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Another Patent Owner Victory at the PTAB for Haley Guiliano LLP

The Patent Trial and Appeal Board (PTAB) declined to institute Inter Partes Review on U.S. Patent No. 6,183,841 in *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752. The PTAB agreed under 325(d) that the same prior art from prosecution was merely repackaged for the IPR and also considered the relative progress of a co-pending District Court case under 314(a). Great work by the HG Team (Jim Haley, Josh Van Hoven, Brian Gummow, and Maria Marley) and our co-counsel at Dechert LLP (Noah Leibowitz) and Simpson Thacher & Bartlett LLP (Jeffrey Ostrow).

PTAB Denies Hard Drive Part Patent Review Over Trial

Law360; Matthew Bultman (September 13, 2018, 8:02 PM EDT) — The Patent Trial and Appeal Board said Wednesday it would not review an Intri-Plex Technologies Inc. patent related to a component in hard drive disks, taking note of a looming infringement trial against the challenger, NHK Spring Co. Ltd.

Declining to institute inter partes review, the PTAB noted Intri-Plex's infringement case against NHK is scheduled to begin trial in California federal court in March 2019, several months before the board would make a final decision. NHK made the same invalidity arguments at the PTAB as it has made in court, the board said.

The PTAB also said the evidence NHK relied on to argue that various claims in the patent were anticipated or obvious had already been considered by a U.S. Patent and Trademark Office examiner when Intri-Plex applied for the patent.

"Institution of an inter partes review under these circumstances would not be consistent with 'an objective of the AIA ... to provide an effective and efficient alternative to district court litigation,'" it wrote in the decision.

The decision is another recent example of the PTAB factoring parallel district court litigation into the mix when deciding whether to review a patent.

Earlier this month, a PTAB judge in a case involving iRobot Corp. suggested that when co-defendants file separate challenges, there should be a presumption that the later-filed petition will be denied if the first review has progressed to a certain point.

An attorney for Intri-Plex, Noah M. Leibowitz of Dechert LLP, said Wednesday's decision was significant.

"This has particular ramifications for IPRs filed with parallel district court cases pending in fast-moving jurisdictions, such as [the Eastern District of Texas and Eastern District of Virginia], and in cases in which the petitioner waits until just before the one-year statutory bar before filing an IPR petition," he said.

An attorney for NHK could not immediately be reached for comment.

California-based Intri-Plex makes so-called swage mounts, used to connect certain parts in a hard disk drive. It sued NHK, which is based in Japan, and its U.S. subsidiary in the Northern District of California last year accusing the company of using its patented technology without permission.

NHK asked the PTAB in March to review the patent, arguing that Intri-Plex's invention was anticipated or made obvious, in large part, by an earlier patent. Intri-Plex responded that NHK was simply recycling old arguments.

"The petition simply repackages and restyles arguments made by the examiner and overcome by IPT during prosecution of the application that led to the grant of the [patent] and that are being simultaneously asserted by petitioner in the district court case," it wrote in a June filing.

In siding with Intri-Plex, the PTAB said review would be inefficient given that the district court litigation was in its "final stages." The board also said NHK failed to convincingly show how the examiner erred in evaluating the earlier patent.

"Given the foregoing, we are not persuaded that we should reconsider [that patent] or the arguments petitioner presents in the petition," the board wrote.

The patent at issue is U.S. Patent No. 6,183,841.

NHK is represented by William H. Mandir, John F. Rabena, Yoshinari Kishimoto and Fadi Kiblawi of Sughrue Mion PLLC.

Intri-Plex is represented by James F. Haley Jr. and Joshua Van Hoven of Haley Guiliano LLP and Noah M. Leibowitz of Dechert LLP.

The case is NHK Spring Co. Ltd. v. Intri-Plex Technologies Inc., case number IPR2018-00752, at the Patent Trial and Appeal Board.

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