

TRW Automotive US LLC v. Magna Electronics, Inc: Denying Motion to Dismiss Petition as Time-Barred and Failing to Identify All Real Parties-in-Interest

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Takeaway: Whether a petition is time-barred under 35 U.S.C. § 315(b) or fails to identify all real parties-in-interest under 35 U.S.C. § 312(a)(2) are fact-dependent inquiries that may or may not be dispositive of a case depending on the circumstances.

In its [Decision](#), the Board addressed issues of service under 35 U.S.C. § 315(b) and real party-in-interest under 35 U.S.C. § 312(a)(2) within the context of a complex fact pattern involving eighteen separate petitions for *inter partes* review. This Decision focuses on thirteen of the proceedings resulting from these eighteen petitions.

35 U.S.C. § 315(b) provides in pertinent part that “[a]n *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than one year after the date on which the petitioner . . . is served with a complaint alleging infringement of the patent.” Further authority indicates that the one-year period at issue is triggered when a party is served with both a summons and complaint. In the present case, Patent Owner asserted in its Preliminary Response for twelve of the proceedings that the petition in each of these twelve proceedings was time-barred under 35 U.S.C. § 315(b).

In this regard, Patent Owner had filed a complaint against Petitioner in the U.S. District for the Western District of Michigan on June 20, 2012. After discussions with Petitioner, Patent Owner filed an amended complaint against Petitioner on July 18, 2012. There was no dispute that Patent Owner’s actions in connection with the June 20, 2012 complaint did not constitute service. At issue was whether the amended complaint was ever served and, if so, whether such service was completed prior to December 17, 2012 (which is one year before the December 17, 2013 petition date for each of the twelve proceedings alleged to be time-barred).

In a December 6, 2012 email communication from Patent Owner’s counsel Mr. Terence Linn to Petitioner’s in-house counsel Mr. Stefan Chmielewski and Mr. Jeff Cooper, Mr. Linn indicated that pursuant to the parties’ agreement, he would serve the amended complaint on all defendants on December 17, 2012 by overnight Federal Express mail and that he would also provide copies to Petitioner’s in-house counsel via email. Mr. Linn then sent an email communication to Messrs. Chmielewski and Cooper on Friday, December 14, 2012, including Summons, Amendment Complaint, and Exhibit attachments, and indicating that per the agreement, he was attaching an

email copy of the Service of Process on Petitioner that was being sent on that day via Federal Express. On the next business day, Monday, December 17, 2012, Mr. Linn filed the summons, including an executed proof of service, along with an attached email tracking update from Federal Express. The proof of service included a declaration by Mr. Linn that he had served the summons on Mr. Chmielewski “by agreement” on December 14, 2012.

Neither Federal Rule of Civil Procedure 4 (which governs service of a summons), nor Michigan law, expressly authorizes service of a summons by email or by Federal Express. Nonetheless, Patent Owner asserted that email and Federal Express service was permissible in this case based on agreement between the parties. The Board said that even if this were the case, the parties’ agreement, as evidenced by the December 6, 2012 email, for example, was for service by email and Federal Express on December 17, 2012, not December 14, 2012. Thus, the Board was not persuaded that the actions by counsel for Patent Owner on December 14, 2012, constituted service of the summons and the amended complaint, which in turn led the Board to conclude that the twelve petitions were not time-barred under 35 U.S.C. § 315(b), “because the amended complaint was not served more than one year before the petitions in the instant proceedings were filed on December 17, 2013.”

35 U.S.C. § 312(a)(2) provides in pertinent part that a petition for *inter partes* review can only be considered if it “identifies all real parties-in-interest.” Factors as to whether a party is a real party-in-interest include whether a non-party exercises control over a petitioner’s participation in a proceeding or is funding or directing the proceeding. In the instant case, Patent Owner asserted in its Preliminary Response for thirteen of the proceedings that *inter partes* review should not be instituted because Petitioner failed to accurately identify all real parties-in-interest.

In particular, in each of the thirteen petitions at issue, Petitioner certified that “TRW Automotive US is the real party-in-interest” and also indicated that there are two other defendants in the district court action, TRW Automotive Holdings Corp. and TRW Vehicle Safety Systems Inc., which are both corporations related to Petitioner. Patent Owner, in its Preliminary Response, asserted that although the petitions identify TRW Automotive US is the real party-in-interest, the petitions also confusingly identify TRW Automotive Holdings Corp. and TRW Vehicle Safety Systems Inc. as corporate entities related to Petitioner without specifying the nature of the relationship. According to Patent Owner, such “contradictory statements call into question the true identities of the real parties in interest” and “unnecessarily [confuse] the Board by identifying only a single real party in interest when it appears likely that multiple interrelated parties may have had a hand in TRW’s petition[s].”

Taking all of these factors into account, the Board found that Patent Owner did not provide sufficient factual basis to support a conclusion that TRW Automotive Holdings Corp. and TRW Vehicle Safety Systems Inc. should have been identified as real parties in interest. The Board also found that by identifying TRW Automotive Holdings Corp. and TRW Vehicle Safety Systems Inc. as being related to Petitioner did not contradict Petitioner’s certification that TRW Automotive US was the real party-in-interest. Thus, the Board concluded that Patent Owner had failed to sufficiently demonstrate that Petitioner had not named all real parties-in-interest for the thirteen proceedings at issue.

In sum, the Board did not find any of the twelve petitions to have been time-barred under 35 U.S.C. § 315(b), and did not deny any of the thirteen petitions as failing to identify all real parties-in-interest in accordance with 35 U.S.C. § 312(a)(2). Thus, the Board will now address whether to institute *inter partes* review in each of these proceedings in separate decisions to follow.

TRW Automotive US LLC v. Magna Electronics, Inc., IPR2014-00251; IPR2014-00255;

IPR2014-00256; IPR2014-00257; IPR2014-00258; IPR2014-00259; IPR2014-00260;
IPR2014-00261; IPR2014-00262; IPR2014-0263; IPR2014-00264; IPR2014-00265; IPR2014-00266
Paper 13, IPR2014-00251; Paper 16, IPR2014-00255; Paper 15, IPR2014-0026; Paper 15,
IPR2014-00257; Paper 15, IPR2014-00258; Paper 18, IPR2014-00259; Paper 14, IPR2014-00260;
Paper 18, IPR2014-00261; Paper 14, IPR2014-00262; Paper 14, IPR2014-00263; Paper 14,
IPR2014-00264; Paper 14, IPR2014-00265; Paper 16, IPR2014-00266

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Patents 6,097,023; 7,423,248; 7,459,664; 8,203,440; 7,994,462; 7,344,261; 7,459,664; 7,339,149;
7,655,894; 8,222,588; 7,459,664; 8,222,588; 7,994,462

Before: Justin T. Arbes, Benjamin D. M. Wood, Patrick R. Scanlon, Neil T. Powell, Barry L.
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