

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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QUALCOMM INCORPORATED,  
Petitioner,

v.

UNM RAINFOREST INNOVATIONS,  
Patent Owner.

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IPR2021-00375 (Patent 8,265,096 B2)  
IPR2021-00377 (Patent 8,249,204 B2)  
IPR2021-00582 (Patent 8,565,326 B2)<sup>1</sup>

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Before KRISTEN L. DROESCH, BARBARA A. PARVIS, and  
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

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<sup>1</sup> This Order addresses overlapping issues in the cases listed above. Therefore, we issue one Order to be filed in each case. The parties, however, are not authorized to use this style of filing

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Judges Droesch, Parvis, and Boudreau held a conference call on September 29, 2021, with counsel for the parties. Counsel for Patent Owner requested the call seeking authorization to file a motion to stay the proceedings in IPR2021-00375, IPR2021-00377, and IPR2021-00582.

Counsel for Patent Owner requests authorization to file a motion in each case to temporarily stay the proceedings to allow the parties to brief the issues of patent ownership and standing to participate in these proceedings, which arise from the patent ownership dispute in *UNM Rainforest Innovations v. Industrial Technology Research Institute*, No. D-202-CV-2021-02803 (N.M. 2d. Judicial District Court May 4, 2021) “(New Mexico state court proceeding”).<sup>2</sup> Counsel for Patent Owner cites *FedEx Corp. v. Human Sciences HC Ltd.*, IPR2018-01830, Paper 23 (April 10, 2018) to support its position that the Board can decide issues of patent ownership and standing. Counsel for Patent Owner also asserts that it would be a waste of resources for UNM Rainforest Innovations (UNM) to file responses to the Petitions if Industrial Technology Research Institute (ITRI) prevails in the New Mexico state court proceeding. Counsel for Patent Owner requests ten pages for its briefing.

Counsel for Petitioner opposes Patent Owner’s request. Counsel for Petitioner emphasizes that 35 U.S.C. § 316(a)(11) requires a final written

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<sup>2</sup> The proceedings in *UNM Rainforest Innovations v. Dell Technologies, Inc.*, No. 6:20-cv-00468-ADA (W.D. Tex.) have been stayed pending the outcome of the ownership issues in the New Mexico state court proceeding. *See, e.g.*, IPR2021-00375, Paper 13.

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decision within one year of institution, which, for these cases, is 10 months away. Counsel for Petitioner asserts that there is no good cause to extend the one-year deadline. Counsel for Petitioner contends that USPTO assignment records indicate that UNM is the owner of record. Counsel for Petitioner further represents that ITRI has not been served with the Petitions filed in IPR2021-00375, 2021-00377, and IPR2021-00582. Counsel for Patent Owner cites *Pixart Imaging Inc. v. Syncpoint Imaging, LLC*, IPR2015-01347, Paper 18 (March 9, 2016) and *The Jewelry Channel, Inc. USA d/b/a Liquidation Channel v. Americas Collectibles Network, Inc.*, CBM2014-00119, Paper 10 (Oct. 20, 2014) to support its positions that there is a presumption of standing for the patent owner listed in USPTO assignment records and that motions to stay should not be authorized. Counsel for Petitioner also distinguishes the facts before us from the underlying facts of the *FedEx* case. Counsel for Petitioner requests that, if the Board authorizes briefing, the schedule be set in parallel with the existing briefing schedule.

After considering the parties' contentions made during the conference call, at this time, we do not authorize Patent Owner to file a motion to stay. We, however, authorize Petitioner to file a ten (10) page brief in each proceeding to address the issues of patent ownership and standing. We also authorize Patent Owner to file in each proceeding a ten (10) page responsive brief. To mitigate the efforts and expense of both parties in the event that the ownership dispute in the New Mexico state court proceeding is resolved in favor of ITRI during briefing of these issues, we deem it appropriate, at

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this time, to postpone DUE DATE 1 in each proceeding to December 7, 2021.<sup>3</sup>

## ORDER

Accordingly, it is:

ORDERED that Petitioner is authorized to file a brief in each proceeding to address the issues of patent ownership and standing;

FURTHER ORDERED that Petitioner's brief is limited to ten (10) pages and shall be filed no later than October 18, 2021;

FURTHER ORDERED that Patent Owner is authorized to file a responsive brief in each proceeding, limited to ten (10) pages, no later than November 1, 2021; and

FURTHER ORDERED that the Scheduling Order in each proceeding (IPR2021-00375, Paper 15; IPR2021-00377, Paper 14; IPR2021-00582, Paper 12) is amended to change DUE DATE 1 to December 7, 2021.

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<sup>3</sup>A revised Scheduling Order setting DUE DATES 2 through 8 for each proceeding will be issued in due course. The parties may still stipulate to new DUE DATES 2, 3, 5, and 6, as permitted according to the Scheduling Order. *See, e.g.*, IPR2021-00375, Paper 15, 9–10.

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