. Opp. 13–15. According to GEA, “[t]he Board should allow Procomac to be added as an RPI (if needed) without changing Petitioner’s filing date to ‘avoid defeating substantive rights’ with ‘wooden interpretations’ of rules that were not intended to procedurally void otherwise valid claims.” *Id.* at 14 (citation omitted). Even assuming we have authority to consider a petition pursuant to § 312(a)(2) when a “good-faith” mistake has impeded Petitioner from identifying all real parties-in-interest, the facts of this particular case do not warrant such equitable relief. We determine that that equity does not dictate allowing GEA to make the RPI correction without changing the filing dates. GEA *initially* argued that the failure to identify Procomac as an RPI was a clerical error. Paper 18, 5. Subsequently, however, discovery revealed that Procomac funded all the IPR expenses in these cases until May 2014 and that it had the opportunity to control GEA’s participation in these proceedings. GEA did not admit that Procomac funded the IPR expenses, or produce the relevant discovery, until long after Steuben Foods alleged that Procomac was an RPI. Indeed, GEA still asserts that Procomac is not an RPI (Opp. 1) despite the overwhelming evidence of its relationship with GEA and these proceedings, discussed above. GEA, thus, has not persuaded us that we should allow it to correct

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the identification of the RPIs in these trials without changing the filing dates of the Petitions.

III. CONCLUSION

Based on the foregoing discussion, we determine that GEA's Petitions do not identify all RPIs. Thus, the Petitions are incomplete pursuant to § 312(a), which dictates that we cannot consider the Petitions. Rule 42.106 provides that "[w]here a party files an incomplete petition, no filing date will be accorded, and the Office will dismiss the petition if the deficiency in the petition is not corrected within one month from the notice of an incomplete petition." Granting GEA a month within which to correct its incomplete Petitions is futile in this instance because, even if corrected, the earliest filing dates that could be accorded to the Petitions would not fall within the one-year period specified by the 35 U.S.C. § 315(b) statutory-bar. *See Zoll Lifecor*, slip. op. at 12 (Paper 13). Because we cannot consider the petitions, we terminate these trials. Furthermore, because the Petitions should not have been considered at institution, we vacate our Decisions on Institution.¹⁴

In consideration of the foregoing, it is:

¹⁴ Steuben Foods requested oral argument. Paper 98. GEA did not make a request for oral argument. The relevant statute, 35 U.S.C. 316(a)(1), dictates that the Director shall prescribe regulations providing either party with the right to an oral hearing as part of the proceeding. Given that trials should not have been instituted in these proceedings, we do not hold an oral hearing.

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ORDERED that the trials in IPR2014-00041, IPR2014-00043, IPR2014-00051, IPR2014-00054, and IPR2014-00055 are hereby terminated; and

FURTHER ORDERED that the Decisions on Institution in IPR2014-00041, IPR2014-00043, IPR2014-00051, IPR2014-00054, and IPR2014-00055 are hereby vacated.

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